



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Scott Clark, et al.

Serial No.: 09/759,103

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For: Search Engine Providing an Option to  
Win the Item Sought

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**APPEAL BRIEF UNDER 37 CFR §41.37(d)**

S I R:

In support of a Notice of Appeal filed October 22, 2009, Applicants respectfully submit  
this Appeal Brief under 37 CFR §41.37(d) in the above referenced matter.

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## **TABLE OF CONTENTS**

<b><u>TITLE</u></b>	<b><u>PAGE</u></b>
I. Table of Authorities	4
II. Real Party in Interest	6
III. Related Appeals and Interferences	6
IV. Status of Claims	7
V. Status of Amendments	7
VI. Summary of Claimed Subject Matter	7
VII. Grounds of Rejection to be Reviewed on Appeal	26
A.    Whether Claims 1-2, 6-11, 13-16, 18-26, 27-28 and 31-37 are unpatentable under 35 U.S.C. §103 over Walker ‘888 in view of bottomdollar.com and Walker ‘765	26
B.    Whether Claims 3-5 and 29-30 are unpatentable under 35 U.S.C. §103 over Walker ‘888 in view of bottomdollar.com, Walker ‘765 and Yoseloff	27
C.    Whether Claims 1, 10, 15, 21-22, 33 and 35-37 are unpatentable under 35 U.S.C. §112, 2nd paragraph	27
VIII. Argument	28
A.    Claims 1-2, 6-11, 13-16, 18-26, 27-28 and 31-37 are patentable over the combination of the prior art because the combination of references fail to teach every element of the claim	28
B.    Claims 3-5 and 29-30 are patentable over the combination of the prior art because the combination of references fail to teach every	

element of the claim	35
C. Claims 1, 10, 15, 21-22, 33 and 35-37 are patentable under 35 U.S.C. § 112, second paragraph because the claims particularly point out and distinctly claim the invention	41
IX. Conclusion	44
Appendix I: Claims	45
Appendix II: Evidence	63
Appendix III: Related Proceedings	64

## **I. TABLE OF AUTHORITIES**

### **A. CASES CITED**

1. *Graham v. John Deere Co.*, 383 U.S. 1 (1966);
2. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007);
3. *In re Ehrreich*, 590 F.2d 902 (Fed. Cir.1979);
4. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989);
5. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005);
6. *In re Morris*, 127 F.3d 1048 (Fed. Cir. 1997)

### **B. UNITED STATES STATUTES CITED**

1. 35 United States Code §103;
2. 35 United States Code §112, Second Paragraph

### **C. PATENTS, PUBLICATIONS, AND NON-PATENT LITERATURE CITED**

1. United States Patent Application Pub. No. 2003/0054888, to Walker, *et al.*;
2. United States Patent No. 6,364,765, to Walker, *et al.*;
3. United States Patent No. 6,331,143, to Yoseloff, *et al.*;
4. Bottomdollar.com, [http://www.web.archive.org/web/19991013040730/  
http://bottomdollar.com/index.html](http://www.web.archive.org/web/19991013040730/http://bottomdollar.com/index.html) (Oct. 13, 1999).



#### **D. SECONDARY SOURCES CITED**

1. File Wrapper for United States Patent Application Serial Number 09/759,013 for “Search Engine Providing an Option to Win the Item Sought” (subject of current appeal);
2. Manual of Patent Examining Procedure (MPEP) §§ 2131-2173.02.

## **II. REAL PARTY IN INTEREST**

The real party in interest in this appeal is PickaPin.com of Bronx, NY. Scott Clark of New York, New York, Armen Djourian, of New York, New York and Moujan Vahdat of New York, New York are the inventors and have assigned an interest to PickaPin.com in the invention that is currently subject to appeal. The assignment to PickaPin.com is recorded with the United States Patent and Trademark Office at Reel/Frame 019348/0373.

## **III. RELATED APPEALS AND INTERFERENCES**

On September 26, 2005, in response to an Office Action dated June 27, 2005 finally rejecting all of the then-pending claims, Applicants filed a Notice of Appeal and a Request for a Pre-Appeal Brief conference. On December 13, 2005, a Notice of Panel Decision from Pre-Appeal Brief Review maintained the rejection of claims 1-30. On February 27, 2006, Applicants filed a Request for Continued Examination (“RCE”) and Amendment. The Office Action dated June 27, 2005, Applicants’ Pre-Appeal Brief Request for Review, the Notice of Panel Decision from Pre-Appeal Brief Review are appended in Appendix III.

On September 21, 2007, in response to an Office Action dated May 21, 2007 finally rejecting all of the pending claims, Applicants filed a Notice of Appeal and, on March 4, 2008, filed an amended Appeal Brief. On May 8, 2008, Applicants withdrew the Application from Appeal and reopened prosecution by filing a Request for Continued Examination (“RCE”) and Amendment. The Office Action dated May 21, 2007, the Request for Continued Examination dated May 8, 2008, and Appeal Brief dated March 4, 2008 are appended in Appendix III.

On October 22, 2009, in response to an Office Action dated April 22, 2009 finally rejecting all of the then-pending claims, Applicants filed a Notice of Appeal. Applicants are

unaware of any other prior appeal, pending appeal, judicial proceeding, or interference proceeding which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in this proceeding. The Office Action dated April 22, 2009, Amendment and Response to Non-Final Office Action dated February 5, 2009, and Non-Final Office Action dated August 5, 2008 are appended in Appendix II.

#### **IV. STATUS OF CLAIMS**

Claims 1, 10, 15, 21-22, 33 and 35-36 were last amended in a Response and Amendment dated February 5, 2009. In addition, Claim 37 was added in the Response and Amendment dated February 5, 2009. Claims 1-11, 13-16 and 18-37 are pending in the application and stand finally rejected under 35 U.S.C. §103 by the Examiner in the Office Action dated April 22, 2009.

The Amendment dated February 5, 2009 and Final Rejection dated April 22, 2009 are attached in Appendix II.

#### **V. STATUS OF AMENDMENTS**

No Amendment has been filed subsequent to the Final Office Action dated April 22, 2009. The Applicants consider the claims listed in Appendix I to be the claims at issue in this appeal.

#### **VI. SUMMARY OF CLAIMED SUBJECT MATTER**

There are nine independent claims in the present application — Claim 1, Claim 10, Claim 15, Claims 21-22, Claim 33, Claims 35-36, and Claim 37. A brief summary of each independent

claim is discussed below, with reference being made to the specification of the presently appealed application. A copy of the claims can be found in Appendix I.

Claim 1 provides for a method for providing a game of chance related to a user's acquisition of a selected product. In particular, Claim 1 recites:

1. A method of providing a user with a game of chance, the method comprising the steps of:  
receiving electronic signals from a user system representing search parameters  
descriptive of a product; (e.g., paragraph [0031], Fig. 2a, elements 203 and 205)  
retrieving at least one product information from at least one database storing third-party  
retail vendor product information; (e.g., paragraph [0031], Fig. 2a, element 206)  
transmitting electronic signals to the user system representing the retrieved product  
information and associated prices; (e.g., paragraph [0031], Fig. 2a, element 207)  
automatically providing the user with an option to play a game to win a selected product  
(e.g., paragraph [0031], Fig. 2a, element 208) from said product information  
without the user first making any payment or requesting the option; (e.g.,  
paragraph [0032], Figs. 2a and 2b, element 210)  
electronically calculating a dynamic probability of winning the selected product by the  
user based on one or more factors selected from a group consisting of: the cost of  
the selected product in relation to the total cost of all products available, a current  
prize budget, a ratio of the current prize budget to a total amount of funds  
received, and the user's behavior during a user session; (e.g., paragraph [0032],  
Fig. 2b, element 214)

electronically and randomly generating a trial outcome of an event trial, the probability of the event trial generating a winning trial outcome corresponding to the calculated probability of winning; (e.g., paragraph [0032], Fig. 2b, elements 214 and 215) generating an outcome indicator, (e.g., paragraph [0032], Fig. 2b, element 217), wherein the outcome indicator is generated independently of the trial outcome (e.g., paragraph [0058]), and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome (e.g., paragraph [0032]), and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution (e.g., paragraph [0032]) and the trial outcome has a distribution associated with a second statistical distribution (e.g., paragraph [0032], Fig. 2b, element 215), and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution; (e.g., paragraph [0093]) and displaying the outcome indicator to the user; (e.g., paragraph [0032], Fig. 2b, element 217) and in response to a winning trial outcome, purchasing the selected product for the user from the third-party retail vendor. (e.g., paragraph [0032], Fig. 2b, element 218).

Claim 3 provides a method step for providing the results of the pseudo-random outcome of a game of chance to a user by displaying a user-chosen number with a comparison number.

Claim 3 particularly recites:

3. The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user-chosen number and a comparison number, (e.g., paragraphs [0008, 0055-0058]), such that a

winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. (e.g., paragraphs [0008, 0058]).

Claim 6 provides a method step permitting a user to increase their odds of winning a game of chance, and recites:

6. The method of claim 1, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation to the provider of the game of chance. (e.g., paragraph [0094]).

Claim 10 provides for an alternative embodiment of the present invention where a user is given the option of purchasing the desired product outright, or winning the product through a game of chance. Claim 10 recites:

10. A method of providing a user with a game of chance, the method comprising:  
receiving electronic signals from a user system representing at least one search parameter  
descriptive of a product; (e.g., paragraph [0031], Fig. 2b, element 215)  
retrieving at least one product information from at least one database storing third-party  
retail vendor product information; (e.g., paragraph [0031], Fig. 2a, element 206)  
transmitting electronic signals to the user system representing at a least one product, a  
price of the product and the independent third-party retail vendor of the product;  
(e.g., paragraph [0031, 0053], Fig. 2a, element 207)  
automatically transmitting electronic signals representing at least a first option for the  
user to play a game, (e.g., paragraph [0031], Fig. 2a, element 208), to win the

product without the user first making any payment or requesting the first option, and a second option to purchase the product; (e.g., paragraphs [0025, 0031], Fig. 2a, element 209)

if the user chooses to play the game, (e.g., paragraph [0031], Fig. 2a, element 210):

electronically calculating a dynamic probability of winning the product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received, and the user's behavior during a user session; (e.g., paragraph [0032], Fig. 2b, element 214)

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning; (e.g., paragraph [0032], Fig. 2b, element 214 and 215)

generating an outcome indicator (e.g., paragraph [0032], Fig. 2b, element 217), wherein the outcome indicator is generated independently of the trial outcome, (e.g., paragraph [0058]), and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, (e.g., paragraph [0032]), and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution, (e.g., paragraph [0032]), and the trial outcome has a distribution associated with a second statistical distribution, (e.g., paragraph [0032], Fig. 2b, element 215), and further wherein the first

statistical distribution has a distribution which is different from the second statistical distribution; (e.g., paragraph [0093])

displaying the outcome indicator to the user; (e.g., paragraph [0032], Fig. 2b, element 217) and

in response to a winning trial outcome, (e.g., paragraph [0032], Fig.2b, element 216)

purchasing the product for the user from the independent third-party retail vendor at no cost to the user; (e.g., paragraph [0032], Fig. 2b, element 218) and

if the user chooses to purchase the product instead of playing the game, (e.g., paragraph [0031], Fig. 2a, element 209): directing the user to a web site which sells the product. (e.g., paragraph [0054]).

Claim 15 provides for an alternative embodiment of the present invention where a response to a user's inquiry regarding a product is predicated on a user provided search parameter. Claim 15 recites:

15. A method of providing a user with a game of chance, the method comprising:
  - receiving electronic signals from a user system representing at least one search parameter descriptive of a product; (e.g., paragraph [0031], Fig. 2a, elements 203 and 205)
  - retrieving at least one product information from at least one database storing independent third-party retail vendor product information; (e.g., paragraph [0031], Fig. 2a, element 206)
  - transmitting electronic signals to the user system representing a plurality of different independent third-party retail vendors and associated prices charged by each of said different independent third-party retail vendors for products identified in



response to said at least one search parameter; (e.g., paragraph [0031], Fig. 2a, element 206)

automatically transmitting electronic signals to the user system representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; (e.g., paragraph [0031], Fig. 2a and 2b, element 210) and

if the user chooses to play the game: (e.g., paragraph [0031], Fig. 2a, element 209)

electronically calculating a dynamic probability of winning said selected one product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received, and the user's behavior during a user session; (e.g., paragraph [0032], Figs. 2a and 2b, element 210)

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning; (e.g., paragraph [0032], Fig. 2b, element 214 and 215)

generating an outcome indicator, (e.g., paragraph [0032], Fig. 2b, element 217), wherein the outcome indicator is generated independently of the trial outcome, (e.g., paragraph [0058]), and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, (e.g., paragraph [0032]), and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical

distribution, (e.g., paragraph [0032]) and the trial outcome has a distribution associated with a second statistical distribution, (e.g., paragraph [0032], Fig. 2b, element 215), and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution; (e.g., paragraph [0093]) and displaying the outcome indicator to the user; (e.g., paragraph [0032], Fig. 2b, element 217) and in response to a winning trial outcome, (e.g., paragraph [0032], Fig. 2b, element 216) purchasing said selected one product from a corresponding independent third-party retail vendor for the user at no cost to the user. (e.g., paragraph [0032], Fig. 2b, element 218).

Claim 21 provides for an alternative search result embodiment. Claim 21 recites:

21. A method of providing a user with a game of chance, the method comprising:  
receiving electronic signals from a user system representing at least one search parameter descriptive of a product; (e.g., paragraph [0031], Fig. 2a, elements 203 and 205)  
searching for products matching said at least one search parameter; (e.g., paragraphs [0031, 0035], Fig. 2a, element 206)  
transmitting electronic signals to the user system representing a plurality of independent third-party retail vendors and associated prices charged by each of said independent third-party retail vendors for products identified in response to said at least one search parameter, each of the products identified being offered for sale

on a corresponding web site of each independent third-party retail vendor; (e.g., paragraphs [0031, 0053], Fig. 2a, element 207)

automatically transmitting electronic signals to the user representing an option to play a game, (e.g., paragraph [0031], Fig. 2a, element 208), to win a selected one of said products without the user first making any payment or requesting the option; (e.g., paragraphs [0025, 0031], Fig. 2a, element 209) and

if the user chooses to play the game, (e.g., paragraph [0031], Fig. 2a, element 210):

electronically calculating a dynamic probability of winning said selected one product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received, and the user's behavior during a user session; (e.g., paragraph [0032], Fig. 2b, element 214)

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning; (e.g., paragraph [0032], Fig. 2b, elements 214 and 215)

generating an outcome indicator, (e.g., paragraph [0032], Fig. 2b, element 217), wherein the outcome indicator is generated independently of the trial outcome, (e.g., paragraph [0058]), and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, (e.g., paragraph [0032]), and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical

distribution, (e.g., paragraph [0032]), and the trial outcome has a distribution associated with a second statistical distribution, (e.g., paragraph [0032], Fig. 2b, element 215), and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution; (e.g., paragraph [0093]) and displaying the outcome indicator to the user; (e.g., paragraph [0032], Fig. 2b, element 217) and in response to a winning trial outcome, (e.g., paragraph [0032], Fig. 2b, element 216) purchasing said selected one product from a corresponding independent third-party retail vendor for the user at no cost to the user. (e.g., paragraph [0032], Fig. 2b, element 218).

Claim 22 provides for an alternative embodiment of the present invention with another method for allowing a user to play a game of chance to win a desired product. Claim 22 recites:

22. A method for providing a user an opportunity to win a product or service by playing a game of chance without buying the product or service and without paying a fee to play, comprising the steps of:
- enabling the user to submit a search query associated with a type of product or service; (e.g., paragraph [0031, 0034], Fig. 2a, element 204)
- conducting a search in a database for an independent third-party retail vendor product or service that satisfies the search query; (e.g., paragraph [0031], Fig. 2a, element 206)

automatically presenting a result of the search to the user, including at least one product or service offered for sale by the independent third-party retail vendor retrieved from the database, along with an option to play the game; (e.g., paragraph [0031], Fig. 2a, element 207)

enabling the user to select the product or service that he wants to win; (e.g., paragraphs [0031, 0033], Fig. 2a, element 208)

dynamically determining the user's chance of winning the selected product or service based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received, and the user's behavior during a user session; (e.g., paragraph [0032], Fig. 2b, element 214)

generating a trial outcome for each play of the game wherein the probability of the trial outcome generating a winning trial outcome corresponds to the user's chance of winning; (e.g., paragraph [0032], Fig. 2b, element 215)

generating an outcome indicator, (e.g., paragraph [0032], Fig. 2b, element 217), wherein the outcome indicator is generated independently of the trial outcome (e.g., paragraph [0058]), and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, (e.g., paragraph [0032]), and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution, (e.g., paragraph [0032]) and the trial outcome has a distribution associated with a second statistical distribution, (e.g., paragraph [0032], Fig. 2b, element 215), and further wherein

the first statistical distribution has a distribution which is different from the second statistical distribution; (e.g., paragraph [0093]) and displaying the outcome indicator to the user. (e.g., paragraph [0032], Fig. 2b, element 217).

Claim 30 provides an embodiment of the present principles where the probability of winning a product or service is increased in response to a user participating in a particular sponsored survey. Claim 30 specifically recites:

30. The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor. (e.g., paragraph [0094]).

Claim 33 provides for an alternative embodiment of the present invention wherein the invention is directed to generating traffic through a website. Claim 33 recites:

33. A method for increasing user traffic to a search engine website, comprising:  
receiving a search query from a user system interacting with a search webpage of the website, the search query defining a desired product for the user; (e.g., paragraph [0031], Fig. 2a, elements 204 and 205), and  
transmitting a results webpage to the user system, the results page including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product, (e.g., paragraph [0031], Fig. 2a, element 209), and further including in the same webpage a play link corresponding to said third party vendor link for redirection

to a webpage which allows the user to play a game of chance to win the product corresponding to the third party website redirection link; (e.g., paragraphs [0031, 0043], Fig. 2a, element 209).

electronically calculating a dynamic probability of winning the corresponding product by the user; (e.g., paragraph [0032], Fig. 2b, element 214)

electronically and randomly generating a trial outcome of an event trial, the probability of the event trial generating a winning trial outcome corresponding to a determined probability of winning; (e.g., paragraph [0032], Fig. 2b, elements 214 and 215)

generating an outcome indicator, (e.g., paragraph [0032], Fig. 2b, element 217), wherein the outcome indicator is generated independently of the trial outcome, (e.g., paragraph [0058]), and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, (e.g., paragraph [0032]), and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution, (e.g., paragraph [0032], Fig. 2b, element 215), and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution; (e.g., paragraph [0093]), and

displaying the outcome indicator to the user; (e.g., paragraph [0032], Fig. 2b, element 217) and

in response to a winning trial outcome, (e.g., paragraph [0032], Fig. 2b, element 216), purchasing the selected product from the user from the independent

third-party retail vendor for the user at no cost to the user. (e.g., paragraph [0032], Fig. 2b, element 218).

Claim 35 provides for an embodiment of the present invention reciting an alternative method for generating traffic through a website. Claim 35 recites:

35. A method for increasing user traffic to a search website, comprising:
- providing a search webpage containing a search interface for a user to submit a search query for a product; (e.g., paragraphs [0031, 0043-0044], Fig. 2a, elements 204 and 205)
  - receiving a search query from a user employing said search webpage; (e.g., paragraph [0031], Fig. 2a, element 204)
  - searching independent third party websites by reference to said query; (e.g., paragraph [0031], Fig. 2a, element 206)
  - retrieving product information and corresponding price from the third party websites for at least one products satisfying said query; (e.g., paragraph [0031], Fig. 2a, element 206)
  - providing a game of chance in response to a user selection of the link to win the product; (e.g., paragraph [0031], Fig. 2a, element 208)
  - purchasing the product from the independent third party for the user response to a favorable outcome in said game; (e.g., paragraph [0032], Fig. 2b, element 218)
  - transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the



independent third party website, (e.g., paragraph [0054]) and a link to win the product; (e.g., paragraph [0031], Fig. 2a, element 210)

providing a game of chance in response to a user selection of the link to win the product, (e.g., paragraph [0031], Fig. 2a, elements 208 and 210), wherein the probability of winning the product by the user is dynamically calculated based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received, and the user's behavior during a user session; (e.g., paragraph [0032], Fig. 2b, element 214)

generating an outcome indicator, (e.g., paragraph [0032], Fig. 2b, element 217), wherein the outcome indicator is generated independently of the trial outcome, (e.g., paragraph [0058]), and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, (e.g., paragraph [0032]), and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution, (e.g., paragraph [0032]), and the trial outcome has a distribution associated with a second statistical distribution, (e.g., paragraph [0032], Fig. 2b, element 215), and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution; (e.g., paragraph [0032]), and

displaying the outcome indicator to the user; (e.g., paragraph [0032], Fig. 2b, element 217) and

purchasing the product from the independent third party for the user in response to a favorable outcome in said game. (e.g., paragraph [0032], Fig. 2b, element 218).

Claim 36 provides for an alternative embodiment of the present invention having a product search website apparatus that permits a user to play a game of chance to win a desired product. Claim 36 recites:

36. A product search website executing on a server storing a plurality of web pages, the website comprising:

a search page for a user submitting a query to the server for at least one product;

(e.g., paragraph [0031], Fig. 2a, elements 204 and 205)

a results webpage transmitted to the user, the results page including links to an

independent third party website and a link to a play webpage of the website; (e.g., paragraphs [0031, 0053-0055], Fig. 2a, element 207)

a play webpage providing a game of chance for winning the at least one product

corresponding to a selected play link from the results webpage, (e.g., paragraphs [0031, 0053-0055], Fig. 2a, element 214), wherein a probability of winning the at least one product by the user is dynamically calculated based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session, (e.g., paragraph [0032], Fig. 2b, element 214); and

a product win webpage to display an outcome indicator indicating a favorable outcome in said game of chance for the at least one product, (e.g., paragraphs [0032, 0058], Fig. 9), wherein the outcome indicator is generated independently of the probability of winning, (e.g., paragraph [0058]), and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome,

and further wherein the outcome indicator for a favorable outcome has a distribution associated with a first statistical distribution, (e.g., paragraph [0032]), and the probability of winning has a distribution associated with a second statistical distribution, (e.g., paragraph [0032], Fig. 2b, element 215), and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution. (e.g., paragraph [0032])

Claim 37 provides for an alternative embodiment of the invention with another method for automatically providing to a user a game of chance to win a desired product. Claim 37 recites:

37. A computer-implemented method, comprising the steps of:
- receiving a search request for a product, wherein the search request is transmitted from a communication device associated with or used by a user; (e.g., paragraph [0031], Fig. 2a, elements 203 and 205)
- processing the search request with a processing device; (e.g., paragraph [0031])
- generating a message, wherein the message contains information regarding at least one product offered by a retail vendor, product information regarding the at least one product, and at least one price associated with the at least one product; (e.g., paragraphs [0031, 0053], Fig. 2a, element 207)
- transmitting the message to the communication device; (e.g., paragraph [0031])
- automatically providing the user with an option to play a game, (e.g., paragraph [0031], Fig. 2a, element 208), to win a selected product from the product information

regarding the at least one product without the user first making any payment or requesting the option; (e.g., paragraphs [0025, 0031], Fig. 2a, element 209)

electronically calculating a dynamic probability of winning the selected product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received, and the user's behavior during a user session; (e.g., paragraph [0032], Fig. 2b, element 214)

electronically and randomly generating a trial outcome for a game of chance, wherein the probability of the game of chance generating a winning trial outcome corresponds to the calculated probability of winning; (e.g., paragraph [0032], Fig. 2b, elements 214 and 215)

generating an outcome indicator, (e.g., paragraph [0032], Fig. 2b, element 217), wherein the outcome indicator is generated independently of the trial outcome, (e.g., paragraph [0058]), and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, (e.g., paragraph [0032]), and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution, (e.g., paragraph [0032]), and the trial outcome has a distribution associated with a second statistical distribution, (e.g., paragraph [0032], Fig. 2b, element 215), and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution; (e.g., paragraph [0093]) and

displaying the outcome indicator to the user; (e.g., paragraph [0032], Fig. 2b, element 217) and

in response to a winning trial outcome, (e.g., paragraph [0032], Fig.2b, element 216), purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user. (e.g., paragraph [0032], Fig. 2b, element 218).

## **VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The following summaries are derived from the Examiner's Final Office Action dated April 22, 2009 and Non-Final Office Action dated August 5, 2008, both of which are attached in Appendix II.

### **A. Whether Claims 1, 2, 6-11, 13-16, 18-28 and 31-37 are unpatentable under 35 U.S.C. § 103 over Walker '888 in view of bottomdollar.com and Walker '765**

The Examiner has rejected claims 1, 2, 6-11, 13-16, 18-28 and 31-37 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Application Pub. No. 2003/0054888 to Walker *et al.*, (hereinafter "Walker '888"), in view of the website to bottomdollar.com, available at <http://www.web.archive.org/web/19991013040730/http://bottomdollar.com/index.html>, (hereinafter "bottomdollar.com"), and further in view of United States Patent No. 6,364,765 to Walker *et al.* (hereinafter "Walker '765"). The Examiner stated that Walker '888 discloses the claimed invention except for "retrieving at least one product information from at least one database storing independent third-party retail vendor product information." See Final Office Action dated April 22, 2009, page 6, first paragraph. The Examiner also stated that Walker '888 does not teach "generating an outcome indicator wherein the outcome indicator is generated independently of the trial outcome . . . displaying the outcome indicator to the user." See Final Office Action dated April 22, 2009, page 6, second paragraph – page 7, first paragraph. The Examiner held that "it would have been obvious at to a person of ordinary skill in the art at the time the application was made, to know that Walker '888 would allow customer to play different games of chance, where the probability of winning said game of chance would be independent of a PIN number needed to play said game, as taught by

Walker '765 in order to adjust the probability of winning a product based upon requirements of said game". *See* Final Office Action dated April 22, 2009, page 7, first paragraph.

**B. Whether Claims 3-5 and 29-30 are unpatentable under 35 U.S.C. § 103 over Walker '888 in view of bottomdollar.com, Walker '765, and Yoseloff**

Claims 3-5 and 29-30 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Walker '888 in view of bottomdollar.com, in further view of Walker '765 and United States Patent No. 6,331,143 to Yoseloff, *et al.* (hereinafter "Yoseloff"). The Examiner stated that "Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated number." *See* Final Office Action dated April 22, 2009, page 18, second paragraph. According to the Examiner, "it would have been obvious to combine Yoseloff with Walker '888 and bottomdollar.com to generate the embodiments claimed in claims 3-5 and 29." *Id.*

**C. Whether Claims 1, 10, 15, 21-22, 33 and 35-37 are unpatentable under 35 U.S.C. §112, 2nd paragraph**

Claims 1, 10, 15, 21-22, 33 and 35-37 stand rejected by the Examiner under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.. The Examiner stated that "the PIN number needed to play the game is not the one that determines if a user would win a game as the trial outcome is independent of the outcome number and PIN." *See* Final Office Action dated April 22, 2009, pages 3-4.

## **VIII. ARGUMENT**

### **A. Claims 1, 2, 6-11, 13-16, 18-28 and 31-37 Are Patentable Over the Combination of the Prior Art Because the Combination of References Fails to Teach Every Element of the Claims**

The Examiner rejected Claims 1, 2, 6-11, 13-16, 18-28 and 31-37 under 35 U.S.C. § 103(a) as being unpatentable over Walker *et al.*, United States Patent Application Pub. No. 2003/0054888 (hereinafter “Walker ‘888”) in view of a website to bottomdollar.com, available at <http://www.web.archive.org/web/19991013040730/http://bottomdollar.com/index.html>, (hereinafter “bottomdollar.com”), and in further view of United States Patent No. 6,364,765 to Walker *et al.* (hereinafter “Walker ‘765”).

The Examiner presented his arguments rejecting Claim 10 specifically. The Examiner also rejected remaining independent claims 1, 10, 15, 21-22, 33 and 35-37 by applying the same arguments to each of those independent claims. Applicants respectfully assert that Claim 10 is representative of independent Claims 1, 15, 21-22, 33 and 35-37, and that these independent claims stand or fall together. Furthermore, Claims 2-9 and 31-32 depend from independent Claim 1, Claims 11 and 13-14 depend from independent Claim 10, Claims 16 and 18-20 depend from independent Claim 15, Claims 23-30 depend from independent Claim 22, and claim 34 depends from independent Claim 33. By virtue of their dependencies, Claims 2-9, 11, 13-14, 16, 18-20, 23-30, 31-32, and 34 have at least all of the features and limitations as the claims from which they depend.

The Examiner cited Walker ‘888 and bottomdollar.com as showing almost all elements of each of the independent claims, however, the Examiner admitted that neither Walker ‘888 nor bottomdollar.com expressly teaches the Claim 10 element of “generating an outcome indicator



wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial . . . displaying the outcome indicator to the user”. See Final Office Action dated April 22, 2009, pages 4-7. In the Examiner’s view, “Walker ‘765 teaches that it is old and well known in the gaming art to play different games of chance in a game machine and obtain different outcomes from said playing.” See Final Office Action dated April 22, 2009, page 7. In addition, the Examiner stated that “Walker (765) teaches the need for an [*sic*] user to enter a PIN number to play a game, where said PIN number is generated by the system but said PIN is not needed to determine the probability of winning said game as said probability of winning is calculated independently of said PIN number.” *Id. (emphasis added)*. As a result, the Examiner stated that “it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker ‘888 would allow a customer to play different games of chance, where the probability of winning said game of chance would be independent of a PIN number needed to play said game, as taught by Walker (765)”. *Id.* Accordingly, the Examiner concluded that the combination of references would allow for adjusting the probability of winning a product based upon the requirements of the game. *Id.*

The Supreme Court held that for a claimed invention to be obvious, either alone or in view of a combination of references, an objective analysis for determining obviousness is required. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2141 (II). This analysis requires the following factual inquiries: 1) determine the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. *Id.* at 33.

Applicants respectfully submit that a factual inquiry into the differences between the claimed invention and the prior art suggests that the Examiner has not made a *prima facie* case for obviousness. It is well settled that the claimed invention must be shown in identical detail in the prior art references in order for these references to be considered. *See, e.g., Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); MPEP § 2131. However, the scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005). Further, ascertaining the differences between the claimed invention and the prior art requires interpreting the claim language, and considering both the invention and the prior art as a whole. MPEP at § 2141 (II) (B). Furthermore, the Court of Appeals has reiterated the impermissibility of importing subject matter from the specification to narrow the scope of the claim, *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Applicants respectfully assert that the combination of Walker ‘888, in view of bottomdollar.com and Walker ‘765, fails to teach, suggest, or render obvious all of the limitations recited in Claim 10. In particular, none of the cited prior art references, taken singly or in combination, teach, suggest, or obviate, *inter alia*, the claimed elements of “generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome”, “the outcome indicator is representative of a winning trial outcome or a losing trial outcome”, “the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution”, or “the first statistical distribution has a distribution which is different from the second statistical distribution.” Furthermore, none of the cited references teach,

suggest, or render obvious the Claim 10 element of “displaying the outcome indicator to the user”, where the outcome indicator indicates a resulting outcome, but is calculated or determined separately from the trial outcome.

The present principles recited in Claim 10 are applicable to a system for providing a user with an option to win the item sought. The system, *inter alia*, automatically provides the user with an option to play the game to win a selected product or service without the user first making any payment or requesting the option. The system generates a trial outcome of an event trial, and displays the outcome indicator representing either a winning or losing trial outcome. Thus, an outcome indicator is an element that displays either a winning trial outcome or a losing trial outcome. The probability of winning is controlled by an odds management component. The odds management component is configured to determine an overall prize budget, and the users probability of winning a desired product or service is varied by the odds management component and not determined by any PIN number selected by the user. The specification discloses that the calculated probability of winning the trial event is independent of any PIN number selected by or determined for the user. The probability of winning the selected product or service is determined separately from the odds a particular PIN will be randomly selected. For example, in one embodiment, the odds of winning are a function of the ratio of the product or service’s price to the current prize budget. Thus, Claim 10 recites elements that permit a website operator to manage expenses and maintain prize awards within the confines of a budget while providing users with a consistent and interesting user experience.

In contrast, Walker ‘888 discloses a system and method wherein an individual retailer can “increase the excitement associated with the shopping experience” by providing “a system to provide a product which includes reception of a selection of a product from a customer, reception

of a fee to play a game, determination of an outcome of the game, provision of the product to the customer if the outcome is a winning outcome, and credit of a portion of the fee to the customer if the outcome is a losing outcome. As a result, the customer is able to play for products actually desired and a risk of loss is less than that presented by gambling-based systems.” *See* Walker ‘888, page 2, paragraph [0022].

According to Walker ‘888, to increase the excitement associated with shopping, a customer has the option to win a product from a retail store outright for a small percentage of the item’s cost. *See*, Walker ‘888, paragraph [0041]. Alternatively, a customer can apply the cost associated with winning the product as a credit towards the purchase of the desired item. *See* Walker ‘888, paragraph [0096]. The product can be manufactured by a third-party, however, it must be offered for sale at the retail store for it to generate customer excitement, and in turn, increased profits. *See* Walker ‘888, paragraphs [0092, 0096, 0106]. The customer may pay a fee to play the game, *See* Walker ‘888, paragraph [0022], or alternatively, the customer may provide an entry form and submit it to a cashier of the retailer for playing a game to win the product. *See* Walker ‘888, paragraph [00130]. Thus, the system taught Walker ‘888 takes a completely different approach to managing the income-to-expense ratio. Where the Walker ‘888 system gathers income from users on a per-play basis, the present principles are directed to maintaining the income-to-expense ratio by changing the odds of winning based on, for example, a predetermined prize budget.

Furthermore, Walker ‘888 fails to teach, disclose, or render obvious the Claim 10 elements of “automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment or requesting the first option, and a second option to purchase the product.” There is no teaching in

Walker '888 of the user playing the game without the user requesting the first option to play the game. According to the present principles, the user has the option of playing the game to win a product without making any payment and without requesting the option to play the game.

Furthermore, Walker '765 also fails to teach, disclose, or render obvious at least the Claim 10 elements of “generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome . . . displaying the outcome indicator to the user.” However, the Examiner stated at page 6 of the office action dated April 22, 2009 that Walker '765 teaches “that it is old and well known in the gaming art to play different games of chance in a game machine and obtain different outcomes from said playing . . . the need for an user to enter a PIN number to play a game, where said PIN number is generated by the system (see col 11, lines 1-15) but said PIN is not needed to determine the probability of winning said game as said probability of winning is calculated independently of said PIN number . . . Walker (888) would allow customer to play different games of chance, where the probability of winning said game of chance would be independent of a PIN number needed to play said game”. *See* Final Office Action dated April 22, 2009, page 6, second paragraph – page 7, first paragraph. Applicants argue that the supporting paragraphs in Walker '765 do not constitute a teaching of this particular claim step.

Walker '765 teaches an amusement device and a method wherein a user may play a secondary game of chance and determining an outcome based on the game requirements of the secondary game, *See* Walker '765 col. 2, lines 25-65. The system requires a user to register and receive a player identifier in order to enable the player to select a secondary game in which to participate, *See* Walker '765, col. 10, lines 57-58. The secondary game may include a game bonus amount that is redeemed by the player upon completing the requirements of the secondary

game. *See* Walker '765, col. 14, lines 43-47. The probability of receiving a game bonus amount may be adjusted according to completion times or supplemented to encourage play at off-peak hours, with the probability calculated on receiving an additional monetary payoff as a game bonus amount. However, Walker '765 fails to teach, render obvious, or even suggest, the feature of "generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome", "the outcome indicator is representative of a winning trial outcome or a losing trial outcome", "the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution", "the first statistical distribution has a distribution which is different from the second statistical distribution", and "displaying the outcome indicator to the user". There is no teaching in Walker '765 of generating an outcome indicator having a probability that is independent of the probability of generating a trial outcome. In fact, Walker '765 teaches receiving a monetary game bonus amount and does not teach, as the Examiner indicate, a probability of an outcome indicator in the secondary game. Walker '765 teaches determining an outcome that is analyzed based on the game requirements. *See* Walker '765, Col. 2, lines 55-67. Thus, Walker '765 does not teach displaying an outcome indicator representative of a winning or losing trial outcome with a winning trial outcome having a statistical distribution that is difference from the distribution associated with a trial outcome. Similarly, bottomdollar.com fails teach, suggest, or render obvious the above-cited elements of Claim 10.

Thus, the present principles disclose a novel system with an option to win the item sought. This represents a vast improvement over the prior art. Further, the cited references neither teach nor suggest the novel and non-obvious features of this invention.

Applicants, therefore, respectfully request the Board's withdrawal of the Examiner's §103(a) rejection of Claim 1. Furthermore, as Claims 1, 15, 21, 22, 33, 35, 36, and 37 stand or fall with Claim 10, the Applicants respectfully assert that Claims 1, 15, 21, 22, 33, 35, 36, and 37 are patentable over the cited prior art references for at least the same reasons as those discussed above for Claim 10, and respectfully request the Board's withdrawal of the Examiner's §103(a) rejection of Claims 1, 15, 21, 22, 33, 35, 36, and 37.

**B. Claims 3-5 and 29-30 Are Patentable Over the Prior Art Because the Combination of References Fail to Teach Every Element of the Claims**

Claims 3-5 and 29-30 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Walker '888 in view of bottomdollar.com and Walker '765, in further view of Yoseloff *et al.*, United States Patent No. 6,331,143 (hereinafter, "Yoseloff"). In the Office Action dated April 22, 2009, the Examiner asserted that the "Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated number" *See* Office Action dated April 22, 2009, page 18, first paragraph. According to the Examiner, it would have been obvious to combine Yoseloff with Walker'888 and bottomdollar.com to know that "Walker '888 and bottomdollar.com system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number", as claimed in claims 3 and 29. *Id.*

The Applicants assert that Claims 3-5 and 29-30 are patentable over the combination of Walker '888, bottomdollar.com, Walker '765, and Yoseloff because these four cited prior art

references fail to teach, suggest, or render obvious in any way, all of the limitations of claims 3-5, 29, and 30.

Claims 3 and 29 recite similar elements, and were addressed together by the Examiner with a single argument. Claims 4 and 5 depend from claim 3, and, thus, stand or fall with Claim 3. Claim 3 depends directly from Claim 1, and recites “wherein the display comprises a user-chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number.”

Claim 3 recites the feature of indicating a winning or losing outcome by displaying a comparison number, *See, e.g.*, outcome number in paragraph [0058], for comparison to a user’s chosen number. Matching the comparison number to the user’s number indicates a winning outcome “corresponding to the calculated probability of winning,” as recited in claim 1. Applicants particularly draw the Board’s attention to the fact that the comparison number is an element used for display. The specification clearly discloses that “if the pseudo-random event trial returns true, the odds management component 107 causes a winning display to be presented to the user. Otherwise, the odds management component 107 causes a losing display to be displayed to the user.” *See, e.g.*, paragraph [0092] of U.S. Patent App. Pub. No. 2002/0138342 (Application Serial Number 09/759,013) (hereinafter “the ‘342 application”). The probability of winning is preferably independent of the outcome number and PIN”, *See, e.g.*, paragraph [0093] of the ‘342 application, while the winning trial outcome a calculated probability of winning recited in claim 1 is used to actually determine whether a user wins the game being played.

In contrast, as cited by the Examiner, *See* Office Action dated April 22, 2009, Yoseloff teaches a video numbers game, similar to a lottery. *See* Yoseloff, Col. 3, lines 37-57, Col. 4,



lines 30-39. The numeric embodiment discussed by Yoseloff covers “a game which is similar to a daily numbers game...a single four digit number is selected by the player and a single four digit number is randomly selected by the microprocessor.” *See*, Yoseloff, Col. 8, lines 35-43.

Under Yoseloff, the odds of a user winning the game are determined by the number of symbols or size of the number range from which the user may select. *See, e.g.*, Yoseloff, Col. 8, lines 37-42. Therefore, a user’s odds of winning are fixed in relation to the preselected number of symbols. Yoseloff reiterates this point by stating “in the most preferred embodiment of the present invention, payout amounts for the basic numbers game are based solely on the probability of occurrence of each winning outcome without consideration for either the amount already wagered in the game or any other occurrence of a similar winning outcome”, *See* Yoseloff, Col. 4, lines 55-60, and “[t]he present invention contemplates using one or more types of symbols to alter the odds and allow for progressive versions of the game. For example, the four ball example of the present invention could be played with two different ball colors in the set. Alternatively, a much larger set of one type of symbols could be used.” *See* Yoseloff, Col. 9, lines 21-26. The player selects either a three or four digit number and wins the game if a single random winning number combination selected by the system matches the player-selected number. *See* Yoseloff, Col. 8, lines 35-50.

Therefore, Yoseloff teaches that the odds of winning are equal to the odds of matching the preselected number of symbols based on statistical analysis. Yoseloff discloses that the odds of winning are determined by changing the number of possible combinations, and that the outcome is random. Yoseloff teaches a system where the budgeted amount paid as winnings cannot be controlled – a random chance of winning could lead to multiple sequential winners, exhausting a budget with the first user. Furthermore, the number generated by the processor in

Yoseloff is a randomly drawn number that is used to match the user's chosen numbers, similar to a lottery. Yoseloff does not disclose any method for controlling a user's odds of winning, a feature that is a clear advantage in the instant claims. The comparison number disclosed in the specification is an element used for communicating a winning result to the user. However, the comparison number is merely used for display, and not for calculating a winning or losing outcome. Therefore, the comparison number is used as a display and does not equate to Yoseloff's numbers that determine the outcome of the lottery game.

Claim 3 recites that the displayed user-selected and comparison numbers *indicate* the event trial outcome. Thus, the trial outcome is separate from the displayed numbers of Claim 3. According to the present principles, the odds of winning a particular prize may be modified or tweaked based on the number of previous wins, the current prize budget, or the like. *See* the '342 application, pages 3-4, paragraphs [0058-0094]. It would be impossible to apply the fixed probabilities of Yoseloff to Claim 3 without significantly modifying the goals, process, and results of Yoseloff or Claim 3.

It would not be obvious to even a highly skilled practitioner of the art to use the number comparison taught by Yoseloff, singly, or in any combination with Walker '888, bottomdollar.com, and Walker '765, to develop the display or the results recited in Claim 3 as Yoseloff teaches a random number generator using the number to determine a winning number as well as being used as a display for the winning number. Similarly, when taken singly, or in any combination, Walker '888, bottomdollar.com, Walker '765, and Yoseloff fail to anticipate, suggest, or render obvious in any way, all of the elements of Claim 29.

Claims 3-5 depend from independent claim 1, while claims 29 and 30 depend, either directly or indirectly from independent Claim 22. Applicants respectfully reassert that

independent Claims 1 and 22 are patentable over the combination of the cited prior art references Walker '888, bottomdollar.com, and Walker '765. Due to their dependencies on Claims 1 and 22, respectively, Claims 3-5 and 29-30 are patentable for at least the same reasons as Claims 1 and 22.

Claims 4 and 5 depend directly from claim 3, and by their dependencies, include all of the features and elements recited in claim 3. Therefore, claims 4 and 5 are patentably distinct and non-obvious over the cited combination of Walker '888, bottomdollar.com, Walker '765 and Yoseloff for at least the same reasons as Claim 3. In light of such non-obviousness, Applicants respectfully solicit the Board's reversal of the Examiner's §103 rejection of Claims 3-5 and 29.

Similarly, claim 30 depends either directly or indirectly from claim 3, and by its dependency, includes all of the features and elements recited in claim 3. Therefore, claim 30 is patentably distinct and non-obvious over the cited combination of Walker '888, bottomdollar.com, Walker '765 and Yoseloff for at least the same reasons as claim 3. In light of such non-obviousness, Applicants respectfully solicit the Board's reversal of the Examiner's §103 rejection of Claim 30.

Claim 30 depends from Claim 29, and recites "The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor."

The Examiner asserts that "Walker '888 teaches "wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor." See Office Action dated April 22, 2009, page 20. The Examiner appears to have equated not paying an explicit fee to play a game, as taught by Walker '888, with

increasing the probability of winning in exchange for participating in an online survey, as recited in Claim 30. Applicants respectfully dispute the Examiner's assertion that these two method steps are equivalent.

In fact, Walker '888 teaches that a third-party merchant may pay a retailer for any advertisements that are viewed by the user. Benefits accrued to the retailer may be passed along to the user through the retailer giving away a "certain percentage of products." In some cases, the third-party merchant may pay the retailer for the cost of the product won by the user. Applicants respectfully traverse the Examiners assertions that "giving away a certain percentage of products" equates to an increased probability of the user winning the product or service. In fact, giving away a percentage of products could easily imply that there are more prizes to be won by the user. It also suggests that the user could win multiple prizes without necessarily increasing the odds of winning more games. Therefore, even a practitioner highly skilled in the art would not look to Walker '888 to provide a solution for increasing a user's odds of winning by performing a task because Walker '888 teaches that there are a greater number of prizes to be won while the invention as claimed requires that "the user can increase the probability of inning the product or service by participating in an online survey for an advertising sponsor".

Therefore, Applicants respectfully submit that Walker '888, bottomdollar.com, and Walker '765, taken singly or in combination, fails to teach, suggest, or obviate , *inter alia*, the claimed elements of Claims 3-5 and 29-30. Applicants respectfully solicit the Board's reversal of the Examiner's §103(a) rejection of Claims 3-5 and 29-30.

**C. Claims 1, 10, 15, 21-22, 33, and 35-37 are patentable under 35 U.S.C. §112, second paragraph because the claims particularly point out and distinctly claim the invention**

The Examiner rejected Claims 1, 10, 15, 21-22, 33, and 35-37 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Examiner stated that the aforementioned claims recite “wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution.” *See* Office Action of April 22, 2009, page 3, first paragraph. In the opinion of the Examiner, the claims are rejected under 35 U.S.C. § 112, second paragraph because “the PIN number needed to play the game is not the one that determines if a user would win a game as the trial outcome is independent of the outcome number and PIN.” *See* Office Action of April 22, 2009, pages 3-4. The Examiner failed to particularly identify the reasons for the 35 U.S.C. § 112, second paragraph rejection.

The Examiner rejected independent Claims 1, 10, 15, 21-22, 33, and 35-37 by applying the same arguments to each claim. Applicant respectfully asserts that Claim 1 is representative of independent Claims 10, 15, 21-22, 33, and 35-37, and that these independent claims stand or fall together.

In order for a claimed invention to be rejected under 35 U.S.C. § 112, second paragraph, the essential inquiry is whether the claims set out and circumscribe a particular subject matter

with a reasonable degree of clarity, and claim language must be analyzed in light of: 1) the content of the particular application disclosure; 2) the teachings of the prior art; and 3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2173.02. However, as noted by *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979), agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. § 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section. *Id.* at § 2172 (II). Furthermore, “the fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification.” *Id.* at § 2173.01.

As the office action does not specifically identify the reasons for the 35 U.S.C. § 112, second paragraph rejection, Applicants presume that this § 112 rejection is based on an inconsistency between claim language and the specification. Applicants respectfully traverse the 35 U.S.C. § 112, second paragraph rejection and assert that Applicants’ specification is consistent with claim language asserted in Claim 1. As noted therein, Claim 1 requires, *inter alia*, a system for generating a trial outcome of an event trial, and displaying a winning or a losing trial outcome through an outcome indicator. *See, e.g.*, paragraph [0032]. The system displays the outcome indicator to the user where “[t]he outcome of the trial determines whether a winning display or a losing display is presented to the user”. *See, e.g.*, the ‘342 application, paragraph [0093]. As such, an outcome indicator is an element merely used to display either a winning trial outcome or a losing trial outcome, however, the primary difference being the

information that is displayed to the user to signify either a winning or a losing trial outcome. *See, e.g., the '342 application, [0058], [0093].* The calculated probability of winning the trial event is independent of any PIN number. *See, e.g., the '342 application, paragraph [0093].* Applicants particularly draw the Board's attention to language identified in the specification that states "if the pseudo-random event trial returns true, the odds management component 107 causes a winning display to be presented to the user. Otherwise, the odds management component 107 causes a losing display to be displayed to the user." *See, e.g., paragraph [0092].* The probability of winning is preferably independent of the outcome indicator, which includes an outcome number or a user PIN. *See, e.g., the '342 application, paragraph [0093].* The winning trial outcome requires a calculated probability of winning, recited in claim 1, which is used to determine whether a user wins the game being played.

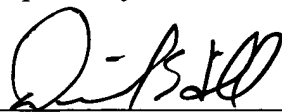
Therefore, Applicants respectfully submit that Claims 1, 10, 15, 21-22, 33 and 35-37 are patentable under 35 U.S.C. §112, second paragraph because the claims particularly point out and distinctly claim the invention. Applicants respectfully solicit the Board's reversal of the Examiner's §112, second paragraph rejection of Claims 1, 10, 15, 21-22, 33 and 35-37.

### **IX. CONCLUSION**

For at least the foregoing reasons, Applicant respectfully solicits the Board's reversal of the Examiner's rejections of Claims 1-11, 13-16, and 18-37.

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Respectfully submitted,



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## **APPENDIX I: CLAIMS**

1. A method of providing a user with a game of chance, the method comprising the steps of:  
receiving electronic signals from a user system representing search parameters  
descriptive of a product;

retrieving at least one product information from at least one database storing independent  
third-party retail vendor product information;

transmitting electronic signals to the user system representing the retrieved product  
information and associated prices;

automatically providing the user with an option to play a game to win a selected product  
from said product information without the user first making any payment or requesting the  
option;

electronically calculating a dynamic probability of winning the selected product by the  
user based on one or more factors selected from a group consisting of: the cost of the selected  
product in relation to the total cost of all products available, a current prize budget, a ratio of the  
current prize budget to a total amount of funds received, and the user's behavior during a user  
session;

electronically and randomly generating a trial outcome of an event trial, the probability of  
the event trial generating a winning trial outcome corresponding to the calculated probability of  
winning;

generating an outcome indicator, wherein the outcome indicator is generated  
independently of the trial outcome, and wherein the outcome indicator is representative of a  
winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a



winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution; and

displaying the outcome indicator to the user; and in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user.

2. The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system.
3. The method of claim 1, wherein the display comprises a user-chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number.
4. The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number.
5. The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number.

6. The method of claim 1, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation to the provider of the game of chance.

7. The method of claim 1, comprising calculating a probability of winning based on at least a current budget.

8. The method of claim 1, comprising calculating a probability P of winning based on a total number of game players.

9. The method of claim 1, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;

and

$N$  is a number of current users.

10. A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

retrieving at least one product information from at least one database storing independent third-party retail vendor product information;

transmitting electronic signals to the user system representing at a least one product, a price of the product and the independent third-party retail vendor of the product;

automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment or requesting the first option, and a second option to purchase the product;

if the user chooses to play the game:

electronically calculating a dynamic probability of winning the product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning;

generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical

distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution;

displaying the outcome indicator to the user; and

in response to a winning trial outcome, purchasing the product for the user from the independent third-party retail vendor at no cost to the user; and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product.

11. The method of claim 10, comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party provides compensation to the provider of the game of chance.

12. (Canceled)

13. The method of claim 10, comprising calculating a probability P of winning based on a total number of game players.

14. The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;  
and

$N$  is a number of current users.

15. A method of providing a user with a game of chance, the method comprising:
  - receiving electronic signals from a user system representing at least one search parameter descriptive of a product;
  - retrieving at least one product information from at least one database storing independent third-party retail vendor product information;
  - transmitting electronic signals to the user system representing a plurality of different independent third-party retail vendors and associated prices charged by each of said different independent third-party retail vendors for products identified in response to said at least one search parameter;
  - automatically transmitting electronic signals to the user system representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and
  - if the user chooses to play the game:
    - electronically calculating a dynamic probability of winning said selected one product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current

prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning;

generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution;

displaying the outcome indicator to the user; and

in response to a winning trial outcome, purchasing said selected one product from a corresponding independent third-party retail vendor for the user at no cost to the user.

16. The method of claim 15, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation to the provider of the game of chance.

17. (Canceled)

18. The method of claim 15, comprising calculating a probability P of winning based on a total number of game players.

19. The method of claim 15, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;

and

$N$  is a number of current users.

20. The method of claim 15, wherein the electronic signals representing the associated prices charged by each of said different dealers, represent the prices charged on said each of said different dealers' own web sites.

21. A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

searching for products matching said at least one search parameter;

transmitting electronic signals to the user system representing a plurality of independent third-party retail vendors and associated prices charged by each of said independent third-party retail vendors for products identified in response to said at least one search parameter, each of the products identified being offered for sale on a corresponding web site of each independent third-party retail vendor;

automatically transmitting electronic signals to the user representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and

if the user chooses to play the game:

electronically calculating a dynamic probability of winning said selected one product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning;

generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical



distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution;

displaying the outcome indicator to the user; and

in response to a winning trial outcome, purchasing said selected one product from a corresponding independent third-party retail vendor for the user at no cost to the user.

22. A method for providing a user an opportunity to win a product or service by playing a game of chance without buying the product or service and without paying a fee to play, comprising the steps of:

enabling the user to submit a search query associated with a type of product or service;

conducting a search in a database for an independent third-party retail vendor product or service that satisfies the search query;

automatically presenting a result of the search to the user, including at least one product or service offered for sale by the independent third-party retail vendor retrieved from the database, along with an option to play the game;

enabling the user to select the product or service that he wants to win;

dynamically determining the user's chance of winning the selected product or service based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

generating a trial outcome for each play of the game wherein the probability of the trial outcome generating a winning trial outcome corresponds to the user's chance of winning;

generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution; and

displaying the outcome indicator to the user.

23. The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user, and at no cost to the user, if the outcome for the play of the game is a win.

24. The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of enabling the user to increase the chance of winning the selected product or service through repeated plays of the game.

25. The method for providing a user an opportunity to win a product or service of claim 22 wherein the step of determining the user's chance of winning the selected product or service is a function of at least one of a cost of the product or service, a number of other users playing to win the product or service concurrently, a current prize budget and an amount of funds received from an advertising sponsor.

26. The method for providing a user an opportunity to win a product or service of claim 25 wherein the advertising sponsor provides funds for the purchase of the selected product or service to a game provider as a payment for a display of an advertisement to the user during each play of the game.

27. The method for providing a user an opportunity to win a product or service of claim 25 wherein the step of determining the user's chance of winning the selected product or service is a function of the user's behavior during repeated plays of the game.

28. The method for providing a user an opportunity to win a product or service of claim 26 wherein the user's repeated plays of the game generates revenue from the advertising sponsor paid to a game provider which increases the user's chance of winning the selected product or service.

29. The method for providing a user an opportunity to win a product or service of claim 22 wherein the game of chance comprises displaying a number selected by the user along with the number generated to represent the outcome for each play of the game.

30. The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor.

31. The method of Claim 1, further comprising collecting a database of independent third party retail vendor product information prior to receiving the search parameters from the user.

32. The method of Claim 1 whereby transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the independent third party retail vendor and a link to initiate playing to win the same product.

33. A method for increasing user traffic to a search engine website, comprising:

receiving a search query from a user system interacting with a search webpage of the website, the search query defining a desired product for the user; and

transmitting a results webpage to the user system, the results webpage including at least one link for redirection to an independent third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to the independent third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product at no cost to the user, the link corresponding to the independent third party website redirection link;

electronically calculating a dynamic probability of winning the corresponding product by the user;

electronically and randomly generating a trial outcome of an event trial, the probability of the event trial generating a winning trial outcome corresponding to a determined probability of winning;

generating an outcome indicator wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution;

displaying the outcome indicator to the user; and

in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user.

34. The method of claim 33, wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the independent third party vendor corresponding to the independent third party website redirection link.

35. A method for increasing user traffic to a search website, comprising:

providing a search webpage containing a search interface for a user to submit a search query for a product;

receiving a search query from a user employing said search webpage;

searching independent third party websites by reference to said query;

retrieving product information and corresponding price from the independent third party websites for at least one products satisfying said query;

providing a game of chance in response to a user selection of the link to win the product;

purchasing the product from the independent third party for the user response to a favorable outcome in said game;

transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the independent third party website, and a link to win the product;

providing a game of chance in response to a user selection of the link to win the product, wherein the probability of winning the product by the user is dynamically calculated based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

generating an outcome indicator, wherein the outcome indicator is generated independently of the probability of winning, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the probability of winning has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution;

displaying the outcome indicator to the user; and

purchasing the product from the independent third party for the user in response to a favorable outcome in said game and providing said product to the user at no cost to the user.

36. A product search website executing on a server storing a plurality of web pages, the website compromising:

a search page for a user submitting a query to the server for at least one product;

a results webpage transmitted to the user, the results page including links to an independent third party website and a link to a play webpage of the website;

a play webpage providing a game of chance for winning the at least one product corresponding to a selected play link from the results webpage, wherein a probability of winning the at least one product by the user is dynamically calculated based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session; and

a product win webpage to display an outcome indicator indicating a favorable outcome in said game of chance for the at least one product, wherein the outcome indicator is generated independently of the probability of winning, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a favorable outcome has a distribution associated with a first statistical distribution and the probability of winning has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution.

37. A computer-implemented method, comprising the steps of:

receiving a search request for a product, wherein the search request is transmitted from a communication device associated with or used by a user;

processing the search request with a processing device;

generating a message, wherein the message contains information regarding at least one product offered by a retail vendor, product information regarding the at least one product, and at least one price associated with the at least one product;

transmitting the message to the communication device;

automatically providing the user with an option to play a game to win a selected product from the product information regarding the at least one product without the user first making any payment or requesting the option;

electronically calculating a dynamic probability of winning the selected product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received, and the user's behavior during a user session;

electronically and randomly generating a trial outcome for a game of chance, wherein the probability of the game of chance generating a winning trial outcome corresponds to the calculated probability of winning;

generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein



the first statistical distribution has a distribution which is different from the second statistical distribution;

displaying the outcome indicator to the user; and

in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user.

## **APPENDIX II: EVIDENCE**

Exhibit 1: Final Office Action Dated April 22, 2009

Exhibit 2: Amendment and Response to Non-Final Action dated February 5, 2009

Exhibit 3: Non-Final Office Action dated August 5, 2008

### **APPENDIX III: RELATED PROCEEDINGS**

Exhibit 4: Final Office Action dated May 21, 2007

Exhibit 5: Appeal Brief dated March 4, 2008

Exhibit 6: Request for Continued Examination and Amendment, dated May 8, 2008

Exhibit 7: Final Office Action dated June 27, 2005

Exhibit 8: Pre-Appeal Brief Request for Review, dated September 26, 2005

Exhibit 9: Panel Decision from Pre-Appeal Brief Review, dated December 13, 2005

# EXHIBIT 1



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	632-001	1839
27776	7590	04/22/2009		
WARD & OLIVO SUITE 300 382 SPRINGFIELD AVENUE SUMMIT, NJ 07901			EXAMINER LASTRA, DANIEL	
			ART UNIT 3688	PAPER NUMBER
			MAIL DATE 04/22/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/759,103	CLARK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	DANIEL LASTRA	3688	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-16 and 18-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-16 and 18-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-11, 13-16 and 18-37 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

### **Response to Amendment**

2. In response to Non Final Rejection filed 08/05/2008, the Applicant filed an Amendment on 02/05/2009, which amended claims 1, 10, 15, 21, 22, 33, 35, 36, and added new claim 37.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22, 35 and 36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transforms a particular article to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fail to meet the above requirements because the steps are

Art Unit: 3688

neither tied to a particular machine or apparatus nor transforms a particular article to a different state or thing.

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 10, 15, 21, 22, 33 and 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recite "*wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution*".

For purpose of art rejection said limitation would be interpreted in light of Applicant's specification as needing PIN number to play the game and that the probability of winning (i.e. trial outcome) is independent of an outcome number and PIN. If the trial outcome is a win for the user, the outcome number displayed matches the PIN number but if the trial outcome is a non-win, the displayed outcome number will differ from the user's PIN (see Applicant's specification page 14, lines 15-25; page 18, line 23 – page 19, line 5). Therefore, according to Applicant's specification, the PIN number needed to play the game is not the one that determines if a user would win a game as the trial



outcome is independent of the outcome number and PIN (see Applicant's specification page 18, lines 22-23).

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6-11, 13-16, 18-26, 27, 28, 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 2003/0054888) in view of bottomdollar.com (<http://www.web.archive.org/web/19991013040730/http://bottomdollar.com/index.html>) and further in view of Walker (US 6,364,765).

As per claims 10 and 20-22, Walker (888) teaches:

A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing at a least one product, a price of the product and a third-party retail vendor of the product (see Walker paragraphs 38 and 39).

automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment

Art Unit: 3688

(see Walker paragraph 130), or requesting the first option and a second option to purchase the product (see Walker paragraphs 34; 149);

if the user chooses to play the game:

electronically calculating a dynamic probability of winning the product by the user based on one more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the, user's behavior during a user session (see Walker paragraphs 89, 94, 98, 110). Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124).

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning (see Walker paragraph 144);

in response to a winning trial outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39) at no cost to the user (see paragraph 130);

and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product (see Walker paragraph 34,149-151);

Art Unit: 3688

Walker does not expressly teach retrieving at least one product information from at least one database storing independent third-party retail vendor product information. However, bottomdollar.com teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest and receive back a comparative list of independent third party retail vendors of said item giving users the option to buy said item from a selected vendor in said list (see bottomdollar.com pages 1 and 2). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would display to users a list of different independent third-party providers vendors of users' selected products, as taught by bottomdollar.com, where said users would have the opportunity to play a game to win said products in order to enable said users the purchase of products from competing product providers, therefore obtaining the best price, with the added incentive of allowing said users to even play a game in order to obtain said products for free (see Walker paragraphs 125, 130).

Walker does not teach and generating an outcome indicator *wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical*

Art Unit: 3688

*distribution has a distribution which is different from the second statistical distribution;*

displaying the outcome indicator to the user. However, Walker (765) teaches that it is old and well known in the gaming art to play different games of chance in a game machine and obtain different outcomes from said playing (see col 2, lines 25-65). Walker (765) teaches the need for an user to enter a PIN number to play a game, where said PIN number is generated by the system (see col 11, lines 1-15) but said PIN is not needed to determine the probability of winning said game as said probability of winning is calculated independently of said PIN number (see col 15, lines 15-25) Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker (888) would allow customer to play different games of chance, where the probability of winning said game of chance would be independent of a PIN number needed to play said game, as taught by Walker (765) in order to adjust the probability of winning a product based upon requirements of said game.

As per claim 1, Walker (888) teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing search parameters descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing the retrieved product information and associated prices (see Walker figure 6).

automatically providing the user an option to play a game to win a selected product from said product information without the user first making any payment (see paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a dynamic probability of winning the selected product by the user based on one more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the, user's behavior during a user session (see Walker paragraphs 89, 94, 98, 110). Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124);

electronically and randomly generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning (see Walker paragraph 144);

in response to a winning trial outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39) at no cost to the user (see paragraph 130);

Walker does not expressly teach retrieving at least one product information from at least one database storing independent third-party retail vendor product information and generating an outcome indicator *wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome*

*indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution and displaying the outcome indicator to the user. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 1*

As per claim 15, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing a plurality of different third-party retail vendors and associated prices charged by each of said different third-party retail vendors for products identified in response to said at least one search parameter (see Walker figure 6).

automatically transmitting electronic signals to the user system representing an option to play a game to win a selected product or service without the user first making any payment (see Walker paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a dynamic probability of winning said selected one product by the user based on one more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a

Art Unit: 3688

current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session (see Walker paragraphs 89, 94, 98, 110). Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124);

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning (see Walker paragraph 144);

in response to a winning trial outcome, purchasing said selected one product (see Walker paragraph 145) from a corresponding third-party retail vendor for the user (see Walker paragraph 39) at no cost to the user (see paragraph 130);

Walker does not expressly teach retrieving at least one product information from at least one database storing independent third-party retail vendor product information and generating an outcome indicator *wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution* and displaying the outcome indicator to the user. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 15.

As per claims 6, 11, 16, 26, 28 Walker teaches:

comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party, such as a game provider, provides compensation to the provider of the game of chance (see paragraphs 124-125).

As per claims 7, 12 , Walker teaches:

calculating a probability of winning based on at least a current budget (see Walker paragraph 144).

As per claims 8, 13 and 18, Walker teaches:

calculating a probability  $P$  of winning based on a total number of game players (see Walker paragraph 110).

As per claim 23, Walker teaches:

providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user and at no cost to the user, if the outcome for the play of the game is a win (see Walker paragraphs 129-131).

As per claim 25, the same rejection applied to claims 7-8 is also applied to claim 25.

As per claims 2, 24 and 27, Walker teaches:

wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system (see Walker paragraphs 26 and 89).



Art Unit: 3688

As per claims 9, 14 and 19, Walker teaches:

calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

Walker does not expressly teach Pa is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see Walker paragraph 143).

Pt is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

Pm is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

Pu is probability factor that varies with the user's behavior during a user session (see Walker paragraph 88); and

N is a number of current users (see Walker paragraph 110).

As per claim 31, Walker fails to teach:

collecting a database of independent third party retail vendor product information prior to receiving the search parameters from the user. However, bottomdollar.com teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest and

receive back a comparative list of independent third party retail vendors of said item giving users the option to buy said item from a selected vendor in said list (see [bottomdollar.com](http://bottomdollar.com) pages 1 and 2). Walker also teaches in figure 6, third party manufacturers of products (see “campbell’s, Volvo, sony”). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would be motivated to display to users a list of different independent third-party providers vendors of users’ selected products, as taught by [bottomdollar.com](http://bottomdollar.com), where said users would have the opportunity to play a game to win said products in order to enable said users the purchase of products from competing product providers, therefore obtaining the best price, with the added incentive of allowing said users to even play a game in order to obtain said products for free (see Walker paragraphs 125, 130).

As per claim 32, Walker teaches:

transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the third party retail vendor and a link to initiate playing to win the same product (see Walker paragraph 39). Walker does not expressly teach that said retail vendor is an independent retail vendor. However, the same rejection applied to claim 1 regarding this missing limitation is also applied to claim 32.

As per claims 33 and 37, Walker teaches:

A method for increasing user traffic to a search engine website, comprising:

transmitting a results webpage to the user system, the results webpage including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to said third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product at no cost to the user corresponding to the third party website redirection link (see Walker paragraphs 39 and 132).

*electronically calculating a dynamic probability of winning the corresponding product by the user (see Walker paragraphs 89, 94, 98, 110). Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124);*

*electronically and randomly generating a trial outcome of an event trial, the probability of the event trial generating a winning trial outcome corresponding to a determined probability of winning (see Walker paragraph 144);*

*in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user (see paragraph 30).*

Walker fails to teach receiving a search query from a user system interacting with a search webpage of the website, the search query defining a desired product for the user and that said third party vendor website is an independent vendor website and generating an outcome indicator *wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome*

Art Unit: 3688

*indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution and displaying the outcome indicator to the user. However, bottomdollar.com teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest and receive back a comparative list of independent third party retail vendors of said item giving users the option to buy said item from a selected vendor in said list (see bottomdollar.com pages 1 and 2). Therefore, the same rejection applied to claim 1 regarding this missing limitation is also applied to claims 33 and 37.*

As per claim 34, Walker does not expressly teach:

wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the independent third party vendor corresponding to the third party website redirection link. However, bottomdollar.com teaches a search engine website which facilitates the purchase of a product from a independent third party vendor (see Roll paragraph 57). Therefore, the same rejection applied to claim 33 is also applied to claim 34.

As per claims 35 and 36, Walker teaches:

A method for increasing user traffic to a search website, comprising:

retrieving product information and corresponding price from said third party websites for at least one products satisfying said query (see Walker paragraphs 38-39);

providing a game of chance in response to a user selection of the link to win the product; and purchasing the product from the third party for the user response to a favorable outcome in said game; transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the third party website, and a link to win the product (see Walker paragraphs 38-40);

providing a game of chance in response to a user selection of the link to win the product (see Walker paragraph 40); and

purchasing the product from the third party for the user in response to a favorable outcome in said game (see Walker paragraph 41).

wherein the probability of winning the product by the user is dynamically calculated based on one more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the, user's behavior during a user session (see Walker paragraphs 89, 94, 98, 110). Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124);

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning (see Walker paragraph 144);

in response to a winning trial outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39) at no cost to the user (see paragraph 130);

Walker fails to teach:

providing a search webpage containing a search interface for a user to submit a search query for a product; receiving a search query from a user employing said search webpage; searching independent third party websites by reference to said query and generating an outcome indicator *wherein the outcome indicator is generated independently of the probability of winning, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the probability of winning has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution*; displaying the outcome indicator to the user. However, the same rejection applied to claim 33 regarding these missing limitations is also applied to claim 35.

Claims 3-5, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of bottomdollar.com

(<http://www.web.archive.org/web/19991013040730/http://bottomdollar.com/index.html>) and further in view

Walker (US 6,364,765) and Yoseloff (U.S. 6,331,143).

As per claims 3 and 29, Walker fails to teach:

wherein the display comprises a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see Yoseloff column 8, lines 35-50; column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker and bottomdollar.com system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker does not teach:

wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the

Art Unit: 3688

corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a system (see Yoseloff column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker does not expressly mention:

wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. However, Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to the provider of the products (see Walker paragraph 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to



the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

As per claim 30, Walker teaches:

wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor (see paragraph 124).

### ***Response to Arguments***

Applicant's arguments filed 02/05/2009 have been fully considered but they are not persuasive. The Applicant argues that Walker does not teach and generating an outcome indicator *wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution*; displaying the outcome indicator to the user. However, Walker (765) teaches that it is old and well known in the gaming art to play different games of chance in a game machine and obtain different outcomes from said playing (see col 2, lines 25-65). Walker (765) teaches the need for an user to enter a PIN number to play a game, where said PIN number is generated by the system (see col 11,

lines 1-15) but said PIN is not needed to determine the probability of winning said game as said probability of winning is calculated independently of said PIN number (see col 15, lines 15-25) Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker (888) would allow customer to play different games of chance, where the probability of winning said game of chance would be independent of a PIN number needed to play said game, as taught by Walker (765) in order to adjust the probability of winning a product based upon requirements of said game.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Examiner, Art Unit 3688  
April 20, 2009

# EXHIBIT 2

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Clark, *et al.*

Serial No.: 09/759,103

Group Art Unit: 3688

Filed: January 12, 2001

Examiner: Daniel Lastra

For: SEARCH ENGINE PROVIDING AN  
OPTION TO WIN THE ITEM  
SOUGHT

Atty. Docket No.: 632-001

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**AMENDMENT AND RESPONSE TO OFFICE ACTION**

S I R:

This is an Amendment and Response To Office Action in reply to the Office Action, mailed August 5, 2008, wherein the Examiner rejected Claims 1-11, 13-16 and 18-36 in view of prior art references.

Based upon the following Amendments and Remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

Prior to further substantive examination, please amend the subject application as follows:

**IN THE ABSTRACT OF THE DISCLOSURE:**

Please delete the Abstract of the Disclosure and please substitute therefor the new Abstract of the Disclosure which is attached hereto on a separate sheet.

**IN THE CLAIMS:**

Please amend Claims 1, 10, 15, 21, 22, 33, 35, and 36, without prejudice, and please add new Claim 37, as provided in the following Listing of Claims. No new matter has been added.

**Listing of Claims:**

Claim 1. (Currently Amended) A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing search parameters descriptive of a product;

retrieving at least one product information from at least one database storing independent third-party retail vendor product information;

transmitting electronic signals to the user system representing the retrieved product information and associated prices;

automatically providing the user with an option to play a game to win a selected product from said product information without the user first making any payment or requesting the option;

electronically calculating a dynamic probability of winning the selected product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received, and the user's behavior during a user session;

electronically and randomly generating a trial outcome of an event trial, the probability of the event trial generating a winning trial outcome corresponding to the calculated probability of winning;

generating an outcome indicator ~~independent of, and differently distributed from, the trial outcome,~~ wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution; and

displaying the outcome indicator to the user; and in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user.

Claim 2. (Previously Presented) The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system.

Claim 3. (Previously Presented) The method of claim 1, wherein the display comprises a user-chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number.



Claim 4. (Previously Presented) The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number.

Claim 5. (Previously Presented) The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number.

Claim 6. (Previously Presented) The method of claim 1, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation to the provider of the game of chance.

Claim 7. (Previously Presented) The method of claim 1, comprising calculating a probability of winning based on at least a current budget.

Claim 8. (Previously Presented) The method of claim 1, comprising calculating a probability P of winning based on a total number of game players.

Claim 9. (Previously Presented) The method of claim 1, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:  
N

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;

and

$N$  is a number of current users.

Claim 10. (Currently Amended) A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

retrieving at least one product information from at least one database storing independent third-party retail vendor product information;

transmitting electronic signals to the user system representing at a least one product, a price of the product and the independent third-party retail vendor of the product;

automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment or requesting the first option, and a second option to purchase the product;

if the user chooses to play the game:

electronically calculating a dynamic probability of winning the product by the user based on one or more factors selected from a group consisting of: the cost of the

selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning;

~~generating an outcome indicator independent of, and differently distributed from, the trial outcome, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution;~~

displaying the outcome indicator to the user; and

in response to a winning trial outcome, purchasing the product for the user from the independent third-party retail vendor at no cost to the user; and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product.

Claim 11. (Previously Presented) The method of claim 10, comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party provides compensation to the provider of the game of chance.

Claim 12. (Canceled).

Claim 13. (Previously Presented) The method of claim 10, comprising calculating a probability P of winning based on a total number of game players.

Claim 14. (Previously Presented) The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;

and

$N$  is a number of current users.

Claim 15. (Currently Amended) A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

retrieving at least one product information from at least one database storing independent third-party retail vendor product information;

transmitting electronic signals to the user system representing a plurality of different independent third-party retail vendors and associated prices charged by each of said different independent third-party retail vendors for products identified in response to said at least one search parameter;

automatically transmitting electronic signals to the user system representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and

if the user chooses to play the game:

electronically calculating a dynamic probability of winning said selected one product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning;

generating an outcome indicator ~~independent of, and differently distributed from, the trial outcome,~~ wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial

outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution;

displaying the outcome indicator to the user; and

in response to a winning trial outcome, purchasing said selected one product from  
a corresponding independent third-party retail vendor for the user at no cost to the user.

Claim 16. (Previously Presented) The method of claim 15, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation to the provider of the game of chance.

Claim 17. (Canceled).

Claim 18. (Previously Presented) The method of claim 15, comprising calculating a probability P of winning based on a total number of game players.

Claim 19. (Previously Presented) The method of claim 15, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

P<sub>a</sub> is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

P<sub>t</sub> is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;  
and

$N$  is a number of current users.

Claim 20. (Previously Presented) The method of claim 15, wherein the electronic signals representing the associated prices charged by each of said different dealers, represent the prices charged on said each of said different dealers' own web sites.

Claim 21. (Currently Amended) A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

searching for products matching said at least one search parameter;

transmitting electronic signals to the user system representing a plurality of independent third-party retail vendors and associated prices charged by each of said independent third-party retail vendors for products identified in response to said at least one search parameter, each of the products identified being offered for sale on a corresponding web site of each independent third-party retail vendor;

automatically transmitting electronic signals to the user representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and

if the user chooses to play the game:

electronically calculating a dynamic probability of winning said selected one product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning;

generating an outcome indicator ~~independent of, and differently distributed from, the trial outcome,~~ wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution;

displaying the outcome indicator to the user; and

in response to a winning trial outcome, purchasing said selected one product from a corresponding independent third-party retail vendor for the user at no cost to the user.



Claim 22. (Currently Amended) A method for providing a user an opportunity to win a product or service by playing a game of chance without buying the product or service and without paying a fee to play, comprising the steps of:

enabling the user to submit a search query associated with a type of product or service;

conducting a search in a database for an independent third-party retail vendor product or service that satisfies the search query;

automatically presenting a result of the search to the user, including at least one product or service offered for sale by the independent third-party retail vendor retrieved from the database, along with an option to play the game;

enabling the user to select the product or service that he wants to win;

dynamically determining the user's chance of winning the selected product or service based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

generating a trial outcome for each play of the game wherein the probability of the trial outcome generating a winning trial outcome corresponds to the user's chance of winning;

generating an outcome indicator ~~independent of, and differently distributed from, the trial outcome,~~ wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution; and

displaying the outcome indicator to the user.

Claim 23. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user, and at no cost to the user, if the outcome for the play of the game is a win.

Claim 24. (Previously Presented) The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of enabling the user to increase the chance of winning the selected product or service through repeated plays of the game.

Claim 25. (Previously Presented) The method for providing a user an opportunity to win a product or service of claim 22 wherein the step of determining the user's chance of winning the selected product or service is a function of at least one of a cost of the product or service, a number of other users playing to win the product or service concurrently, a current prize budget and an amount of funds received from an advertising sponsor.

Claim 26. (Previously Presented) The method for providing a user an opportunity to win a product or service of claim 25 wherein the advertising sponsor provides funds for the purchase of the selected product or service to a game provider as a payment for a display of an advertisement to the user during each play of the game.

Claim 27. (Previously Presented) The method for providing a user an opportunity to win a product or service of claim 25 wherein the step of determining the user's chance of winning the selected product or service is a function of the user's behavior during repeated plays of the game.

Claim 28. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 26 wherein the user's repeated plays of the game generates revenue from the advertising sponsor paid to a game provider which increases the user's chance of winning the selected product or service.

Claim 29. (Previously Presented) The method for providing a user an opportunity to win a product or service of claim 22 wherein the game of chance comprises displaying a number selected by the user along with the number generated to represent the outcome for each play of the game.

Claim 30. (Previously Presented) The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor.

Claim 31. (Previously presented) The method of Claim 1, further comprising collecting a database of independent third party retail vendor product information prior to receiving the search parameters from the user.

Claim 32. (Previously presented) The method of Claim 1 whereby transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the independent third party retail vendor and a link to initiate playing to win the same product.

Claim 33. (Currently Amended) A method for increasing user traffic to a search engine website, comprising:

receiving a search query from a user system interacting with a search webpage of the website, the search query defining a desired product for the user; and

transmitting a results webpage to the user system, the results [[page]] webpage including at least one link for redirection to an independent third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to the independent third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product at no cost to the user, the link corresponding to the independent third party website redirection link~~[[.]]~~;

electronically calculating a dynamic probability of winning the corresponding product by the user;

electronically and randomly generating a trial outcome of an event trial, the probability of the event trial generating a winning trial outcome corresponding to a determined probability of winning;

generating an outcome indicator wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a

winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution;

displaying the outcome indicator to the user; and

in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user.

Claim 34. (Previously presented) The method of claim 33, wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the independent third party vendor corresponding to the independent third party website redirection link.

Claim 35. (Currently Amended) A method for increasing user traffic to a search website, comprising:

providing a search webpage containing a search interface for a user to submit a search query for a product;

receiving a search query from a user employing said search webpage;

searching independent third party websites by reference to said query;

retrieving product information and corresponding price from said the independent third party websites for at least one products satisfying said query;

providing a game of chance in response to a user selection of the link to win the product;

and

purchasing the product from the independent third party for the user response to a favorable outcome in said game;

transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the independent third party website, and a link to win the product;

providing a game of chance in response to a user selection of the link to win the product, wherein the probability of winning the product by the user is dynamically calculated based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

generating an outcome indicator ~~independent of, and differently distributed from, the probability of winning,~~ wherein the outcome indicator is generated independently of the probability of winning, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the probability of winning has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution;

displaying the outcome indicator to the user; and

purchasing the product from the independent third party for the user in response to a favorable outcome in said game and providing said product to the user at no cost to the user.

Claim 36. (Currently Amended) A product search website executing on a server storing a plurality of web pages, the website comprising:

a search page for a user submitting a query to the server for at least one product;

a results webpage transmitted to the user, the results page including links to an independent third party website and a link to a play webpage of the website;

a play webpage providing a game of chance for winning the at least one product corresponding to a selected play link from the results webpage, wherein ~~[[the]]~~ a probability of winning the at least one product by the user is dynamically calculated based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session; and

a product win webpage to ~~displaying~~ display an outcome indicator indicating a favorable outcome in said game of chance for ~~[[said]]~~ the at least one product, ~~the outcome indicator independent of, and differently distributed from, the probability of winning, wherein the outcome indicator is generated independently of the probability of winning, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a favorable outcome has a distribution associated with a first statistical distribution and the probability of winning has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution.~~

Claim 37. (New) A computer-implemented method, comprising the steps of:

receiving a search request for a product, wherein the search request is transmitted from a communication device associated with or used by a user;

processing the search request with a processing device;

generating a message, wherein the message contains information regarding at least one product offered by a retail vendor, product information regarding the at least one product, and at least one price associated with the at least one product;

transmitting the message to the communication device;

automatically providing the user with an option to play a game to win a selected product from the product information regarding the at least one product without the user first making any payment or requesting the option;

electronically calculating a dynamic probability of winning the selected product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received, and the user's behavior during a user session;

electronically and randomly generating a trial outcome for a game of chance, wherein the probability of the game of chance generating a winning trial outcome corresponds to the calculated probability of winning;

generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a



winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution;

displaying the outcome indicator to the user; and

in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user.

### **Remarks**

Claims 1-11, 13-16 and 18-37 are pending in this application. By this Amendment, Applicants have amended Claims 1, 10, 15, 21, 22, 33, 35 and 36, and added new Claim 37. Applicants have amended Claims 1, 10, 15, 21, 22, 33, 35 and 36 so as to more clearly distinguish the present invention, as defined by each of Claims 1, 10, 15, 21, 22, 33, 35 and 36, over the prior art. Applicant has also amended Claims 1, 10, 15, 21, 22, 35, and 36 in order to overcome the 35 U.S.C. §112 rejections. Applicants respectfully submit that the amendments to each of Claims 1, 10, 15, 21, 22, 33, 35, 36, and 37 do not contain new matter. Applicants respectfully submit that the present invention, as defined by Claims 1-11, 13-16 and 18-37, is patentable over the prior art.

Applicant has also deleted the Abstract of the Disclosure and has substituted therefor the new Abstract of the Disclosure, which is attached hereto on a separate sheet. Applicants respectfully submit that the new Abstract of the Disclosure does not contain new matter.

Based on the foregoing amendments and the following Remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

#### **I. THE 35 U.S.C. §112 REJECTIONS AND “FORMAL” MATTERS:**

The Examiner asserts that Claims 1, 10, 15, 21, 22, 35, and 36 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, at page 2 of the Office Action, mailed August 5, 2008, the Examiner stated: “Said claims recite

*‘generating an outcome indicator independent of and differently distributed from the trial outcome; displaying the outcome indicator to the user’.* Said limitation is indefinite because it is not clear the linkage between an outcome indicator and a trial outcome. Are same terms related?” (emphasis in original).

As noted above, Applicants have amended Claims 1, 10, 15, 21, 22, 35, and 36 so as to overcome the 35 U.S.C. §112 rejections. Applicants have amended each of Claims 1, 10, 15, 21, and 22 so that the pertinent portions of said Claims recite: “wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”.

Applicants have amended Claim 35 so that the pertinent portions of said Claims recite: “wherein the outcome indicator is generated independently of the probability of winning, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the probability of winning has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”.

Applicants have amended Claim 35 so that the pertinent portions of said Claims recite: “wherein the outcome indicator is generated independently of the probability of winning, and

wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a favorable outcome has a distribution associated with a first statistical distribution and the probability of winning has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution.”.

Applicants respectfully submit that the above amendments to each of the respective Claims provides the clarification sought by the Examiner.

In view of the foregoing, Applicants respectfully submit that Claims 1-11, 13-16 and 18-37, including Claims 1, 10, 15, 21, 22, 35, and 36, are in compliance with 35 U.S.C. §112. In view of the foregoing, Applicants respectfully request that the Examiner’s 35 U.S.C. §112 rejection of Claims 1, 10, 15, 21, 22, 35, and 36 be withdrawn,

## **II. THE 35 U.S.C. § 103 REJECTIONS:**

The Examiner asserts that Claims 1, 2, 6-11, 13-16, 18-26, 27, 28, and 31-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2003/0054888 to Walker, (Walker I) in view of website to bottomdollar.com, <http://www.web.archive.org/web/19991013040730/http://bottomdollar.com/index.html> (bottomdollar), and further in view of U.S. Patent No. 6,364,765 to Walker (Walker II). The Examiner further asserts that Claims 3-5, 29 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker I in view of bottomdollar, and further in view of Walker II and U.S. Patent No. 6,331,143 to Yoseloff (Yoseloff).

As noted above, Applicants have amended Claims 1, 10, 15, 21, 22, 33, 35 and 36 and added Claim 37 so as to more clearly distinguish the present invention, as defined by such claims, over the prior art. Applicants therefore respectfully submit that the invention, as claimed in Claims 1-11, 13-16 and 18-37, is patentable over the prior art.

Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof, do not disclose, teach, or suggest, “electronically and randomly generating a trial outcome of an event trial, the probability of the event trial generating a winning trial outcome corresponding to the calculated probability of winning”, both of which features are specifically recited features of independent Claim 1.

Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, “generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”, and “displaying the outcome indicator to the user; and in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user”, all of which features are specifically recited features of independent Claim 1.

Applicants further respectfully submit that the present invention, as defined by independent Claim 1, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof. Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and

any combination of same, do not disclose, teach, or suggest, a method of providing a user with a game of chance, the method comprising "receiving electronic signals from a user system representing search parameters descriptive of a product", "retrieving at least one product information from at least one database storing independent third-party retail vendor product information", "transmitting electronic signals to the user system representing the retrieved product information and associated prices", "automatically providing the user with an option to play a game to win a selected product from said product information without the user first making any payment or requesting the option", "electronically calculating a dynamic probability of winning the selected product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received, and the user's behavior during a user session", "electronically and randomly generating a trial outcome of an event trial, the probability of the event trial generating a winning trial outcome corresponding to the calculated probability of winning, generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution", and "displaying the outcome indicator to the user; and in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user", all of which features are specifically recited features of independent Claim 1.

In view of the foregoing, Applicants respectfully submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest all of the specifically recited features of independent Claim 1 and, therefore, Applicants respectfully submit that the invention, as defined by independent Claim 1, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same.

Applicants further submit that Claims 2-9, 31, and 32, which claims depend either directly or indirectly from independent Claim 1, so as to include all of the limitations of independent Claim 1, are also patentable over the prior art as the aforementioned claims 2-9, 31, and 32 depend from allowable subject matter.

Next, Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, “generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”, and “displaying the outcome indicator to the user”, “in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user”, all of which features are specifically recited features of independent Claim 10.

Applicants further respectfully submit that the present invention, as defined by independent Claim 10, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof. Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, a method of providing a user with a game of chance, the method comprising "receiving electronic signals from a user system representing search parameters descriptive of a product", "retrieving at least one product information from at least one database storing independent third-party retail vendor product information", "transmitting electronic signals to the user system representing at least one product, a price of the product and the independent third-[arty retail vendor of the product", "automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment or requesting the first option, and a second option to purchase the product", "if the user chooses to play the game: electronically calculating a dynamic probability of winning the product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session", "electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning", "generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical



distribution has a distribution which is different from the second statistical distribution”, “displaying the outcome indicator to the user”, “in response to a winning trial outcome, purchasing the product for the user from the independent third-party retail vendor at no cost to the user”, and if the user chooses to purchase the product instead of playing the game: directing the user to a web site which sells the product”, all of which features are specifically recited features of independent Claim 10.

In view of the foregoing, Applicants respectfully submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest all of the specifically recited features of independent Claim 10 and, therefore, Applicants respectfully submit that the invention, as defined by independent Claim 10, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same,

Applicants further submit that Claims 11, 13, and 14, which claims depend either directly or indirectly from independent Claim 10, so as to include all of the limitations of independent Claim 10, are also patentable over the prior art as the aforementioned claims 11, 13, and 14 depend from allowable subject matter.

Next, Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, among other things, “wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution

which is different from the second statistical distribution”, all of which features are specifically recited features of independent Claim 15.

Applicants further respectfully submit that the present invention, as defined by independent Claim 15, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof. Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, a method of providing a user with a game of chance, the method comprising “receiving electronic signals from a user system representing at least one search parameter descriptive of a product”, “retrieving at least one product information from at least one database storing independent third-party retail vendor product information”, “transmitting electronic signals to the user system representing a plurality of different independent third-party retail vendors and associated prices charged by each of said different independent third-party retail vendors for products identified in response to said at least one search parameter”, “automatically transmitting electronic signals to the user system representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option”, “and if the user chooses to play the game: electronically calculating a dynamic probability of winning said selected one product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session”, “electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning”, “generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a

losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”, “displaying the outcome indicator to the user”, and “in response to a winning trial outcome, purchasing said selected one product from a corresponding independent third-party retail vendor for the user at no cost to the user”, all of which features are specifically recited features of independent Claim 15.

In view of the foregoing, Applicants respectfully submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest all of the specifically recited features of independent Claim 15 and, therefore, Applicants respectfully submit that the invention, as defined by independent Claim 15, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same.

Applicants further submit that Claims 16, 18-19, and 29, which claims depend either directly or indirectly from independent Claim 15, so as to include all of the limitations of independent Claim 15, are also patentable over the prior art as the aforementioned claims 16, 18-19, and 29 depend from allowable subject matter.

Next, Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, among other things, “wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second

statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”, all of which features are specifically recited features of independent Claim 21.

Applicants further respectfully submit that the present invention, as defined by independent Claim 21, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof. Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, a method of providing a user with a game of chance, the method comprising “receiving electronic signals from a user system representing at least one search parameter descriptive of a product”, “searching for products matching said at least one search parameter”, “transmitting electronic signals to the user system representing a plurality of independent third-party retail vendors and associated prices charged by each of said independent third-party retail vendors for products identified in response to said at least one search parameter, each of the products identified being offered for sale on a corresponding web site of each independent third-party retail vendor”, “automatically transmitting electronic signals to the user representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option”, “and if the user chooses to play the game: electronically calculating a dynamic probability of winning said selected one product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session”, “electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning”, “generating an outcome indicator, wherein the outcome

indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”, “displaying the outcome indicator to the user”, and “in response to a winning trial outcome, purchasing said selected one product from a corresponding independent third-party retail vendor for the user at no cost to the user”, all of which features are specifically recited features of independent Claim 21.

In view of the foregoing, Applicants respectfully submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest all of the specifically recited features of independent Claim 21 and, therefore, Applicants respectfully submit that the invention, as defined by independent Claim 21, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same.

Next, Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, among other things, “wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”, all of which features are specifically recited features of independent Claim 22.

Applicants further respectfully submit that the present invention, as defined by independent Claim 22, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof. Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, a method for providing a user an opportunity to win a product or service by playing a game of chance, the method comprising “enabling the user to submit a search query associated with a type of product or service”, “conducting a search in a database for an independent third-party retail vendor product or service that satisfies the search query”, “automatically presenting a result of the search to the user, including at least one product or service offered for sale by the independent third-party retail vendor retrieved from the database, along with an option to play the game”, “enabling the user to select the product or service that he wants to win”, “dynamically determining the user's chance of winning the selected product or service based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session”, “generating a trial outcome for each play of the game wherein the probability of the trial outcome generating a winning trial outcome corresponds to the user's chance of winning”, “generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is

different from the second statistical distribution”, and “displaying the outcome indicator to the use”, all of which features are specifically recited features of independent Claim 22.

In view of the foregoing, Applicants respectfully submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest all of the specifically recited features of independent Claim 22 and, therefore, Applicants respectfully submit that the invention, as defined by independent Claim 22, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same,

Applicants further submit that Claims 23-30, which claims depend either directly or indirectly from independent Claim 22, so as to include all of the limitations of independent Claim 22, are also patentable over the prior art as the aforementioned claims 23-30 depend from allowable subject matter.

Next, Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof, do not disclose, teach, or suggest, “electronically calculating a dynamic probability of winning the corresponding product by the user”, which feature is specifically recited feature of independent Claim 33.

Applicants also respectfully submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof, do not disclose, teach, or suggest, “displaying the outcome indicator to the user”, which feature is specifically recited feature of independent Claim 33.

Applicants further submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof, do not disclose, teach, or suggest, “in response to a winning trial outcome, purchasing the selected products for the user from the independent third-party retail vendor at no cost to the user”, both of which features are specifically recited features of independent Claim 33.

Applicants further respectfully submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof, do not disclose, teach, or suggest, “electronically and randomly generating a trial outcome of an event trial, the probability of the event trial generating a winning trial outcome corresponding to the calculated probability of winning”, both of which features are specifically recited features of independent Claim 33.

Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, “generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”, and “displaying the outcome indicator to the user; and in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user”, all of which features are specifically recited features of independent Claim 33.

Applicants further respectfully submit that the present invention, as defined by independent Claim 33, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof. Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, a method for increasing user traffic to a search engine website, the method comprising “receiving a search query from a user system interacting with a search webpage of the website, the search query defining a desired product for



the user”, “transmitting a results webpage to the user system, the results webpage including at least one link for redirection to an independent third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to the independent third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product at no cost to the user, the link corresponding to the independent third party website redirection link”, “electronically calculating a dynamic probability of winning the corresponding product by the user”, “electronically and randomly generating a trial outcome of an event trial, the probability of the event trial generating a winning trial outcome corresponding to a determined probability of winning”, “generating an outcome indicator wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”, “displaying the outcome indicator to the user”, and “in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user”, all of which features are specifically recited features of independent Claim 33.

In view of the foregoing, Applicants respectfully submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest all of the specifically recited features of independent Claim 33 and, therefore, Applicants respectfully submit that the invention, as defined by independent Claim 33, is patentable over Walker I,

bottomdollar, Walker II, Yoseloff, and any combination of same.

Applicants further submit that Claim 34, which claim depends either directly or indirectly from independent Claim 33, so as to include all of the limitations of independent Claim 33, is also patentable over the prior art as the aforementioned Claim 33 depends from allowable subject matter.

Next, Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, among other things, “wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”, all of which features are specifically recited features of independent Claim 35.

Applicants further respectfully submit that the present invention, as defined by independent Claim 35, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof. Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, a method for increasing user traffic to a search website, the method comprising “providing a search webpage containing a search interface for a user to submit a search query for a product”, “receiving a search query from a user employing said search webpage”, “searching independent third party websites by reference to said query”, “retrieving product information and corresponding price from the independent third party websites for at least one products satisfying said query”, “providing a game of chance in

response to a user selection of the link to win the product”, “purchasing the product from the independent third party for the user response to a favorable outcome in said game”, “transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the independent third party website, and a link to win the product”, “providing a game of chance in response to a user selection of the link to win the product, wherein the probability of winning the product by the user is dynamically calculated based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session”, “generating an outcome indicator, wherein the outcome indicator is generated independently of the probability of winning, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the probability of winning has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution” “displaying the outcome indicator to the user”, and “purchasing the product from the independent third party for the user in response to a favorable outcome in said game and providing said product to the user at no cost to the user”, all of which features are specifically recited features of independent Claim 35.

In view of the foregoing, Applicants respectfully submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest all of the specifically recited features of independent Claim 35 and, therefore, Applicants respectfully

submit that the invention, as defined by independent Claim 35, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same.

Next, Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, among other things, “wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”, all of which features are specifically recited features of independent Claim 36.

Applicants further respectfully submit that the present invention, as defined by independent Claim 36, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination thereof. Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, a product search website executing on a server storing a plurality of web pages, the website comprising “a search page for a user submitting a query to the server for at least one product”, “a results webpage transmitted to the user, the results page including links to an independent third party website and a link to a play webpage of the website”, “a play webpage providing a game of chance for winning the at least one product corresponding to a selected play link from the results webpage, wherein a probability of winning the at least one product by the user is dynamically calculated based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current

prize budget to a total amount of funds received and the user's behavior during a user session”, and “a product win webpage to display an outcome indicator indicating a favorable outcome in said game of chance for the at least one product, wherein the outcome indicator is generated independently of the probability of winning, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a favorable outcome has a distribution associated with a first statistical distribution and the probability of winning has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”, all of which features are specifically recited features of independent Claim 36.

In view of the foregoing, Applicants respectfully submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest all of the specifically recited features of independent Claim 36 and, therefore, Applicants respectfully submit that the invention, as defined by independent Claim 36, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same.

Finally, Applicants submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest, a computer-implemented method comprising “receiving a search request for a product, wherein the search request is transmitted from a communication device associated with or used by a user”, “processing the search request with a processing device”, “generating a message, wherein the message contains information regarding at least one product offered by a retail vendor, product information regarding the at least one product, and at least one price associated with the at least one product”, “transmitting the message to the communication device”, “automatically providing the user with an option to

play a game to win a selected product from the product information regarding the at least one product without the user first making any payment or requesting the option”, “electronically calculating a dynamic probability of winning the selected product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received, and the user’s behavior during a user session”, “electronically and randomly generating a trial outcome for a game of chance, wherein the probability of the game of chance generating a winning trial outcome corresponds to the calculated probability of winning”, “generating an outcome indicator, wherein the outcome indicator is generated independently of the trial outcome, and wherein the outcome indicator is representative of a winning trial outcome or a losing trial outcome, and further wherein the outcome indicator for a winning trial outcome has a distribution associated with a first statistical distribution and the trial outcome has a distribution associated with a second statistical distribution, and further wherein the first statistical distribution has a distribution which is different from the second statistical distribution”, “displaying the outcome indicator to the user”, and “in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user”, all of which features are specifically recited features of independent Claim 37.

In view of the foregoing, Applicants respectfully submit that Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same, do not disclose, teach, or suggest all of the specifically recited features of independent Claim 37 and, therefore, Applicants respectfully submit that the invention, as defined by independent Claim 37, is patentable over Walker I, bottomdollar, Walker II, Yoseloff, and any combination of same,

### III. CONCLUSION

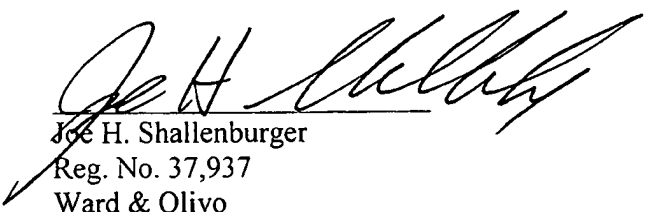
In view of the foregoing, the application is deemed to be in condition for allowance and action to that end is respectfully requested. Allowance of pending Claims 1-11, 13-16 and 18-37 is respectfully requested.

Should any amendments to the claims and/or specification be deemed necessary to place the application in condition for allowance, the Examiner is respectfully requested to contact the undersigned to discuss the same. If a petition and/or any other fees are required, the Patent and Trademark Office is specifically authorized to charge such fee to Deposit Account No. 23-0420 in the name of Ward & Olivo.

Respectfully submitted,

Date: \_\_\_\_\_

2/5/09

  
Joe H. Shallenburger

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# EXHIBIT 3





# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	632-001	1839
27776 7590 08/05/2008 WARD & OLIVO SUITE 300 382 SPRINGFIELD AVENUE SUMMIT, NJ 07901			EXAMINER LASTRA, DANIEL	
			ART UNIT 3688	PAPER NUMBER
			MAIL DATE 08/05/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/759,103	<b>Applicant(s)</b> CLARK ET AL.	
	<b>Examiner</b> DANIEL LASTRA	<b>Art Unit</b> 3688	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-16 and 18-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-16 and 18-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. Claims 1-11, 13-16 and 18-36 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

### Response to Amendment

2. In response to Final Rejection filed 05/21/2007, the Applicant filed an RCE on 05/08/2008, which amended claims 1, 3, 6, 10, 11, 15, 16, 21, 22, 23, 28, 31-36 and cancel claims 12 and 17.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 10, 15, 21, 22, 35 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recite "*generating an outcome indicator independent of and differently distributed from the trial outcome; displaying the outcome indicator to the user*". Said limitation is indefinite because it is not clear the linkage between an outcome indicator and a trial outcome. Are same terms related? For purpose of art rejection, said limitation would be interpreted as meaning generating two different outcomes, a trial outcome and an outcome indicator.

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3688

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6-11, 13-16, 18-26, 27, 28, 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 2003/0054888) in view of bottomdollar.com (<http://www.web.archive.org/web/19991013040730/http://bottomdollar.com/index.html>) and further in view of Walker (US 6,364,765).

As per claims 10 and 20-22, Walker (888) teaches:

A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing at a least one product, a price of the product and a third-party retail vendor of the product (see Walker paragraphs 38 and 39).

automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment (see Walker paragraph 130), or requesting the first option and a second option to purchase the product (see Walker paragraphs 34; 149);

if the user chooses to play the game:

electronically calculating a dynamic probability of winning the product by the user *based on one more factors selected from a group consisting of: the cost of the selected*

*product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the, user's behavior during a user session (see Walker paragraphs 89, 94, 98, 110). Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124).*

*electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning (see Walker paragraph 144);*

*in response to a winning trial outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39) at no cost to the user (see paragraph 130);*  
and

*if the user chooses to purchase the product instead of playing the game:*

*directing the user to a web site which sells the product (see Walker paragraph 34,149-151);*

Walker does not expressly teach retrieving at least one product information from at least one database storing *independent* third-party retail vendor product information. However, bottomdollar.com teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest and receive back a comparative list of independent third party retail vendors of said item giving users the option to buy said item from a selected

vendor in said list (see bottomdollar.com pages 1 and 2). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would display to users a list of different independent third-party providers vendors of users' selected products, as taught by bottomdollar.com, where said users would have the opportunity to play a game to win said products in order to enable said users the purchase of products from competing product providers, therefore obtaining the best price, with the added incentive of allowing said users to even play a game in order to obtain said products for free (see Walker paragraphs 125, 130).

Walker does not teach and *generating an outcome indicator independent of and differently distributed from the trial outcome; displaying the outcome indicator to the user*. However, Walker (765) teaches that it is old and well known in the gaming art to play different games of chance in a game machine and obtain different outcomes from said playing (see col 2, lines 25-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker (888) would allow customer to play different games of chance, as taught by Walker (765) in order to give customer a higher probability of winning a product.

As per claim 1, Walker (888) teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing search parameters descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing the retrieved product information and associated prices (see Walker figure 6).

automatically providing the user an option to play a game to win a selected product from said product information without the user first making any payment (see paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a *dynamic* probability of winning the selected product by the user *based on one more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the, user's behavior during a user session* (see Walker paragraphs 89, 94, 98, 110). Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124);

electronically generating *a trial outcome, the probability of the trial outcome generating a winning trial outcome* corresponding to the calculated probability of winning (see Walker paragraph 144);

in response to a winning trial outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39) at *no cost to the user* (see paragraph 130);

Walker does not expressly teach retrieving at least one product information from at least one database storing *independent* third-party retail vendor product information and *generating an outcome indicator independent of and differently distributed from the trial outcome; displaying the outcome indicator to the user*. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 1

As per claim 15, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing a plurality of different third-party retail vendors and associated prices charged by each of said different third-party retail vendors for products identified in response to said at least one search parameter (see Walker figure 6).

automatically transmitting electronic signals to the user system representing an option to play a game to win a selected product or service without the user first making any payment (see Walker paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a *dynamic* probability of winning said selected one product by the user *based on one more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds*



*received and the user's behavior during a user session (see Walker paragraphs 89, 94, 98, 110). Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124);*

*electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning (see Walker paragraph 144);*

*in response to a winning trial outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39) at no cost to the user (see paragraph 130);*

*Walker does not expressly teach retrieving at least one product information from at least one database storing independent third-party retail vendor product information and generating an outcome indicator independent of and differently distributed from the trial outcome; displaying the outcome indicator to the user. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 15.*

As per claims 6, 11, 16, 26, 28 Walker teaches:

*comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party, such as a game provider, provides compensation to the provider of the game of chance (see paragraphs 124-125).*

As per claims 7, 12 , Walker teaches:

calculating a probability of winning based on at least a current budget (see Walker paragraph 144).

As per claims 8, 13 and 18, Walker teaches:

calculating a probability P of winning based on a total number of game players (see Walker paragraph 110).

As per claim 23, Walker teaches:

providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user *and at no cost to the user*, if the outcome for the play of the game is a win (see Walker paragraphs 129-131).

As per claim 25, the same rejection applied to claims 7-8 is also applied to claim 25.

As per claims 2, 24 and 27, Walker teaches:

wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system (see Walker paragraphs 26 and 89).

As per claims 9, 14 and 19, Walker teaches:

calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

Walker does not expressly teach  $P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available.

However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see Walker paragraph 143).

Pt is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

Pm is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

Pu is probability factor that varies with the user's behavior during a user session (see Walker paragraph 88); and

N is a number of current users (see Walker paragraph 110).

As per claim 31, Walker fails to teach:

collecting a database of *independent* third party retail vendor product information prior to receiving the search parameters from the user. However, bottomdollar.com teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest and receive back a comparative list of independent third party retail vendors of said item giving users the option to buy said item from a selected vendor in said list (see bottomdollar.com pages 1 and 2). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would be motivated to display to users a list of different

independent third-party providers vendors of users' selected products, as taught by bottomdollar.com, where said users would have the opportunity to play a game to win said products in order to enable said users the purchase of products from competing product providers, therefore obtaining the best price, with the added incentive of allowing said users to even play a game in order to obtain said products for free (see Walker paragraphs 125, 130).

As per claim 32, Walker teaches:

transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the third party retail vendor and a link to initiate playing to win the same product (see Walker paragraph 39). Walker does not expressly teach that said retail vendor is an independent retail vendor. However, the same rejection applied to claim 1 regarding this missing limitation is also applied to claim 32.

As per claim 33, Walker teaches:

A method for increasing user traffic to a search engine website, comprising:

transmitting a results webpage to the user system, the results page including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to said third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product at no cost to the user corresponding to the third party website redirection link (see Walker paragraphs 39 and 132). Walker fails to teach receiving a search query

Art Unit: 3688

from a user system interacting with a search webpage of the website, the search query defining a desired product for the user and that said third party vendor website is an independent vendor website. However, bottomdollar.com teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest and receive back a comparative list of independent third party retail vendors of said item giving users the option to buy said item from a selected vendor in said list (see bottomdollar.com pages 1 and 2). Therefore, the same rejection applied to claim 1 regarding this missing limitation is also applied to claim 33.

As per claim 34, Walker does not expressly teach:

wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the independent third party vendor corresponding to the third party website redirection link. However, bottomdollar.com teaches a search engine website which facilitates the purchase of a product from a independent third party vendor (see Roll paragraph 57). Therefore, the same rejection applied to claim 33 is also applied to claim 34.

As per claims 35 and 36, Walker teaches:

A method for increasing user traffic to a search website, comprising:

retrieving product information and corresponding price from said third party websites for at least one products satisfying said query (see Walker paragraphs 38-39);

providing a game of chance in response to a user selection of the link to win the product; and purchasing the product from the third party for the user response to a favorable outcome in said game; transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the third party website, and a link to win the product (see Walker paragraphs 38-40);

providing a game of chance in response to a user selection of the link to win the product (see Walker paragraph 40); and

purchasing the product from the third party for the user in response to a favorable outcome in said game (see Walker paragraph 41).

*wherein the probability of winning the product by the user is dynamically calculated based on one more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the, user's behavior during a user session (see Walker paragraphs 89, 94, 98, 110).* Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124);

electronically generating *a trial outcome, the probability of the trial outcome generating a winning trial outcome* corresponding to the calculated probability of winning (see Walker paragraph 144);

in response to a winning trial outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39) *at no cost to the user (see paragraph 130)*;

Walker fails to teach:

providing a search webpage containing a search interface for a user to submit a search query for a product; receiving a search query from a user employing said search webpage; searching *independent* third party websites by reference to said query and *generating an outcome indicator independent of and differently distributed from the trial outcome; displaying the outcome indicator to the user*. However, the same rejection applied to claim 33 regarding these missing limitations is also applied to claim 35.

5. Claims 3-5, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of bottomdollar.com (<http://www.web.archive.org/web/19991013040730/http://bottomdollar.com/index.html>) and further in view Walker (US 6,364,765) and Yoseloff (U.S. 6,331,143).

As per claims 3 and 29, Walker fails to teach:

wherein the *display comprises* a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see Yoseloff column 8, lines 35-50;

column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker and bottomdollar.com system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker does not teach:

wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a system (see Yoseloff column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an



incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker does not expressly mention:

wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. However, Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to the provider of the products (see Walker paragraph 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

As per claim 30, Walker teaches:

wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor (see paragraph 124).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-11, 13-16 and 18-36 have been considered but are moot in view of the new ground(s) of rejection. The Applicant argues that the prior art does not teach "generating a trial outcome and an outcome indicator independent of, and differently distributed from the trial outcome before displaying the outcome indicator to the user". The Examiner answers that nowhere in Applicant's claimed limitation is recited "before displaying the outcome indicator to the user", therefore, the Applicant is arguing about limitation not stated in the claims.

The Applicant argues that Walker does not teach providing the product at no cost to the user. The Examiners that Walker teaches providing a product at no cost to the user (see paragraph 130). Therefore, contrary to Applicant's argument, Walker teaches Applicant's claimed limitation.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Art Unit: 3688

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/

Art Unit 3688

July 18, 2008

# EXHIBIT 4



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839

26158 7590 05/21/2007  
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC  
ATTN: PATENT DOCKETING 32ND FLOOR  
P.O. BOX 7037  
ATLANTA, GA 30357-0037

EXAMINER
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LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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05/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/759,103	CLARK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	DANIEL LASTRA	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                    |
|--------------------------------------------------------------------------------------|--------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                           |

**DETAILED ACTION**

1. Claims 1-36 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

***Response to Amendment***

2. In response to Non Final Rejection filed 05/18/2006, the Applicant filed a Request for reconsideration on 08/18/2006.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7-10, 12-15, 17-25, 27, 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 2003/0054888) in view of Roll (US 2002/0016779).

As per claims 10 and 20-22, Walker teaches:

A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing at a least one product, a price of the product and a third-party retail vendor of the product (see Walker

Art Unit: 3622

paragraphs 38 and 39). Walker does not expressly teach retrieving at least one product information from at least one database storing third-party retail vendor product information. However, Roll teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest (see Roll paragraphs 44-46) and receive back a comparative list of providers of said item, as well as terms of offer for said item (see Roll paragraph 57 and abstract, paragraph 61). Rolls also teaches that his present invention include, but are not limited to, pricing mechanisms for insurance, loans, credit cards, automobiles and other consumer pricing applications (see Roll paragraph 19). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would be motivated to display to users a list of different third-party providers vendors of users' selected products, as taught by Roll, where said users would have the opportunity to play a game to win said products in order to enable said users the purchase of products from competing product providers, therefore obtaining the best price, with the added incentive of allowing said users to even play a game in order to obtain said products for free (see Walker paragraphs 125, 130).

automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment (see Walker paragraph 130), or requesting the first option and a second option to purchase the product (see Walker paragraphs 34; 149);



if the user chooses to play the game:

electronically calculating a probability of winning the product by the user;  
electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 144); and

in response to a winning pseudo-random outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39);

and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product (see Walker paragraph 34,149-151);

As per claim 1, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing search parameters descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing the retrieved product information and associated prices (see Walker figure 6). Walker does not expressly teach retrieving at least one product information from at least one database storing third-party retail vendor product information. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 1.

automatically providing the user an option to play a game to win a selected product from said product information without the user first making any payment (see paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a probability of winning the selected product or service by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing the selected product for the user from the third-party retail vendor (see Walker paragraph 145; paragraph 39).

As per claim 15, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing a plurality of different third-party retail vendors and associated prices charged by each of said different third-party retail vendors for products identified in response to said at least one search parameter (see Walker figure 6). Walker does not expressly teach retrieving at least one product information from at least one database storing third-party retail vendor product information. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 15.

automatically transmitting electronic signals to the user system representing an option to play a game to win a selected product or service without the user first making any payment (see Walker paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a probability of winning said selected one product by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing said selected one product from a corresponding third-party retail vendor for the user (see Walker paragraph 145; paragraph 39).

As per claims 7, 12 and 17, Walker teaches:

The method of claim 10, comprising calculating a probability of winning based on at least a current budget (see Walker paragraph 144).

As per claims 8, 13 and 18, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on a total number of game players (see Walker paragraph 110).

As per claim 23, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win (see Walker paragraphs 129-131).

As per claim 25, the same rejection applied to claims 7-8 is applied to claim 25.

As per claims 2, 24 and 27, Walker teaches:

The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system (see Walker paragraphs 26 and 89).

As per claims 9, 14 and 19, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

Walker does not expressly teach  $P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see Walker paragraph 143).

$P_t$  is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

$P_u$  is probability factor that varies with the user's behavior during a user session (see Walker paragraph 88); and

N is a number of current users (see Walker paragraph 110).

As per claim 31, Walker fails to teach:

The method of Claim 1, further comprising collecting a database of third party retail vendor product information prior to receiving the search parameters from the user. However, Roll teaches collecting a database of third party retail vendor prior to receiving a query request from a user (see Roll paragraph 61). Therefore, the same rejection applied to claim 10 regarding the third-party vendor database missing limitation is also made in claim 31.

As per claim 32, Walker teaches:

The method of Claim 1 whereby transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the third party retail vendor and a link to initiate playing to win the same product (see Walker paragraph 39).

As per claim 33, Walker teaches:

A method for increasing user traffic to a search engine website, comprising:

transmitting a results webpage to the user system, the results page including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to said third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product corresponding to the third party website redirection link (see Walker paragraph 39). Walker fails to teach receiving a search query from a user system interacting with a

Art Unit: 3622

search webpage of the website, the search query defining a desired product for the user. However, Roll teaches a system that provides a comparative and variable pricing system that allows users to search for an item via an Internet browser (see Roll paragraphs 44-46) and receive back a comparative list of providers of said item, as well as terms of offer for the item (see Roll paragraph 57 and abstract, paragraph 61). Roll also teaches that his present invention include, but are not limited to, pricing mechanisms for insurance, loans, credit cards, automobiles and other consumer pricing applications (see Roll paragraph 19). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would be motivated to display to users a list of different third-party providers vendors of users' selected products, as taught by Roll, where said users would have the opportunity to play a game to win said products in order to enable said users the purchase of products from competing product providers, therefore obtaining the best price, with the added incentive of allowing said users to even play a game in order to obtain said products for free (see Walker paragraphs 125, 130).

As per claim 34, Walker does not expressly teach:

The method of claim 33, wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the third party vendor corresponding to the third party

Art Unit: 3622

website redirection link. However, Roll teaches a search engine website which facilitates the purchase of a product from a third party vendor (see Roll paragraph 57). Therefore, the same rejection applied to claim 33 is also applied to claim 34.

As per claims 35 and 36, Walker teaches:

A method for increasing user traffic to a search website, comprising:

retrieving product information and corresponding price from said third party websites for at least one products satisfying said query (see Walker paragraphs 38-39);

providing a game of chance in response to a user selection of the link to win the product; and purchasing the product from the third party for the user response to a favorable outcome in said game; transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the third party website, and a link to win the product (see Walker paragraphs 38-40);

providing a game of chance in response to a user selection of the link to win the product (see Walker paragraph 40); and

purchasing the product from the third party for the user in response to a favorable outcome in said game (see Walker paragraph 41).

Walker fails to teach:

providing a search webpage containing a search interface for a user to submit a search query for a product; receiving a search query from a user employing said search webpage; searching third party websites by reference to said query. However, the same

rejection applied to claim 33 regarding these missing limitations is also applied to claim 35.

4. Claims 3-5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view Yoseloff (U.S. 6,331,143).

As per claims 3 and 29, Walker teaches:

The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see Yoseloff column 8, lines 35-50; column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.



Art Unit: 3622

As per claim 4, Walker teaches:

The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a system (see Yoseloff column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker teaches:

The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to

Art Unit: 3622

the provider of the products (see Walker paragraph 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

5. Claims 6, 11, 16, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view of Angles et al (U.S. 5,933,811).

As per claims 6, 11, 16, 26, 28 Walker teaches:

The method of claim 10, but fails to teach comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party, such as a game provider, provides compensation. However, Angles teaches a system where users are compensated for viewing sponsors' advertisements (see column 16, lines 38-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsors' advertisements independently of the purchase of the advertised product or service, as taught by Angles and these compensations would allow users to play games to win the sponsors' advertise products, as taught by Walker.

Compensating users for viewing advertisements would be a good business decision as this would increase the probability that users would view the sponsors' advertisements and would play to win the advertise products, therefore increasing customer traffic and customer loyalty.

6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view of Angles et al (U.S. 5,933,811) and Yoseloff (US 6,331,143).

As per claim 30, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 29 but fails to teach wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that sponsors would compensate users for viewing the sponsors' advertisements or for participating in the sponsors' online surveys. Sponsors would compensate users by allowing the users to play games to win the sponsors' products.

### ***Response to Arguments***

7. Applicant's arguments filed 11/03/2006 have been fully considered but they are not persuasive. The Applicant argues that there is no motivation to combine Walker with Rolls and that the references teaches away from each other, because according to the Applicant, the Walker reference results in increase profits for a single retail store, while Rolls teaches a system that is designed for use by multiple retailers which result in

lower profits by the retailers via lowered prices to the consumer. The Examiner answers that a user would be motivated to use the Walker and Roll system in order to find the best possible price (i.e. lower price) for a product by comparing the offer price of different providers with the added incentive of allowing said user to play a game in order to obtain said product for free. Therefore, contrary to Applicant's argument, Walker and Roll are combinable.

The Applicant further argues that Walker does not allow a user to purchase a product from a third party vendor because according to the Applicant, if the user wins a product, the customer is charged a game fee and receives the item directly from the offeror of the game. The Examiner answers that Walker teaches an embodiment where is not necessary to pay a fee to play a game (see paragraph 130, 152) and also Walker teaches the purchase of products from websites run by retailers (see paragraph 104). Therefore, contrary to Applicant's argument, Walker allow users to purchase a product from a third party vendor (i.e. retailer).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
March 31, 2007

  
RETTA YEHEDEGA  
PRIMARY EXAMINER

# EXHIBIT 5



**PATENT**

**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Scott Clark, et al.

Serial No.: 09/759,103

Group Art Unit: 3622

Filed: January 12, 2001

Examiner: Daniel Lastra

For: Search Engine Providing an Option to  
Win the Item Sought

Atty. Doc. No.: 632-001

Mail Stop Appeal Brief – Patents  
Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**AMENDED APPEAL BRIEF UNDER 37 CFR §41.37(d)**

**S I R:**

In response to the Notification of Non-Compliant Appeal Brief, dated February 11, 2008,  
Applicant respectfully submits this Amended Appeal Brief under 37 CFR §41.37(d) in the above  
referenced matter.

## **TABLE OF CONTENTS**

<b><u>TITLE</u></b>	<b><u>PAGE</u></b>
Table of Contents	2
I. Table of Authorities	4
II. Real Party in Interest	6
III. Related Appeals and Interferences	6
IV. Status of Claims	6
V. Status of Amendments	7
VI. Summary of Claimed Subject Matter	7
VII. Grounds of Rejection to be Reviewed on Appeal	18
A. Whether Claims 1, 2, 7-10, 12-15, 17-25, 27 and 31-36 are unpatentable under 35 U.S.C. §103 over Walker in view of Roll	18
B. Whether Claims 3-5 and 29 are unpatentable under 35 U.S.C. §103 over Walker in view of Roll and Yoseloff	18
C. Whether Claims 6, 11, 16, 26 and 28 are unpatentable under 35 U.S.C. §103 over Walker in view of Roll and Angles	19
D. Whether Claim 30 is unpatentable under 35 U.S.C. §103 over Walker in view of Roll, Angles and Yoseloff	19
VIII. Argument	20
A. Claims 1, 2, 7-10, 12-15, 17-25, 27, and 31-36 are patentable over the combination of the prior art because there is no motivation to combine the references	20
i. Roll teaches away from Walker	23



ii.	Walker would be inoperative if combined with Roll	25
iii.	The combination of Walker and Roll fails to render the claimed invention obvious	26
B.	Claims 3-5 and 29 are patentable over the prior art because there is no motivation to combine the references and the combination of references fail to teach every element of the claims	28
i.	The combination of Walker, Roll and Yoseloff fails to render the claimed invention obvious	29
C.	Claims 6, 11, 16, 26 and 28 are patentable over the prior art because there is no motivation to combine the references and the combination of references fail to teach every element of the claims	31
i.	The combination of Walker, Roll and Angles fails to render the claimed invention obvious	32
D.	Claim 30 is patentable over the prior art because there is no motivation to combine the references and the combination of references fail to teach every element of the claim	34
i.	The combination of Walker, Roll, Angles and Yoseloff fails to render the claimed invention obvious	35
IX. Conclusion		35
Appendix I: Claims		36
Appendix II: Evidence		48
Appendix III: Related Proceedings		49

## **I. TABLE OF AUTHORITIES**

### **A. CASES CITED**

1. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991);
2. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).
3. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007) .
4. *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F.2d 1572 (Fed. Cir. 1984).
5. *Seasonics v. Aerosonic Corp.*, 38 USPQ 2d 1551, 1554 (1996).
6. *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005 (Fed. Cir. 1983).
7. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

### **B. UNITED STATES STATUTES CITED**

1. 35 United States Code §103

### **C. PATENTS AND PATENT PUBLICATIONS CITED**

1. United States Patent Application Pub. No. 2003/0054888, to Walker, *et al.*
2. United States Patent Application Pub. No. 2003/0016779, to Roll, *et al.*
3. United States Patent No. 6,331,143, to Yoseloff, *et al.*
4. United States Patent No. 5,933,811, to Angles, *et al.*

#### **D. SECONDARY SOURCES CITED**

1. File Wrapper for United States Patent Application Serial Number 09/759,013 for “Search Engine Providing an Option to Win the Item Sought” (subject of current appeal).
2. Manual of Patent Examining Procedure (MPEP) §§2143-2143.03.

## **II. REAL PARTY IN INTEREST**

The real party in interest in this appeal is PickaPin.com of Bronx, NY. Scott Clark of New York, New York, Armen Djourian, of New York, New York and Moujan Vahdat of New York, New York are the inventors and have assigned an interest to PickaPin.com in the invention that is currently subject to appeal. The assignment to PickaPin.com is recorded with the United States Patent and Trademark Office at Reel/Frame 019348/0373.

## **III. RELATED APPEALS AND INTERFERENCES**

On September 26, 2005, in response to an Office Action dated June 27, 2005 finally rejecting all of the then-pending claims, Applicant filed a Notice of Appeal and a Request for a Pre-Brief Appeal Conference. On December 13, 2005, a Notice of Panel Decision from Pre-Appeal Brief Review maintained the rejection of claims 1-30. On February 27, 2006, Applicant filed a Request for Continued Examination (RCE) and Amendment. The Office Action dated June 27, 2005, Applicant's Pre-Appeal Brief Request for Review, the Notice of Panel Decision from Pre-Appeal Brief Review are appended in Appendix III.

Applicant is unaware of any other prior appeal, pending appeal, judicial proceeding, or interference proceeding which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in this proceeding.

## **IV. STATUS OF CLAIMS**

Claims 1, 10, 15 and 21-22 were last amended in the Response and Amendment dated February 27, 2006. Claims 31-36 were added in the Response and Amendment dated February

27, 2006. Claims 1-36 are pending in the application and stand finally rejected under 35 U.S.C. §103 by the Examiner in the Office Action dated May 21, 2007.

The Amendment dated February 27, 2006 and Final Rejection dated May 21, 2007 are attached in Appendix II.

#### **V. STATUS OF AMENDMENTS**

No Amendment has been filed subsequent to the Final Office Action dated May 21, 2007. Applicants consider the claims listed in Appendix I to be the claims at issue in this appeal.

#### **VI. SUMMARY OF CLAIMED SUBJECT MATTER**

There are eight independent claims in the present application, Claim 1, Claim 10, Claim 15, Claims 21-22, Claim 33 and Claims 35-36. A brief summary of each independent claim is discussed below, with reference being made to the specification of the presently appealed application. A copy of the claims can be found in Appendix I.

Claim 1 provides for a method for providing a game of chance related to a user's acquisition of a selected product. In particular, Claim 1 recites:

1. A method of providing a user with a game of chance, the method comprising the steps of:  
receiving electronic signals from a user system representing search  
parameters descriptive of a product; (e.g., paragraph [0031], Fig. 2a,  
elements 203 and 205)

retrieving at least one product information from at least one database storing  
third-party retail vendor product information; (e.g., paragraph [0031], Fig. 2a, element 206)  
transmitting electronic signals to the user system representing the retrieved  
product information and associated prices; (e.g., paragraph [0031], Fig. 2a, element 207)  
automatically providing the user with an option to play a game to win a selected  
product (e.g., paragraph [0031], Fig. 2a, element 208) from said product  
information without the user first making any payment or requesting the  
option; (e.g., paragraph [0032], Figs. 2a and 2b, element 210)  
electronically calculating a probability of winning the selected product by the  
user; (e.g., paragraph [0032], Fig. 2b, element 214)  
electronically generating a pseudo-random outcome corresponding to the  
calculated probability of winning; (e.g., paragraph [0032], Fig. 2b, element 215) and  
in response to a winning pseudo-random outcome, (e.g., paragraph [0032], Fig. 2b, element 216) purchasing the selected product for the user from the  
third-party retail vendor. (e.g., paragraph [0032], Fig. 2b, element 218).

Claim 3 provides a method step for providing the results of the pseudo-random outcome of a game of chance to a user by displaying a user-chosen number with a comparison number.

Claim 3 particularly recites:

3. The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user-chosen number and a comparison number, (e.g., paragraphs [0008, 0055-0058]) such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. (e.g., paragraphs [0008, 0058]).

Claim 6 provides a method step permitting a user to increase their odds of winning a game of chance, and recites:

6. The method of claim 1, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation. (e.g., paragraph [0094]).

Claim 10 provides for an alternative embodiment of the present invention where a user is given the option of purchasing the desired product outright, or winning the product through a game of chance. Claim 10 recites:

10. A method of providing a user with a game of chance, the method comprising:
  - receiving electronic signals from a user system representing at least one search parameter descriptive of a product; (e.g., paragraph [0031], Fig. 2b, element 215)
  - retrieving at least one product information from at least one database storing third-party retail vendor product information; (e.g., paragraph [0031], Fig. 2a, element 206)

transmitting electronic signals to the user system representing at a least one product, a price of the product and a third-party retail vendor of the product; (e.g., paragraph [0031, 0053], Fig. 2a, element 207)

automatically transmitting electronic signals representing at least a first option for the user to play a game (e.g., paragraph [0031], Fig. 2a, element 208) to win the product without the user first making any payment or requesting the first option, and a second option to purchase the product; (e.g., paragraphs [0025, 0031], Fig. 2a, element 209)

if the user chooses to play the game (e.g., paragraph [0031], Fig. 2a, element 210):

electronically calculating a probability of winning the product by the user; (e.g., paragraph [0032], Fig. 2b, element 214)

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning; (e.g., paragraph [0032], Fig. 2b, element 214) and

in response to a winning pseudo-random outcome, (e.g., paragraph [0032], Fig. 2b, element 216) purchasing the product for the user from the third-party retail vendor; (e.g., paragraph [0032], Fig. 2b, element 218) and

if the user chooses to purchase the product instead of playing the game (e.g., paragraph [0031], Fig. 2a, element 209):

directing the user to a web site which sells the product. (e.g., paragraph [0054]).



Claim 15 provides for an alternative embodiment of the present invention where a response to a user's inquiry regarding a product is predicated on a user provided search parameter. Claim 15 recites:

15. A method of providing a user with a game of chance, the method comprising:
  - receiving electronic signals from a user system representing at least one search parameter descriptive of a product; (e.g., paragraph [0031], Fig. 2a, elements 203 and 205)
  - retrieving at least one product information from at least one database storing third-party retail vendor product information; (e.g., paragraph [0031], Fig. 2a, element 206)
  - transmitting electronic signals to the user system representing a plurality of different third-party retail vendors and associated prices charged by each of said different third-party retail vendors for products identified in response to said at least one search parameter; (e.g., paragraph [0031], Fig. 2a, element 206)
  - automatically transmitting electronic signals to the user system representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; (e.g., paragraph [0031], Fig. 2a and 2b, element 210) and
  - if the user chooses to play the game: (e.g., paragraph [0031], Fig. 2a, element 209)
  - electronically calculating a probability of winning said selected one product by the user; (e.g., paragraph [0031], Figs. 2a and 2b, element 210)

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning; (e.g., paragraph [0032], Fig. 2b, elements 214 and 215) and in response to a winning pseudo-random outcome, (e.g., paragraph [0032], Fig. 2b, element 216) purchasing said selected one product from a corresponding third-party retail vendor for the user. (e.g., paragraph [0032], Fig. 2b, element 218).

Claim 21 provides for an alternative search result embodiment. Claim 21 recites:

21. A method of providing a user with a game of chance, the method comprising:
- receiving electronic signals from a user system representing at least one search parameter descriptive of a product; (e.g., paragraph [0031], Fig. 2a, elements 203 and 205)
  - searching for products matching said at least one search parameter; (e.g., paragraphs [0031, 0035], Fig. 2a, element 206)
  - transmitting electronic signals to the user system representing a plurality of third-party retail vendors and associated prices charged by each of said third-party retail vendors for products identified in response to said at least one search parameter, each of the products identified being offered for sale on a corresponding web site of each third-party retail vendor; (e.g., paragraphs [0031, 0053], Fig. 2a, element 207)
  - automatically transmitting electronic signals to the user representing an option to

play a game (e.g., paragraph [0031], Fig. 2a, element 208) to win a selected one of said products without the user first making any payment or requesting the option; (e.g., paragraphs [0025, 0031], Fig. 2a, element 209) and

if the user chooses to play the game (e.g., paragraph [0031], Fig. 2a, element 210):

electronically calculating a probability of winning said selected one product by the user; (e.g., paragraph [0032], Fig. 2b, element 214)

electronically generating a pseudo-random outcome having a probability corresponding to the calculated probability of winning; (e.g., paragraph [0032], Fig. 2b, elements 214 and 215) and

in response to a winning pseudo-random outcome, (e.g., paragraph [0032], Fig. 2b, element 216) purchasing said selected one product from a corresponding third-party retail vendor for the user. (e.g., paragraph [0032], Fig. 2b, element 218).

Claim 22 provides for an alternative embodiment of the present invention with another method for allowing a user to play a game of chance to win a desired product. Claim 22 recites:

22. A method for providing a user an opportunity to win a product or service by playing a game of chance without buying the product or service and without paying a fee to play, comprising the steps of:

enabling the user to submit a search query associated with a type of product or service; (e.g., paragraph [0031, 0034], Fig. 2a, element 204)

conducting a search in a database for a third-party retail vendor product or service that satisfies the search query; (e.g., paragraph [0031], Fig. 2a, element 206)

automatically presenting a result of the search to the user, including at least one product or service offered for sale by said third-party retail vendor retrieved from the database, along with an option to play the game; (e.g., paragraph [0031], Fig. 2a, element 207)

enabling the user to select the product or service that he wants to win; (e.g., paragraphs [0031, 0033], Fig. 2a, element 208)

determining the user's chance of winning the selected product or service; (e.g., paragraph [0032], Fig. 2b, element 214)

generating an outcome for each play of the game that corresponds to the user's chance of winning; (e.g., paragraph [0032], Fig. 2b, element 215) and displaying the outcome of the game to the user. (e.g., paragraph [0032], Fig. 2b, element 217).

Claim 30 provides an embodiment of the present principles where the probability of winning a product or service is increased in response to a user participating in a particular sponsored survey. Claim 30 specifically recites:

30. The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor. (e.g., paragraph [0094]).

Claim 33 provides for an alternative embodiment of the present invention wherein the invention is directed to generating traffic through a website. Claim 33 recites:

33. A method for increasing user traffic to a search engine website, comprising:
- receiving a search query from a user system interacting with a search webpage of the website, the search query defining a desired product for the user; (e.g., paragraph [0031], Fig. 2a, elements 204 and 205) and
- transmitting a results webpage to the user system, the results page including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product (e.g., paragraph [0031], Fig. 2a, element 209) and further including in the same webpage a play link corresponding to said third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product corresponding to the third party website redirection link (e.g., paragraphs [0031, 0043], Fig. 2a, element 209).

Claim 35 provides for an embodiment of the present invention reciting an alternative method for generating traffic through a website. Claim 35 recites:

35. A method for increasing user traffic to a search website, comprising:
- providing a search webpage containing a search interface for a user to submit a search query for a product; (e.g., paragraphs [0031, 0043-0044], Fig. 2a, elements 204 and 205)
- receiving a search query from a user employing said search webpage; (e.g., paragraph [0031], Fig. 2a, element 204)

searching third party websites by reference to said query; (e.g., paragraph [0031], Fig. 2a, element 206)

retrieving product information and corresponding price from said third party websites for at least one products satisfying said query; (e.g., paragraph [0031], Fig. 2a, element 206)

providing a game of chance in response to a user selection of the link to win the product; (e.g., paragraph [0031], Fig. 2a, element 208) and purchasing the product from the third party for the user response to a favorable outcome in said game; (e.g., paragraph [0032], Fig. 2b, element 218)

transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the third party website, (e.g., paragraph [0054]) and a link to win the product; (e.g., paragraph [0031], Fig. 2a, element 210)

providing a game of chance in response to a user selection of the link to win the product; (e.g., paragraph [0031], Fig. 2a, elements 208 and 210) and purchasing the product from the third party for the user in response to a favorable outcome in said game. (e.g., paragraph [0032], Fig. 2b, element 218).

Claim 36 provides for an alternative embodiment of the present invention having a product search website apparatus that permits a user to play a game of chance to win a desired product. Claim 36 recites:

36. A product search website executing on a server storing a plurality of web pages, the website comprising:

a search page for a user submitting a query to the server for at least one product;

(e.g., paragraph [0031], Fig. 2a, elements 204 and 205)

a results webpage transmitted to the user, the results page including links to third party

website and a link to a play webpage of the website; (e.g., paragraphs [0031,

0053-0055], Fig. 2a, element 207)

a play webpage providing a game of chance for winning the product corresponding to a

selected play link from the results webpage; (e.g., paragraphs [0031, 0053-0055],

Fig. 2a, element 214) and

a product win webpage to indicate a favorable outcome in said game of chance for said

product. (e.g., paragraphs [0032, 0058], Fig. 9).

## **VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The following summaries are derived from the Examiner's Final Office Action dated May 21, 2007 and Non-Final Office Action dated May 18, 2006, both of which are attached in Appendix II.

### **A. Whether Claims 1, 2, 7-10, 12-15, 17-25, 27 and 31-36 are unpatentable under 35 U.S.C. § 103 over Walker in view of Roll**

The Examiner rejected claims 1, 2, 7-10, 12-15, 17-25, 27 and 31-36 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Application Pub. No. 2003/0054888, to Walker, *et al.*, (hereinafter, referred to as "Walker") in view of United States Patent Application Pub. No. 2003/0016779, to Roll, *et al.* (hereinafter, referred to as "Roll"). The Examiner opined that Walker discloses the claimed invention except for retrieving product information from a database storing third party retail vendor product information. (*See*, Final Rejection Page 3, first paragraph). The Examiner argued that "it would have been obvious at to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system." (Non-Final Office dated May 18, 2006).

### **B. Whether Claims 3-5 and 29 are unpatentable under 35 U.S.C. § 103 over Walker in view of Roll and Yoseloff**

Claims 3-5 and 29 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Roll, in further view of United States Patent No. 6,331,143, to Yoseloff, *et al.*, (hereinafter referred to as "Yoseloff"). The Examiner stated that "Yoseloff teaches about a system where a player selects a number and the system generates a random



number, and a winning outcome is indicated if the user-chosen number...” *See*, Office Action of May 18, 2006, page 11, second paragraph. According to the Examiner, it would have been obvious to combine Yoseloff with Walker and Roll to generate the embodiments claimed in claims 3-5 and 29. *Id.*

**C. Whether Claims 6, 11, 16, 26 and 28 are unpatentable under 35 U.S.C. § 103 over Walker in view of Roll and Angles**

The Examiner rejected claims 6, 11, 16, 26 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Roll, in further view of United States Patent No. 5,933,811, to Angles, *et al.*, (hereinafter referred to as “Angles”). The Examiner stated that “Angles teaches a system where users are compensated for viewing sponsors’ advertisements. *See*, Office Action dated May 18, 2006, page 13, third paragraph. The Examiner argued that “it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsor’s advertisements independently of the purchase of the advertised product or service as taught by Angles” *Id.*

**D. Whether Claim 30 is unpatentable under 35 U.S.C. § 103 over Walker in view of Roll, Angles and Yoseloff**

Claims 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker, in view of Roll, Angles and Yoseloff. The Examiner recognized that Walker “fails to teach wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor.” *See*, Office Action dated May 18, 2006, page 14,

third paragraph. The Examiner stated that it would have been obvious "to know that sponsors would compensate users for viewing the sponsors' advertisements or for participating in the sponsors' online surveys." See, Office Action dated May 18, 2006, page 13, third paragraph.

### **VIII. ARGUMENT**

#### **A. Claims 1, 2, 7-10, 12-15, 17-25, 27, and 31-36 Are Patentable Over the Combination of the Prior Art Because There is No Motivation to Combine the References**

The Examiner rejected Claims 1, 2, 7-10, 12-15, 17-25, 27, and 31-36 under 35 U.S.C. § 103(a) as being unpatentable over Walker *et al.*, United States Patent Application Pub. No. 2003/0054888 (hereinafter, referred to as "Walker") in view of United States Patent Application Pub. No. 2002/0016779 (hereinafter, referred to as "Roll").

The Examiner rejected independent claims 1, 10, 15, 21, 22, 33, 35 and 36 by applying the same arguments to each claim. Applicant respectfully asserts that Claim 1 is representative of independent Claims 10, 15, 21, 22, 33, 35 and 36, and that these independent claims stand or fall together. Furthermore, Claims 2-9 and 31-32 depend from independent Claim 1, Claims 11-14 depend from independent Claim 10, Claims 16-20 depend from independent Claim 15, Claims 23-30 depend from independent Claim 22, and claim 34 depends from independent Claim 33. By virtue of their dependencies, Claims 2-9, 11-14, 26-20, 23-32 and 34, have at least all of the features and limitations as the Claims from which they depend, and, therefore, stand or fall with the claims from which they ultimately depend.

The Examiner cited Walker as showing every element of each of the independent claims; however, the Examiner admitted that Walker does not expressly teach retrieving at least one product information from at least one database storing third-party retail vendor product

information. *See*, Office Action dated 5/18/2006, page 3. In the Examiner's view, "Roll teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest and received back a comparative list of providers of said item." *Id.* In addition, according to the Examiner, "Walker teaches third party manufacturers of products." *Id.* As a result, the Examiner opined that "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to users a list of different third-party providers vendors of users' selected products." *Id.* Accordingly, the Examiner concluded that the combination of references "would show to users the best third-party vendors' offers of products selected by users." *Id.*

In order for a claimed invention to be obvious, either alone or in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE § 2143-2143.03.

Applicants respectfully submit that there is no motivation to combine the references. It is well settled that an obviousness rejection is improper unless the prior art relied upon suggests the proposed combination. *See, In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Furthermore, the Supreme Court has recently reiterated that "a patent composed of several elements is not proved obvious by demonstrating that each of its elements was, independently, known in the prior art." *See, KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007) at 1741.

“[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant art to combine the elements in a way that the new invention does.” *Id.*

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.” *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Applicants respectfully submit that there is no rationale for the combination of Walker and Roll. In the present rejection, the Examiner stated, with respect to the combination of Walker in view of Roll that “it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to users a list of “the best third-party vendors’ offers of products selected by users.” See, Office Action date May 21, 2006, page 3.

The prior art references relied upon by the Examiner fail to provide any rationale for the combination asserted by the Examiner in rejecting the pending claims. The Examiner has further failed to provide any sort of rationale for the supposed obviousness to combine Walker and Roll. More specifically, the Examiner simply stated that “it would have been obvious to a person of ordinary skill...to know that Walker would be motivated to display to users a list of different third party vendors of user’s selected products.” See, Final Office Action dated May 21, 2006, page 8.

Applicants respectfully submit that the proffered motivation is insufficient to support a *prima facie* case of obviousness. Walker discloses a system and method wherein an individual retailer can increase the excitement associated with the shopping experience. See, Walker, page

3, paragraphs [0022, 0041]. The increased excitement attracts a greater number of customers capable of purchasing items at the retail store. These customers, in turn, are induced to purchase some of the retail store's products, increasing the overall profitability of the retail store. *See*, Walker, page 2, paragraph [0022].

According to Walker, to increase the excitement associated with shopping, a customer has the option to win a product from a retail store outright for a small percentage of the item's cost. *See*, Walker, paragraph [0041]. Alternatively, a customer can apply the cost associated with winning the product as a credit towards the purchase of the desired item. *See*, Walker, paragraph [0096]. The product can be manufactured by a third-party, however, it must be offered for sale at the retail store for it to generate customer excitement, and in turn, increased profits. *See*, Walker, paragraphs [0092, 0096, 0106].

Roll discloses a method wherein a user utilizes a search engine to search multiple providers for a product by using a program which is accessed from the Internet. *See*, Roll, paragraphs [0036, 0037]. After searching for the product, the user receives a comparative list of retailers (or other entities) that offer the item as well as terms (i.e., the price) for the item. *See*, Roll, paragraph [0040]. The system, in turn, allows a user to purchase products and services from competing retailers. *Id.*

#### **i. Roll teaches away from Walker**

Applicants respectfully submit that Roll teaches away from any combination with Walker. Therefore, a practitioner skilled in the art of online marketing would not be compelled to look to Roll to improve upon the shortcomings of Walker. The system of Walker results in *increased* profits for a single retail store, while Roll teaches a system that is designed for use by

multiple retailers which results in *lower* profits for the retailers via lowered prices to the consumer. Indeed, in describing the state of the art, Roll describes the typical use of pricing mechanisms as follows:

“Heretofore, available pricing mechanisms are primarily designed to promote transactions within either a) the line of service of the entity providing the listing (e.g., web sites, insurance company websites, mortgage company web sites, insurance company web sites, *retail stores* and discount stores...” See, Roll, paragraph [0006], emphasis added.

Roll also discloses the inherent flaws in such a system:

“Users may use these various pricing mechanisms in an effort to find the best terms for the purchase of an item. However, the users’ motivation can be in conflict with the motivation of the entity providing the pricing information, often the seller. The seller’s motivation is oftentimes to maximize profit, which means conducting the highest number of transactions with the highest margin possible.” See, Roll, paragraph [0007].

Roll explicitly describes the process taught by Walker as deficient. *Id.* Roll points out that a seller controlled system is designed to maximize profits *for the seller*, while still conducting the highest number of transactions possible. *Id.* Indeed, in light of the deficiencies of the system disclosed in Walker, one of the objects of Roll’s invention is to “enable the purchase of products and services from *competing* product/service providers.” See, Roll, paragraph [0013], emphasis added. Accordingly, one of ordinary skill in the art would not be motivated to combine the two references because the references expressly teach away from each other. In teaching away from combination with the likes of Walker, Roll describes the primary features taught by Walker as deficient, and seeks to surmount the shortcomings by providing a system and method benefitting a different audience. See, Roll, paragraph [0007].

In addition, neither of the cited references provide any other motivation or incentive for the combination suggested by the Examiner. Therefore, the obviousness rejection could only be

the result of a hindsight view with the benefit of Applicant's specifications. This type of analysis is inappropriate:

"To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." *Seasonics v. Aerosonic Corp.* 38 USPQ 2d 1551, 1554 (1996) (citations omitted).

Accordingly, the combination advanced by the Examiner is not legally proper -- on reconsideration the Examiner will undoubtedly recognize that such a position is merely an "obvious to try" argument.

Under the circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

"It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarter backing is quite improper when resolving the question of non-obviousness in a court of law." *Id.*

Applicants submit that the only "motivation" for the Examiner's combination of the references is provided by the teachings of Applicant's own disclosure. No such motivation is provided by the references themselves. Therefore, the rejection should be withdrawn.

#### **ii. Walker would be inoperative if combined with Roll**

Applicants further assert that, if the references were combined using the rationale proffered by the Examiner, Walker would be rendered inoperative for its intended purpose. According to the Examiner, "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to

users a list of different third-party providers vendors of users' selected products." *See*, Office Action dated May 21, 2006, page 3. However, such a combination would result in a state where Walker competed with itself by offering products sold by the competition. Accordingly, the system of Walker would not operate as intended, by offering its products with the added incentive of a chance to win a product. Rather, it would allow users the opportunity to win a product without the benefit of a possible sale, which may go to the third party vendor. Indeed, the Examiner admitted that such a combination would show to users the best third-party offers of products selected by users. *See*, Office Action dated May 21, 2006, page 3.

It is well settled that "if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MANUAL OF PATENT EXAMINING PROCEDURE § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Since the Examiner's proposed modification of Walker in view of Roll would render Walker unsatisfactory for its intended purpose, there can be no motivation to combine the references. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and the rejections should be withdrawn.

**iii. The combination of Walker and Roll fails to render the claimed invention obvious**

Even if the combination of Walker and Roll is proper, the combined references do not disclose the present invention. The resulting system of Walker in view of Roll would result in a system that provides a user with the opportunity to win or directly purchase a particular product from the party offering the product for sale. In addition, the combination would allow third-



party vendors to compete with the individual retailer by offering the item directly to the user at a lower cost.

More specifically, the Examiner contends that Walker teaches the purchase of a product from the third-party retail vendor. *See*, Office Action dated May 21, 2006, page 4. Applicants respectfully disagree. Walker does not allow a user to purchase a product from a third-party vendor. Instead, if the user wins a product, the customer is charged a game fee and receives the item directly from the offeror of the game. *See*, Walker, Abstract.

In contrast, the present invention comprises an improved shopping search engine. *See*, Abstract. When a user enters criteria related to a specific product, the search engine displays one or more third-party web pages that offer the particular product for sale. *See*, Page 1, paragraph [0025]. When the results are displayed, the user has the option to attempt to win the prize via one or more games of chance. *Id.* Alternatively, the user can simply click on one of the third-party vendor's links and purchase the product. *Id.* Both options are available to the user from one interface immediately after generating the appropriate search. If the user wins the product, the search engine purchases the product from the third-party vendor on behalf of the user. *See*, Page 2, paragraph [0032]. As a result, the present invention does not directly offer products for sale.

Thus, the present invention for the first time discloses a novel search engine with an option to win the item sought. This represents a vast improvement over the prior art. Further, the cited references neither teach nor suggest the novel and non-obvious features of this invention.

Applicant, therefore, respectfully requests the Board's withdrawal of the Examiner's §103(a) rejection of Claim 1. Furthermore, as claims 2-36 stand or fall with Claim 1, Applicant respectfully asserts that Claims 2-36 are patentable over the cited prior art references for at least

the same reasons as those discussed above for Claim 1, and respectfully request the Board's withdrawal of the Examiner's §103(a) rejection of Claims 2-36.

**B. Claims 3-5 and 29 Are Patentable Over the Prior Art Because There is No Motivation to Combine the References and the Combination of References Fail to Teach Every Element of the Claims**

Claims 3-5 and 29 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Roll, in further view of Yoseloff, *et al.*, United States Patent No. 6,331,143. (hereinafter referred to as "Yoseloff"). In the Office Action dated May 21, 2007, the Examiner asserted that the Yoseloff teaches a system for determining a winning game by generating a random number and displaying the resulting random number. *See, e.g.* Office Action May 18, 2006, page 11, second paragraph.

Claims 3-5 depend from independent claim 1, while claim 29 depends from independent Claim 22. Applicants respectfully reassert that independent Claims 1 and 22 are patentable over the cited prior art, as discussed above. Due to their dependencies on Claims 1 and 22, respectively, Claims 3-5 and 29 are patentable for at least the same reasons as Claims 1 and 22.

The Applicant further asserts that Claims 3-5 and 22 are patentable over the combination of Walker, Roll, and Yoseloff because these three cited prior art references fail to teach, suggest, or render obvious in any way, all of the limitations of claims 3-5 and 29.

**i. The combination of Walker, Roll and Yoseloff fails to render the claimed invention obvious**

Claims 3 and 29 recite similar elements, and were addressed together by the Examiner with a single argument. Claims 4 and 5 depend from claim 3, and, thus, stand or fall with Claim 3. Claim 3 depends directly from Claim 1, and recites:

“the pseudo-random outcome is indicated by displaying a user-chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number.”

Applicants respectfully assert that Walker, Roll and Yoseloff, taken singly, or in any combination, fail to remotely render obvious the features recited in Claim 3.

Claim 3 recites the feature of indicating a winning or losing outcome by displaying a number for comparison to a user's chosen number. The matching of the comparison number to the user's number indicates the pseudo-random outcome “corresponding to the calculated probability of winning”, as recited in claim 1. Applicants particularly draw the Board's attention to the fact that the comparison number is an element merely used for display, while the generated pseudo-random outcome recited in claim 1 is used to actually determine whether a user wins the game being played.

In contrast, as cited by the Examiner (*See*, Office Action dated May 18, 2006), Yoseloff teaches a video numbers game, similar to a lottery. *See*, Yoseloff, column 3, lns. 37-57, column 4, lns. 30-39. The numeric embodiment discussed by Yoseloff covers “a game which is similar to a daily numbers game...a single four digit number is selected by the player and a single four digit number is randomly selected by the microprocessor.” *See*, Yoseloff, column 8, lns. 35-43.

Under Yoseloff, the odds of a user winning the game are determined by the number of symbols or size of the number range from which the user may select. *See*, e.g. Yoseloff, column 8, lns. 37-42. Therefore, a user's odds of winning are fixed in relation to the preselected number of symbols. Yoseloff reiterates this point by stating "in the most preferred embodiment of the present invention, payout amounts for the basic numbers game are based solely on the probability of occurrence of each winning outcome without consideration for either the amount already wagered in the game or any other occurrence of a similar winning outcome" (*See*, Yoseloff, column 4, lns. 55-60) and "[t]he present invention contemplates using one or more types of symbols to alter the odds and allow for progressive versions of the game. For example, the four ball example of the present invention could be played with two different ball colors in the set. Alternatively, a much larger set of one type of symbols could be used." *See*, Yoseloff, column 9, lns. 21-26.

Therefore, Yoseloff teaches that the odds of winning are equal to the odds of two different symbol sets, or numbers, matching. In other words, the odds of winning a game, according to the teachings of Yoseloff, the outcome of the game is not pseudo-random, it is random. As cited above, Yoseloff discloses that the odds of winning are determined by changing the number of possible combinations, and that the outcome is random. Thus, under Yoseloff, any display of the outcome is a display of a random outcome, and not a display *indicating* a pseudo-random outcome. Furthermore, the number generated by the processor in Yoseloff, which the Examiner equates to the comparison number of Claim 3, determines the outcome of the game.

In contrast, Claim 3 recites that the displayed user-selected and comparison numbers *indicate* the pseudo-random outcome. Thus, the pseudo-random outcome is separate from the displayed numbers of Claim 3. According to the present principles, the odds of winning a

particular prize may be modified or tweaked based on the number of previous wins, the current prize budget, or the like. *See*, Pages 3-4, paragraphs [0058-0094]. It would be impossible to apply the fixed probabilities of Yoseloff to Claim 3 without significantly modifying the goals, process and results of Yoseloff or Claim 3.

It would not be obvious to even a highly skilled practitioner of the art to use the number comparison taught by Yoseloff, singly, or in any combination with Walker and Roll, to develop the display or the pseudo-random results recited in Claim 3. Similarly, Walker, Roll and Yoseloff fail to anticipate, suggest, or render obvious in any way, all of the elements of Claim 29.

Claims 4 and 5 depend directly from claim 3, and by their dependencies, include all of the features and elements recited in claim 3. Therefore, claims 4 and 5 are patentably distinct and non-obvious over the cited combination of Walker, Roll and Yoseloff for at least the same reasons as claim 3. In light of such non-obviousness, Applicants respectfully solicit the Board's reversal of the Examiner's §103 rejection of Claims 3-4 and 29.

**C. Claims 6, 11, 16, 26 And 28 Are Patentable Over the Prior Art Because There is No Motivation to Combine the References and the Combination of References Fail to Teach Every Element of the Claims**

The Examiner rejected claims 6, 11, 16, 26 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Roll, in further view of United States Patent No. 5,933,811, to Angles, *et al.* (hereinafter referred to as "Angles").

The Examiner asserts that "Angles teaches a system where users are compensated for viewing sponsors' advertisements (see column 16, lns. 38-45). Therefore, it would have been

obvious... to know that users of the Walker system would be compensated for viewing of select sponsors' advertisements independently of the purchase of the advertised product or service... and these compensations would allow users to play games to win the sponsors' advertise products." *See*, Office Action dated May 21, 2007, page 13, third paragraph.

**i. The combination of Walker, Roll and Angles fails to render the claimed invention obvious**

Claim 6 depends from independent claim 1, Claim 11 depends from independent Claim 10, Claim 16 depends from independent Claim 15, and Claims 26 and 28 depend from independent Claim 22. Applicants respectfully reassert that independent claims 1, 10, 15 and 22 are patentable over the cited prior art, as discussed above, and that Claims 6, 11, 16, 26 and 28 are patentable for at least the same reasons as Claims 1, 10, 15 and 22 due to their dependencies on the respective patentable independent claims.

Applicants further assert that the combination of Walker, Roll and Angles fails to render obvious all of the elements of Claims 6, 11, 16, 26 and 28. Claim 6 is representative of Claims 11, 16, 26 and 28. The cited prior art references particularly fail to teach, suggest, or in any way render obvious, at least the element of "providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation" as recited in Claim 6.

The Examiner appears to have equated paying a user for viewing an advertisement, as taught by Angles, with increasing a user's chance of winning in exchange for performing a task, as recited in Claim 6. Applicants respectfully dispute the Examiner's assertion that these two method steps are equivalent.

While the Examiner opines that “[c]ompensating users for viewing advertisements would be a good business decision as this would increase the probability that the users would view the sponsors’ advertisements and would play to win the advertised products, therefore increasing customer traffic and customer loyalty”, (See, e.g., Office Action dated May 21, 2007, page 14, first paragraph), Claim 6 does not recite any element where a user is compensated. In fact, according to the specification, “In return for directing the user to the sponsor’s web site, *the system receives revenue* from the sponsor. A portion of the revenue received is allocated to the prize budget, and the odds management component 107 increases the user’s probability of winning in response.” See, Page 6, paragraph [0095], emphasis added. Thus, when interpreted in light of the specification, Claim 6 clearly provides that the *system*, instead of a user, is compensated.

The Examiner’s assertions regarding successful business practices notwithstanding, having a third party directly compensate a user, as taught by Angles, gives the user the opportunity to keep any earned money without the referring website operator having the chance to recapture a portion of the money paid by a sponsor for a user viewing an advertisement. See, Angles, Column 16, lns. 35-37. In contrast, Claim 6 recites a method where the providing system retains all payments from third parties, awarding prizes based on a prize budget. See, Page 5, paragraph [0094]. Therefore, the teachings of Angles have no bearing on the elements recited in Claim 6.

The specification further illustrates that a user does not necessarily need to view an advertisement to increase their odds of winning a game. The specification recites: “[A] user’s probability of winning increases, for example, through continued play.” See, e.g., Page 6, paragraph [0096]. In such an embodiment, no compensation is paid to the system or the user.

Therefore, even a practitioner highly skilled in the art would not look to Angles to provide a solution for increasing a user's odds of winning by performing a task.

Furthermore, there is no indication in Angles that a user would use any compensation from a third party to play any game provided according to Angles. The mere hope that a user might use their compensation under Angles to play the paid game of chance taught by Walker and Roll cannot amount to obviousness.

Thus, Angles fails to render obvious the Claim 6 element of "providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation" because Angles presents no teaching that a skilled artisan would find obvious to develop into such an element. Therefore, Claim 6 is patentably distinct and nonobvious over the combination of Walker, Roll and Angles fails to render Claim 6.

Claims 11, 16, 26 and 28 all have elements analogous to, or depend from claims having analogous elements to, the element discussed above for claim 6. Therefore, Claims 11, 16, 26 and 28 are patentable for at least the same reasons as discussed above for Claim 6.

In light of the foregoing arguments, Applicants respectfully request the Board's reversal of the Examiner's §103(a) rejection of Claims 6, 11, 16, 26 and 28.

**D. Claim 30 is Patentable Over the Prior Art Because There is No Motivation to Combine the References and the Combination of References Fail to Teach Every Element of the Claim**

The Examiner rejected Claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Walker, in view of Roll, Angles and Yoseloff. The Examiner asserts that Angles teaches a method for providing a user an opportunity to increase the probability of winning a product or



service by participating in an online survey. *See*, Office Action dated May 18, 2007, page 14, third paragraph.

**i. The combination of Walker, Roll, Angles and Yoseloff fails to render the claimed invention obvious**

Claim 30 depends from Claim 29, and recites "The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor." The element recited by Claim 30 is analogous to that discussed above for Claims 6, 11, 16, 26 and 28. Therefore, by virtue of its dependency on Claim 29, Claim 30 has all of the features and limitations of Claim 29, is patentable over the cited art for at least the reasons set forth above for claim 29. Applicants further assert that, by having an limitation analogous to Claims 6, 11, 16, 26 and 28, Claim 30 is further patentable over the cited prior art for at least the same reasons as Claims 6, 11, 16 26 and 28.

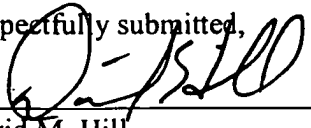
Applicants respectfully solicit the Board's reversal of the Examiner's §103(a) rejection of Claim 30.

**XI. CONCLUSION**

For at least the foregoing reasons, Applicant respectfully solicits the Board's reversal of the Examiner's rejections of Claims 1-36.

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## **APPENDIX I: CLAIMS**

1. A method of providing a user with a game of chance, the method comprising the steps of:
  - receiving electronic signals from a user system representing search parameters descriptive of a product;
  - retrieving at least one product information from at least one database storing third-party retail vendor product information;
  - transmitting electronic signals to the user system representing the retrieved product information and associated prices;
  - automatically providing the user with an option to play a game to win a selected product from said product information without the user first making any payment or requesting the option;
  - electronically calculating a probability of winning the selected product by the user;
  - electronically generating a pseudo-random outcome corresponding to the calculated probability of winning; and
  - in response to a winning pseudo-random outcome, purchasing the selected product for the user from the third-party retail vendor.
2. The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system.

3. The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user-chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number.
4. The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number.
5. The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number.
6. The method of claim 1, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation.
7. The method of claim 1, comprising calculating a probability of winning based on at least a current budget.
8. The method of claim 1, comprising calculating a probability  $P$  of winning based on a total number of game players.
9. The method of claim 1, comprising calculating a probability  $P$  of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;  
and

$N$  is a number of current users.

10. A method of providing a user with a game of chance, the method comprising:
  - receiving electronic signals from a user system representing at least one search parameter descriptive of a product;
  - retrieving at least one product information from at least one database storing third-party retail vendor product information;
  - transmitting electronic signals to the user system representing at a least one product, a price of the product and a third-party retail vendor of the product;
  - automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment or requesting the first option, and a second option to purchase the product;

if the user chooses to play the game:

electronically calculating a probability of winning the product by the user;

electronically generating a pseudo-random outcome corresponding to the

calculated probability of winning; and

in response to a winning pseudo-random outcome, purchasing the product for the

user from the third-party retail vendor; and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product.

11. The method of claim 10, comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party provides compensation.

12. The method of claim 10, comprising calculating a probability of winning based on at least a current budget.

13. The method of claim 10, comprising calculating a probability P of winning based on a total number of game players.

14. The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

$P_a$  is a probability factor that varies with the cost of the selected product in

relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;

and

$N$  is a number of current users.

15. A method of providing a user with a game of chance, the method comprising:
  - receiving electronic signals from a user system representing at least one search parameter descriptive of a product;
  - retrieving at least one product information from at least one database storing third-party retail vendor product information;
  - transmitting electronic signals to the user system representing a plurality of different third-party retail vendors and associated prices charged by each of said different third-party retail vendors for products identified in response to said at least one search parameter;
  - automatically transmitting electronic signals to the user system representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and
  - if the user chooses to play the game:
    - electronically calculating a probability of winning said selected one product by the user;

electronically generating a pseudo-random outcome corresponding to the  
calculated probability of winning; and  
in response to a winning pseudo-random outcome, purchasing said selected one  
product from a corresponding third-party retail vendor for the user.

16. The method of claim 15, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation.
17. The method of claim 15, comprising calculating a probability of winning based on at least a current budget.
18. The method of claim 15, comprising calculating a probability P of winning based on a total number of game players.
19. The method of claim 15, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;

and

$N$  is a number of current users.

20. The method of claim 15, wherein the electronic signals representing the associated prices charged by each of said different dealers, represent the prices charged on said each of said different dealers' own web sites.

21. A method of providing a user with a game of chance, the method comprising:

- receiving electronic signals from a user system representing at least one search parameter descriptive of a product;
- searching for products matching said at least one search parameter;
- transmitting electronic signals to the user system representing a plurality of third-party retail vendors and associated prices charged by each of said third-party retail vendors for products identified in response to said at least one search parameter, each of the products identified being offered for sale on a corresponding web site of each third-party retail vendor;
- automatically transmitting electronic signals to the user representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and
- if the user chooses to play the game:



electronically calculating a probability of winning said selected one product by  
the user;

electronically generating a pseudo-random outcome having a probability  
corresponding to the calculated probability of winning; and

in response to a winning pseudo-random outcome, purchasing said selected one  
product from a corresponding third-party retail vendor for the user.

22. A method for providing a user an opportunity to win a product or service by playing a  
game of chance without buying the product or service and without paying a fee to play,  
comprising the steps of:

enabling the user to submit a search query associated with a type of product or  
service;

conducting a search in a database for a third-party retail vendor product or service  
that satisfies the search query;

automatically presenting a result of the search to the user, including at least one  
product or service offered for sale by said third-party retail vendor  
retrieved from the database, along with an option to play the game;

enabling the user to select the product or service that he wants to win;

determining the user's chance of winning the selected product or service;

generating an outcome for each play of the game that corresponds to the user's  
chance of winning; and

displaying the outcome of the game to the user.

23. The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win.
24. The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of enabling the user to increase the chance of winning the selected product or service through repeated plays of the game.
25. The method for providing a user an opportunity to win a product or service of claim 22 wherein the step of determining the user's chance of winning the selected product or service is a function of at least one of a cost of the product or service, a number of other users playing to win the product or service concurrently, a current prize budget and an amount of funds received from an advertising sponsor.
26. The method for providing a user an opportunity to win a product or service of claim 25 wherein the advertising sponsor provides funds for the purchase of the selected product or service to a game provider as a payment for a display of an advertisement to the user during each play of the game.
27. The method for providing a user an opportunity to win a product or service of claim 25 wherein the step of determining the user's chance of winning the selected product or service is a function of the user's behavior during repeated plays of the game.

28. The method for providing a user an opportunity to win a product or service of claim 26 wherein the user's repeated plays of the game generates revenue from the advertising sponsor for a game provider which increases the user's chance of winning the selected product or service.
29. The method for providing a user an opportunity to win a product or service of claim 22 wherein the game of chance comprises displaying a number selected by the user along with the number generated to represent the outcome for each play of the game.
30. The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor.
31. The method of Claim 1, further comprising collecting a database of third party retail vendor product information prior to receiving the search parameters from the user.
32. The method of Claim 1 whereby transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the third party retail vendor and a link to initiate playing to win the same product.
33. A method for increasing user traffic to a search engine website, comprising:

receiving a search query from a user system interacting with a search webpage of the website, the search query defining a desired product for the user; and transmitting a results webpage to the user system, the results page including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to said third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product corresponding to the third party website redirection link.

34. The method of claim 33, wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the third party vendor corresponding to the third party website redirection link.
35. A method for increasing user traffic to a search website, comprising:  
providing a search webpage containing a search interface for a user to submit a search query for a product;  
receiving a search query from a user employing said search webpage;  
searching third party websites by reference to said query;

retrieving product information and corresponding price from said third party websites for  
at least one products satisfying said query;  
providing a game of chance in response to a user selection of the link to win the product;  
and purchasing the product from the third party for the user response to a  
favorable outcome in said game;  
transmitting at least one results webpage to the user, the results webpage including at  
least one link for the product information, a corresponding price, a link to the  
third party website, and a link to win the product;  
providing a game of chance in response to a user selection of the link to win the product;  
and  
purchasing the product from the third party for the user in response to a favorable  
outcome in said game.

36. A product search website executing on a server storing a plurality of web pages, the website comprising:
- a search page for a user submitting a query to the server for at least one product;
  - a results webpage transmitted to the user, the results page including links to third party website and a link to a play webpage of the website;
  - a play webpage providing a game of chance for winning the product corresponding to a selected play link from the results webpage; and
  - a product win webpage to indicate a favorable outcome in said game of chance for said product.

## **APPENDIX II: EVIDENCE**

Exhibit 1: Final Office Action Dated May 21, 2007

Exhibit 2: Non-Final Office Action dated May 18, 2006

Exhibit 3: Amendment and Request for Continued Examination dated February 27, 2006

### **APPENDIX III: RELATED PROCEEDINGS**

Exhibit 4: Final Office Action dated June 27, 2005

Exhibit 5: Pre-Appeal Brief Request for Review, dated September 26, 2005

Exhibit 6: Panel Decision from Pre-Appeal Brief Review, dated December 13, 2005

**EXHIBIT 1**





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839

26158 7590 05/21/2007  
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC  
ATTN: PATENT DOCKETING 32ND FLOOR  
P.O. BOX 7037  
ATLANTA, GA 30357-0037

EXAMINER

LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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05/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/759,103	CLARK ET AL.	
	Examiner	Art Unit	
	DANIEL LASTRA	3622	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                    |
|--------------------------------------------------------------------------------------|--------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                           |

**DETAILED ACTION**

1. Claims 1-36 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

***Response to Amendment***

2. In response to Non Final Rejection filed 05/18/2006, the Applicant filed a Request for reconsideration on 08/18/2006.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7-10, 12-15, 17-25, 27, 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 2003/0054888) in view of Roll (US 2002/0016779).

As per claims 10 and 20-22, Walker teaches:

A method of providing a user with a game of chance, the method comprising:  
receiving electronic signals from a user system representing at least one search parameter descriptive of a product (see Walker paragraph 39);  
transmitting electronic signals to the user system representing at a least one product, a price of the product and a third-party retail vendor of the product (see Walker

paragraphs 38 and 39). Walker does not expressly teach retrieving at least one product information from at least one database storing third-party retail vendor product information. However, Roll teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest (see Roll paragraphs 44-46) and receive back a comparative list of providers of said item, as well as terms of offer for said item (see Roll paragraph 57 and abstract, paragraph 61). Rolls also teaches that his present invention include, but are not limited to, pricing mechanisms for insurance, loans, credit cards, automobiles and other consumer pricing applications (see Roll paragraph 19). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would be motivated to display to users a list of different third-party providers vendors of users' selected products, as taught by Roll, where said users would have the opportunity to play a game to win said products in order to enable said users the purchase of products from competing product providers, therefore obtaining the best price, with the added incentive of allowing said users to even play a game in order to obtain said products for free (see Walker paragraphs 125, 130).

automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment (see Walker paragraph 130), or requesting the first option and a second option to purchase the product (see Walker paragraphs 34; 149);

if the user chooses to play the game:

electronically calculating a probability of winning the product by the user;  
electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 144); and

in response to a winning pseudo-random outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39);

and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product (see Walker paragraph 34,149-151);

As per claim 1, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing search parameters descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing the retrieved product information and associated prices (see Walker figure 6). Walker does not expressly teach retrieving at least one product information from at least one database storing third-party retail vendor product information. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 1.

automatically providing the user an option to play a game to win a selected product from said product information without the user first making any payment (see paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a probability of winning the selected product or service by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing the selected product for the user from the third-party retail vendor (see Walker paragraph 145; paragraph 39).

As per claim 15, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing a plurality of different third-party retail vendors and associated prices charged by each of said different third-party retail vendors for products identified in response to said at least one search parameter (see Walker figure 6). Walker does not expressly teach retrieving at least one product information from at least one database storing third-party retail vendor product information. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 15.

automatically transmitting electronic signals to the user system representing an option to play a game to win a selected product or service without the user first making any payment (see Walker paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a probability of winning said selected one product by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing said selected one product from a corresponding third-party retail vendor for the user (see Walker paragraph 145; paragraph 39).

As per claims 7, 12 and 17, Walker teaches:

The method of claim 10, comprising calculating a probability of winning based on at least a current budget (see Walker paragraph 144).

As per claims 8, 13 and 18, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on a total number of game players (see Walker paragraph 110).

As per claim 23, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win (see Walker paragraphs 129-131).

As per claim 25, the same rejection applied to claims 7-8 is applied to claim 25.

As per claims 2, 24 and 27, Walker teaches:

The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system (see Walker paragraphs 26 and 89).

As per claims 9, 14 and 19, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

Walker does not expressly teach  $P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see Walker paragraph 143).

$P_t$  is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

$P_u$  is probability factor that varies with the user's behavior during a user session (see Walker paragraph 88); and



N is a number of current users (see Walker paragraph 110).

As per claim 31, Walker fails to teach:

The method of Claim 1, further comprising collecting a database of third party retail vendor product information prior to receiving the search parameters from the user. However, Roll teaches collecting a database of third party retail vendor prior to receiving a query request from a user (see Roll paragraph 61). Therefore, the same rejection applied to claim 10 regarding the third-party vendor database missing limitation is also made in claim 31.

As per claim 32, Walker teaches:

The method of Claim 1 whereby transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the third party retail vendor and a link to initiate playing to win the same product (see Walker paragraph 39).

As per claim 33, Walker teaches:

A method for increasing user traffic to a search engine website, comprising:

transmitting a results webpage to the user system, the results page including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to said third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product corresponding to the third party website redirection link (see Walker paragraph 39). Walker fails to teach receiving a search query from a user system interacting with a

search webpage of the website, the search query defining a desired product for the user. However, Roll teaches a system that provides a comparative and variable pricing system that allows users to search for an item via an Internet browser (see Roll paragraphs 44-46) and receive back a comparative list of providers of said item, as well as terms of offer for the item (see Roll paragraph 57 and abstract, paragraph 61). Roll also teaches that his present invention include, but are not limited to, pricing mechanisms for insurance, loans, credit cards, automobiles and other consumer pricing applications (see Roll paragraph 19). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would be motivated to display to users a list of different third-party providers vendors of users' selected products, as taught by Roll, where said users would have the opportunity to play a game to win said products in order to enable said users the purchase of products from competing product providers, therefore obtaining the best price, with the added incentive of allowing said users to even play a game in order to obtain said products for free (see Walker paragraphs 125, 130).

As per claim 34, Walker does not expressly teach:

The method of claim 33, wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the third party vendor corresponding to the third party

Art Unit: 3622

website redirection link. However, Roll teaches a search engine website which facilitates the purchase of a product from a third party vendor (see Roll paragraph 57). Therefore, the same rejection applied to claim 33 is also applied to claim 34.

As per claims 35 and 36, Walker teaches:

A method for increasing user traffic to a search website, comprising:

retrieving product information and corresponding price from said third party websites for at least one products satisfying said query (see Walker paragraphs 38-39);

providing a game of chance in response to a user selection of the link to win the product; and purchasing the product from the third party for the user response to a favorable outcome in said game; transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the third party website, and a link to win the product (see Walker paragraphs 38-40);

providing a game of chance in response to a user selection of the link to win the product (see Walker paragraph 40); and

purchasing the product from the third party for the user in response to a favorable outcome in said game (see Walker paragraph 41).

Walker fails to teach:

providing a search webpage containing a search interface for a user to submit a search query for a product; receiving a search query from a user employing said search webpage; searching third party websites by reference to said query. However, the same

rejection applied to claim 33 regarding these missing limitations is also applied to claim 35.

4. Claims 3-5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view Yoseloff (U.S. 6,331,143).

As per claims 3 and 29, Walker teaches:

The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see Yoseloff column 8, lines 35-50; column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker teaches:

The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a system (see Yoseloff column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker teaches:

The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to

the provider of the products (see Walker paragraph 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

5. Claims 6, 11, 16, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view of Angles et al (U.S. 5,933,811).

As per claims 6, 11, 16, 26, 28 Walker teaches:

The method of claim 10, but fails to teach comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party, such as a game provider, provides compensation. However, Angles teaches a system where users are compensated for viewing sponsors' advertisements (see column 16, lines 38-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsors' advertisements independently of the purchase of the advertised product or service, as taught by Angles and these compensations would allow users to play games to win the sponsors' advertise products, as taught by Walker.

Compensating users for viewing advertisements would be a good business decision as this would increase the probability that users would view the sponsors' advertisements and would play to win the advertise products, therefore increasing customer traffic and customer loyalty.

6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view of Angles et al (U.S. 5,933,811) and Yoseloff (US 6,331,143).

As per claim 30, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 29 but fails to teach wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that sponsors would compensate users for viewing the sponsors' advertisements or for participating in the sponsors' online surveys. Sponsors would compensate users by allowing the users to play games to win the sponsors' products.

#### ***Response to Arguments***

7. Applicant's arguments filed 11/03/2006 have been fully considered but they are not persuasive. The Applicant argues that there is no motivation to combine Walker with Rolls and that the references teaches away from each other, because according to the Applicant, the Walker reference results in increase profits for a single retail store, while Rolls teaches a system that is designed for use by multiple retailers which result in

Art Unit: 3622

lower profits by the retailers via lowered prices to the consumer. The Examiner answers that a user would be motivated to use the Walker and Roll system in order to find the best possible price (i.e. lower price) for a product by comparing the offer price of different providers with the added incentive of allowing said user to play a game in order to obtain said product for free. Therefore, contrary to Applicant's argument, Walker and Roll are combinable.

The Applicant further argues that Walker does not allow a user to purchase a product from a third party vendor because according to the Applicant, if the user wins a product, the customer is charged a game fee and receives the item directly from the offeror of the game. The Examiner answers that Walker teaches an embodiment where is not necessary to pay a fee to play a game (see paragraph 130, 152) and also Walker teaches the purchase of products from websites run by retailers (see paragraph 104). Therefore, contrary to Applicant's argument, Walker allow users to purchase a product from a third party vendor (i.e. retailer).

### **Conclusion**

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



Art Unit: 3622


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL  
Daniel Lastra  
March 31, 2007

  
RETTA YERDEGA  
PRIMARY EXAMINER

## EXHIBIT 2



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839
26158	7590	05/18/2006	EXAMINER	
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC ATTN: PATENT DOCKETING 32ND FLOOR P.O. BOX 7037 ATLANTA, GA 30357-0037			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/759,103		CLARK ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	DANIEL LASTRA		3622	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

1. Claims 1-36 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

***Response to Amendment***

2. In response to Final Rejection filed 06/27/2005, the Applicant filed an RCE on 03/03/2006, which amended claims 1, 10, 15, 21, 22 and added new claims 31-36.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 7-10, 12-15, 17-25, 27, 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 2003/0054888) in view of Roll (US 2002/0016779).

As per claims 10 and 20-22, Walker teaches:

A method of providing a user with a game of chance, the method comprising:

receiving electronic signals *from a user system* representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals *to the user system* representing at least one product, a price of the product and a third-party retail vendor of the product (see Walker

paragraphs 38 and 39). Walker does not expressly teach *retrieving at least one product information from at least one database storing third-party retail vendor product information*. However, Roll teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest (see Roll paragraphs 44-46) and receive back a comparative list of providers of said item, as well as terms of offer for said item (see Roll paragraph 57 and abstract, paragraph 61). Rolls also teaches that his present invention include, but are not limited to, pricing mechanisms for insurance, loans, credit cards, automobiles and other consumer pricing applications (see Roll paragraph 19). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to users a list of different third-party providers vendors of users' selected products, which users would like to play games to win said selected products (see Walker paragraphs 38-39). This feature would show to users the best third-party vendors' offers of products selected by users.

automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment (see Walker paragraph 130), or requesting the first option and a second option to purchase the product (see Walker paragraphs 34; 149);

if the user chooses to play the game:

electronically calculating a probability of winning the product by the user; electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 144); and

in response to a winning pseudo-random outcome, purchasing the product for the user (see Walker paragraph 145) *from the third-party retail vendor* (see Walker paragraph 39);

and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product (see Walker paragraph 34,149-151);

As per claim 1, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals *from a user system* representing search parameters descriptive of a product (see Walker paragraph 39);

transmitting electronic signals *to the user system* representing the *retrieved product information* and associated prices (see Walker figure 6). Walker does not expressly teach *retrieving at least one product information from at least one database storing third-party retail vendor product information*. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 1.

automatically providing the user an option to play a game to win a selected product *from said product information* without the user first making any payment (see paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a probability of winning the selected product or service by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing the selected product for the user *from the third-party retail vendor* (see Walker paragraph 145; paragraph 39).

As per claim 15, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals *from a user system* representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals *to the user system* representing a plurality of different *third-party retail vendors* and associated prices charged by each of said different *third-party retail vendors* for products identified in response to said at least one search parameter (see Walker figure 6). Walker does not expressly teach *retrieving at least one product information from at least one database storing third-party retail vendor product information*. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 15.



automatically transmitting electronic signals *to the user system* representing an option to play a game to win a selected product or service without the user first making any payment (see Walker paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a probability of winning said selected one product by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing said selected one product from a corresponding *third-party retail vendor* for the user (see Walker paragraph 145; paragraph 39).

As per claims 7, 12 and 17, Walker teaches:

The method of claim 10, comprising calculating a probability of winning based on at least a current budget (see Walker paragraph 144).

As per claims 8, 13 and 18, Walker teaches:

The method of claim 10, comprising calculating a probability  $P$  of winning based on a total number of game players (see Walker paragraph 110).

As per claim 23, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win (see Walker paragraphs 129-131).

As per claim 25, the same rejection applied to claims 7-8 is applied to claim 25.

As per claims 2, 24 and 27, Walker teaches:

The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system (see Walker paragraphs 26 and 89).

As per claims 9, 14 and 19, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

Walker does not expressly teach  $P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see Walker paragraph 143).

$P_t$  is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

$P_u$  is probability factor that varies with the user's behavior during a user session (see Walker paragraph 88); and

N is a number of current users (see Walker paragraph 110).

As per claim 31, Walker fails to teach:

The method of Claim 1, further comprising collecting a database of third party retail vendor product information prior to receiving the search parameters from the user. However, Roll teaches collecting a database of third party retail vendor prior to receiving a query request from a user (see Roll paragraph 61). Therefore, the same rejection applied to claim 10 regarding the third-party vendor database missing limitation is also made in claim 31.

As per claim 32, Walker teaches:

The method of Claim 1 whereby transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the third party retail vendor and a link to initiate playing to win the same product (see Walker paragraph 39).

As per claim 33, Walker teaches:

A method for increasing user traffic to a search engine website, comprising:

transmitting a results webpage to the user system, the results page including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to said third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product corresponding to the third party website redirection link (see Walker paragraph 39). Walker fails to teach receiving a search query from a user system interacting with a

search webpage of the website, the search query defining a desired product for the user. However, Roll teaches a system that provides a comparative and variable pricing system that allows users to search for an item via an Internet browser (see Roll paragraphs 44-46) and receive back a comparative list of providers of said item, as well as terms of offer for the item (see Roll paragraph 57 and abstract, paragraph 61). Roll also teaches that his present invention include, but are not limited to, pricing mechanisms for insurance, loans, credit cards, automobiles and other consumer pricing applications (see Roll paragraph 19). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to users a list of different third-party providers vendors of users' selected products, which users would like to play games to win said selected products (see Walker paragraphs 38-39). This feature would show to users the best third-party vendors' offers of products selected by users.

As per claim 34, Walker does not expressly teach:

The method of claim 33, wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the third party vendor corresponding to the third party website redirection link. However, Roll teaches a search engine website which

facilitates the purchase of a product from a third party vendor (see Roll paragraph 57).

Therefore, the same rejection applied to claim 33 is also applied to claim 34.

As per claims 35 and 36, Walker teaches:

A method for increasing user traffic to a search website, comprising:

retrieving product information and corresponding price from said third party websites for at least one products satisfying said query (see Walker paragraphs 38-39);

providing a game of chance in response to a user selection of the link to win the product; and purchasing the product from the third party for the user response to a favorable outcome in said game; transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the third party website, and a link to win the product (see Walker paragraphs 38-40);

providing a game of chance in response to a user selection of the link to win the product (see Walker paragraph 40); and

purchasing the product from the third party for the user in response to a favorable outcome in said game (see Walker paragraph 41).

Walker fails to teach:

providing a search webpage containing a search interface for a user to submit a search query for a product; receiving a search query from a user employing said search webpage; searching third party websites by reference to said query. However, the same rejection applied to claim 33 regarding these missing limitations is also applied to claim 35.

5. Claims 3-5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view Yoseloff (U.S. 6,331,143).

As per claims 3 and 29, Walker teaches:

The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see Yoseloff column 8, lines 35-50; column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker teaches:

The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a system (see Yoseloff column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker teaches:

The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to the provider of the products (see Walker paragraph 26). Therefore, it would have been

obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

6. Claims 6, 11, 16, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view of Angles et al (U.S. 5,933,811).

As per claims 6, 11, 16, 26, 28 Walker teaches:

The method of claim 10, but fails to teach comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party, such as a game provider, provides compensation. However, Angles teaches a system where users are compensated for viewing sponsors' advertisements (see column 16, lines 38-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsors' advertisements independently of the purchase of the advertised product or service, as taught by Angles and these compensations would allow users to play games to win the sponsors' advertise products, as taught by Walker. Compensating users for viewing advertisements would be a good business decision as



this would increase the probability that users would view the sponsors' advertisements and would play to win the advertise products, therefore increasing customer traffic and customer loyalty.

7. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Roll (US 2002/0016779) and further in view of Angles et al (U.S. 5,933,811) and Yoseloff (US 6,331,143).

As per claim 30, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 29 but fails to teach wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that sponsors would compensate users for viewing the sponsors' advertisements or for participating in the sponsors' online surveys. Sponsors would compensate users by allowing the users to play games to win the sponsors' products.

#### **Response to Arguments**

8. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

#### **Conclusion**


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

Application/Control Number: 09/759,103  
Art Unit: 3622

Page 15

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel Lastra  
April 29, 2006

  
RETTA YENDEGE  
PRIMARY EXAMINER

### EXHIBIT 3



PTO/SB/21 (02-04)  
Approved for use through 07/31/2008. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE  
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/759,103	
	Filing Date	01/12/2001	
	First Named Inventor	Clark	
	Art Unit	3622	
	Examiner Name	Daniel Lastra	
Total Number of Pages in This Submission	28	Attorney Docket Number	632-001

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input checked="" type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): 1. Return Receipt Postcard
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual name	James L. Lynch	Reg. No: 54,763
Signature		
Date	February 27, 2006	

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.		
Typed or printed name	James L. Lynch	
Signature		Date 02/27/2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PTO/SB/17 (01-06)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

**FEE TRANSMITTAL**  
**For FY 2006**☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 395.00

**Complete if Known**

Application Number 09/759,103

Filing Date 01/12/2001

First Named Inventor Clark

Examiner Name Daniel Lastra

Art Unit 3622

Attorney Docket No. 632-001

**METHOD OF PAYMENT (check all that apply)**☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 23-0420 Deposit Account Name: Ward & Olivo

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17☐ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>
- 20 or HP = _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20.		
<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>
- 3 or HP = _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3.		

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fees Paid (\$)
- 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____				

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Request for Continued Examination Fee

Fees Paid (\$)

395.00

**SUBMITTED BY**

Signature	Registration No. (Attorney/Agent) 54,763	Telephone (908) 277-3333
Name (Print/Type) James L. Lynch		Date 02/27/2006

This collection of information is required by 37 CFR 1.138. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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#RCE  
JFW

PTO/SB/30 (04-05)

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**Request  
for  
Continued Examination (RCE)  
Transmittal**Address to:  
Mail Stop RCE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Application Number	09/759,103
Filing Date	January 12, 2001
First Named Inventor	Clark
Art Unit	3622
Examiner Name	Daniel Lastra
Attorney Docket Number	632-001

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application. Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_

ii. ☐ Other \_\_\_\_\_

b. ☒ Enclosed

i. ☒ Amendment/Reply

iii. ☐ Information Disclosure Statement (IDS)

ii. ☐ Affidavit(s)/ Declaration(s)

iv. ☐ Other \_\_\_\_\_

2. **Miscellaneous**

a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)

b. ☐ Other \_\_\_\_\_

3. **Fees** The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed. The Director is hereby authorized to charge the following fees, any underpayment of fees, or credit any overpayments, to Deposit Account No. 23-0420. I have enclosed a duplicate copy of this sheet.

a. ☒ RCE fee required under 37 CFR 1.17(e)

ii. ☒ Extension of time fee (37 CFR 1.136 and 1.17)

iii. ☐ Other \_\_\_\_\_

b. ☒ Check in the amount of \$ 395.00 enclosed

c. ☐ Payment by credit card (Form PTO-2038 enclosed)

03/06/2006 ABIZUNES 00000031 09759103  
01 FC:2801 395.00 0P

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED			
Signature		Date	02/27/2006
Name (Print/Type)	James L. Lynch	Registration No.	54,763

CERTIFICATE OF MAILING OR TRANSMISSION	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.	
Signature	
Name (Print/Type)	James L. Lynch
Date	02/27/2006

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**PATENT APPLICATION FEE DETERMINATION RECORD**  
Substitute for Form PTO-875

Application or Docket Number

09759103

**CLAIMS AS FILED - PART I**

(Column 1) (Column 2)

FOR	NUMBER FILED	NUMBER EXTRA
BASIC FEE (37 CFR 1.16(a))		
TOTAL CLAIMS (37 CFR 1.16(c))	5 minus 20 =	8
INDEPENDENT CLAIMS (37 CFR 1.16(b))	1 minus 3 =	8

MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(d))

\* If the difference in column 1 is less than zero, enter "0" in column 2.

**SMALL ENTITY**

OR

**OTHER THAN SMALL ENTITY**

RATE	FEE
	\$ 355
x \$ 9 =	
x \$ 70 =	
+ \$ =	
TOTAL	355

RATE	FEE
	\$
x \$ =	
x \$ =	
+ \$ =	
TOTAL	

**CLAIMS AS AMENDED - PART II**

(Column 1) (Column 2) (Column 3)

AMENDMENT A	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total (37 CFR 1.16(c))	36	30	6
Independent (37 CFR 1.16(b))	8	5	3

FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(d))

**SMALL ENTITY**

OR

**OTHER THAN SMALL ENTITY**

RATE	ADDITIONAL FEE
x \$ 25 =	225
x \$ 100 =	300
+ \$ =	
TOTAL ADD'L FEE	525

RATE	ADDITIONAL FEE
x \$ =	
x \$ =	
+ \$ =	
TOTAL ADD'L FEE	

AMENDMENT B	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total (37 CFR 1.16(c))	38	38	0
Independent (37 CFR 1.16(b))	16	16	0

FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(d))

RATE	ADDITIONAL FEE
x \$ =	
x \$ =	
+ \$ =	
TOTAL ADD'L FEE	

RATE	ADDITIONAL FEE
x \$ =	
x \$ =	
+ \$ =	
TOTAL ADD'L FEE	

AMENDMENT C	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total (37 CFR 1.16(c))			
Independent (37 CFR 1.16(b))			

FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(d))

RATE	ADDITIONAL FEE
x \$ =	
x \$ =	
+ \$ =	
TOTAL ADD'L FEE	

RATE	ADDITIONAL FEE
x \$ =	
x \$ =	
+ \$ =	
TOTAL ADD'L FEE	

- \* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
- \*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".
- \*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".

The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and to USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comment on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Clark *et al.*

5

Serial No.: 09/759,103

Group Art Unit: 3622

Filed: January 12, 2001

Examiner: Daniel Lastra

For: SEARCH ENGINE PROVIDING AN    Atty. Docket No.: 632-001  
OPTION TO WIN THE ITEM SOUGHT

Honorable Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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**AMENDMENT AND REQUEST FOR CONTINUED EXAMINATION**

SIR:

In response to the December 13, 2005 Notice of Panel Decision from Pre-Appeal Brief

15    Review and the Final Office Action dated June 27, 2005 in the above mentioned case, Applicants  
respectfully request reconsideration in view of the following amendments and remarks:

**Amendments to the Claims** begin on Page 2 of this paper.

20    **Remarks** begin on Page 17 of this paper.



## IN THE CLAIMS

This listing of claims shall replace all prior versions and listings of claims in the application:

1. (Currently amended) A method of providing a user with a game of chance, the method  
5 comprising the steps of:

receiving electronic signals from a user system representing search  
parameters descriptive of a product ~~or service~~;

retrieving at least one product information from at least one database storing  
third-party retail vendor product information;

10 transmitting electronic signals to the user system representing ~~dealers in the~~  
retrieved product or service information and associated prices;

automatically providing the user with an option to play a game to win a selected  
product ~~or service~~ from said product information without the user first  
making any payment or requesting the option;

15 electronically calculating a probability of winning the selected product ~~or service~~  
by the user;

electronically generating a pseudo-random outcome corresponding to the  
calculated probability of winning; and

in response to a winning pseudo-random outcome, purchasing the selected  
20 product ~~or service~~ for the user from the third-party retail vendor.

2. (Previously presented) The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system.

5 3. (Previously presented) The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user-chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number.

10

4. (Previously presented) The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number.

15

5. (Previously presented) The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number.

20

6. (Previously presented) The method of claim 1, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation.

7. (Previously presented) The method of claim 1, comprising calculating a probability of winning based on at least a current budget.

8. (Previously presented) The method of claim 1, comprising calculating a probability P of winning based on a total number of game players.

9. (Previously presented) The method of claim 1, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;

and

$N$  is a number of current users.

10. (Currently amended) A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

5 retrieving at least one product information from at least one database storing

third-party retail vendor product information;

transmitting electronic signals to the user system representing at a least one product, a price of the product and a third-party ~~dealer~~ retail vendor of the product;

10 automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment or requesting the first option, and a second option to purchase the product;

if the user chooses to play the game:

15 electronically calculating a probability of winning the product by the user;  
electronically generating a pseudo-random outcome corresponding to the  
calculated probability of winning; and

in response to a winning pseudo-random outcome, purchasing the product for the user from the third-party retail vendor; and

20 if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product.

11. (Previously presented) The method of claim 10, comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party provides compensation.

5 12. (Previously presented) The method of claim 10, comprising calculating a probability of winning based on at least a current budget.

13. (Previously presented) The method of claim 10, comprising calculating a probability P of winning based on a total number of game players.

10

14. (Previously presented) The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

15

where:

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

20

$P_u$  is probability factor that varies with the user's behavior during a user session;

and

$N$  is a number of current users.

15. (Currently amended) A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

5 retrieving at least one product information from at least one database storing third-party retail vendor product information;

transmitting electronic signals to the user system representing a plurality of different ~~dealers~~ third-party retail vendors and associated prices charged by each of said different ~~dealers~~ third-party retail vendors for products  
10 identified in response to said at least one search parameter;

automatically transmitting electronic signals to the user system representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and

if the user chooses to play the game:

15 electronically calculating a probability of winning said selected one product by the user;

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning; and

in response to a winning pseudo-random outcome, purchasing said selected one

20 product from a corresponding ~~dealers~~ third-party retail vendor for the user.

16. (Previously presented) The method of claim 15, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation.

5 17. (Previously presented) The method of claim 15, comprising calculating a probability of winning based on at least a current budget.

18. (Previously presented) The method of claim 15, comprising calculating a probability P of winning based on a total number of game players.

10

19. (Previously presented) The method of claim 15, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

15

where:

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

20

$P_u$  is probability factor that varies with the user's behavior during a user session;

and

$N$  is a number of current users.

20. (Previously presented) The method of claim 15, wherein the electronic signals representing the associated prices charged by each of said different dealers, represent the prices charged on said each of said different dealers' own web sites.

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21. (Currently amended) A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

5 searching for products matching said at least one search parameter;

transmitting electronic signals to the user system representing a plurality of

~~dealers~~ third-party retail vendors and associated prices charged by each of said ~~dealers~~ third-party retail vendors for products identified in response to said at least one search parameter, each of the products identified being  
10 offered for sale on a corresponding web site of each ~~dealer~~ third-party retail vendor;

automatically transmitting electronic signals to the user representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and

15 if the user chooses to play the game:

electronically calculating a probability of winning said selected one product by the user;

electronically generating a pseudo-random outcome having a probability corresponding to the calculated probability of winning; and

20 in response to a winning pseudo-random outcome, purchasing said selected one product from a corresponding ~~dealer~~ third-party retail vendor for the user.

22. (Currently amended) A method for providing a user an opportunity to win a product or service by playing a game of chance without buying the product or service and without paying a fee to play, comprising the steps of:

enabling the user to submit a search query associated with a type of product or service;

conducting a search in a database for a third-party retail vendor product or service that satisfies the search query;

automatically presenting a result of the search to the user, including at least one product or service offered for sale by said third-party retail vendor

retrieved from the database, along with an option to play the game;

enabling the user to select the product or service that he wants to win;

determining the user's chance of winning the selected product or service;

generating an outcome for each play of the game that corresponds to the user's chance of winning; and

displaying the outcome of the game to the user.

23. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win.

24. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of enabling the user to increase the chance of winning the selected product or service through repeated plays of the game.

25. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 22 wherein the step of determining the user's chance of winning the selected product or service is a function of at least one of a cost of the product or service, a number of other users playing to win the product or service concurrently, a current prize budget and an amount of funds received from an advertising sponsor.

26. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 25 wherein the advertising sponsor provides funds for the purchase of the selected product or service to a game provider as a payment for a display of an advertisement to the user during each play of the game.

27. (previously presented) The method for providing a user an opportunity to win a product or service of claim 25 wherein the step of determining the user's chance of winning the selected product or service is a function of the user's behavior during repeated plays of the game.

28. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 26 wherein the user's repeated plays of the game generates revenue from the advertising sponsor for a game provider which increases the user's chance of winning the selected product or service.

29. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 22 wherein the game of chance comprises displaying a number selected by the user along with the number generated to represent the outcome for each play of the game.

5

30. (Previously presented) The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor.

- 10 31. (New) The method of Claim 1, further comprising collecting a database of third party retail vendor product information prior to receiving the search parameters from the user.

32. (New) The method of Claim 1 whereby transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a  
15 webpage containing at least a link to a webpage of the third party retail vendor and a link to initiate playing to win the same product.

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33. (New) A method for increasing user traffic to a search engine website, comprising:  
receiving a search query from a user system interacting with a search webpage of the  
website, the search query defining a desired product for the user; and  
transmitting a results webpage to the user system, the results page including at least one  
5 link for redirection to a third party vendor website where the user system can  
interact with at least one webpage to purchase a corresponding product and  
further including in the same webpage a play link corresponding to said third  
party vendor link for redirection to a webpage which allows the user to play a  
game of chance to win the product corresponding to the third party website  
10 redirection link.

34. (New) The method of claim 33, wherein said play link webpage is provided by the search  
engine website and wherein the search engine website calculates the outcome of the game  
of chance for a user system selecting to play to win the product and further wherein if the  
15 user outcome is favorable the search engine website facilitating the purchase of the  
product from the third party vendor corresponding to the third party website redirection  
link.

35. (New) A method for increasing user traffic to a search website, comprising:

providing a search webpage containing a search interface for a user to submit a search query for a product;

receiving a search query from a user employing said search webpage;

5 searching third party websites by reference to said query;

retrieving product information and corresponding price from said third party websites for at least one products satisfying said query;

providing a game of chance in response to a user selection of the link to win the product;

and purchasing the product from the third party for the user response to a

10 favorable outcome in said game;

transmitting at least one results webpage to the user, the results webpage including at

least one link for the product information, a corresponding price, a link to the third party website, and a link to win the product;

providing a game of chance in response to a user selection of the link to win the product;

15 and

purchasing the product from the third party for the user in response to a favorable outcome in said game.

20

36. (New) A product search website executing on a server storing a plurality of web pages,  
the website comprising:

a search page for a user submitting a query to the server for at least one product;

a results webpage transmitted to the user, the results page including links to third party

5 website and a link to a play webpage of the website;

a play webpage providing a game of chance for winning the product corresponding to a

selected play link from the results webpage; and

a product win webpage to indicate a favorable outcome in said game of chance for said  
product.

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## REMARKS

Initially, Applicants have amended claims 1, 10, 15, 21, and 22. In addition, Applicants have added new claims 31-36. No new matter has been added. Applicants believe that the foregoing comments overcome the rejections set forth in the June 27, 2005 Office Action. A Request for Continued Examination is being filed concurrently with this response.

### I. THE EXAMINER'S REJECTIONS

The Examiner rejected Claims 1, 2, 7-10, 12-15, 17-25, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Walker *et al.*, U.S. Patent Application Pub. No. 2003/0054888 (hereinafter "Walker") in view of Ghouri *et al.*, U.S. Patent Application Pub. No. 2002/0082978 (hereinafter "Ghouri").

The Examiner rejected independent claims 1, 10, 15, 21 and 22 by applying the same arguments to each claim. More specifically, the Examiner cited Walker to show every element of independent claims 1, 10, 15, 21 and 22; however, the Examiner admitted that Walker does not expressly teach the use of dealers. *See, e.g.*, Office Action dated 6/27/2005, page 4. In the Examiner's view, "Ghouri teaches a system that searches for dealers of products selected by users." *Id.* In addition, according to the Examiner, "Walker teaches third party manufacturers of products." *Id.* As a result, the Examiner opined that "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products." *Id.* Accordingly, the Examiner concluded that the combination of references "would show to users the best dealers or manufacturers' offers of products selected by users." *Id.*



## II. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

In order for a claimed invention to be obvious, either alone or in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE § 2143-2143.03.

Applicants respectfully submit that there is no motivation to combine the references. It is well settled that an obviousness rejection is improper unless the prior art relied upon suggests the proposed combination. *See In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Indeed, the Examiner "has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination." *SmithKline Diagnostics, Inc. v. Helena*

*Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988); *see also, In re Mayne*, 104 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997) ("When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion to combine references of make modification."). A finding of obviousness is not warranted if, as in the present case, there is an absence of such teaching, suggestion or

motivation. *See Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). The prior art references relied upon by the Examiner fail to provide any teaching, suggestion or motivation for the combination asserted by the Examiner in rejecting the pending claims. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is

some suggestion or incentive to do so.” *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

More specifically, Applicants respectfully submit that there is no motivation for the combination of Walker in view of Ghouri. In the present rejection, the Examiner stated, with respect to the combination of Walker in view of Ghouri that “it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users’ selected products.” See Office Action, page 4.

Applicants respectfully submit that the proffered motivation is improper. Walker discloses a method wherein an individual retailer can increase the excitement associated with the shopping experience. The increased excitement attracts a greater number of customers capable of purchasing items at the retail store. These customers, in turn, are induced to purchase some of the retail store’s products, increasing the overall profitability of the retail store.

To increase the excitement associated with shopping, a customer has the option to win a product from a retail store outright for a small percentage of the item’s cost. Alternatively, a customer can apply the cost associated with winning the product as a credit towards the purchase of the desired item. The product can be manufactured by a third-party, however, it must be offered for sale at the retail store for it to generate customer excitement, and in turn, increased profits.

Ghouri discloses a method wherein a user customizes a product, such as an automobile, by using a program which is accessed from the Internet. After customizing the product, the user stores the results in a database for a fee. After the information is stored and the fee is paid, a notification is sent to multiple participating retailers of the customizable product. The retailers,

in turn, offer the product to the user for a specified price. Each retailer has access to the other offers, and can modify its offer accordingly. For example, if the retailer wants to sell the item but does not have the lowest offer, it may lower the asking price for the product to make it more attractive for purchase by a user. The system, known as a reverse auction, is designed to provide the user with the lowest possible price for a particular product. As a result, a retailer who uses the Ghouri system will actually receive less profit for a product than it normally would.

As a result, Applicants respectfully submit that the references teach away from each other. As such, they are not combinable. For example, the Walker reference results in increased profits for a single retail store, while Ghouri teaches a system that is designed for use by multiple retailers which results in lower profits by the retailers via lowered prices to the consumer.

Accordingly, one of ordinary skill in the art would not be motivated to combine the two references. In addition, the cited references provide no other motivation or incentive for the combination suggested by the Examiner. Therefore, the obviousness rejection could only be the result of a hindsight view with the benefit of Applicant's specifications. This type of analysis is inappropriate:

"To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." *Seasonics v. Aerosonic Corp.* 38 USPQ 2d 1551, 1554 (1996) (citations omitted).

Accordingly, the combination advanced by the Examiner is not legally proper -- on reconsideration the Examiner will undoubtedly recognize that such a position is merely an "obvious to try" argument.

At best, it might be obvious to *try* such a modification, but of course, "obvious to try" is not the standard for obviousness under 35 U.S.C. § 103. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 91 (Fed. Cir. 1986).

Under the circumstances, Applicants respectfully submit that the Examiner has  
5 succumbed to the "strong temptation to rely on hindsight." *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

10 "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarter backing is quite improper when resolving the question of non-obviousness in a court of law." *Id.*

Applicants submit that the only "motivation" for the Examiner's combination of the references is provided by the teachings of Applicant's own disclosure. No such motivation is provided by the references themselves. Therefore, the rejection should be withdrawn.

15 Further, if the references were combined using the rationale proffered by the Examiner, Walker would be rendered inoperative for its intended purpose. According to the Examiner, "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products." *See* Office Action, page 4. However,  
20 such a combination would result in a state where Walker competed with itself by offering products sold by the competition. Accordingly, the system of Walker will not operate as intended, by offering its products with the added incentive of a chance to win a product, but rather would allow users the opportunity to win a product without the benefit of a possible sale, which may go to the third party vendor. Indeed, the Examiner admitted that such a combination  
25 "would show to users the best dealers or manufacturers' offers of products selected by users."  
*See* Office Action, page 4.

It is well settled that "if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MANUAL OF PATENT EXAMINING PROCEDURE § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Since the Examiner's  
5 proposed modification of Walker in view of Ghouri would render Walker unsatisfactory for its intended purpose, there can be no motivation to combine the references. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and the rejections should be withdrawn.

Even if the combination of Walker and Ghouri is proper, the combined references do not  
10 disclose the present invention as amended. The resulting system of Walker in view of Ghouri would result in a system that provides a user with the opportunity to win or directly purchase a particular product from the party offering the product for sale. In addition, the combination would allow third-party vendors to compete with the individual retailer by offering the item directly to the user at a lower cost.

15 In contrast, the present invention comprises an improved shopping search engine. When a user enters criteria related to a specific product, the search engine displays one or more third-party web pages that offer the particular product for sale. When the results are displayed, the user has the option to attempt to win the prize via one or more games of chance. Alternatively, the user can simply click on one of the third-party vendor's links and purchase the product. Both  
20 options are available to the user from one interface immediately after generating the appropriate search. If the user wins the product, the search engine purchases the product from the third-party vendor on behalf of the user. As a result, the present invention does not directly offer products for sale.

In addition, the present invention merely lists third-party vendors who offer the product that a user wishes to purchase and/or win. It does not directly offer products for sale to a user, nor does it allow third-party vendors to compete with each other via a reverse auction as required by Ghouri. Neither Walker nor Ghouri discloses a search engine which provides the user with an opportunity to purchase the product from a third-party vendor as required by the amended claims. Instead, Walker discloses the direct sale of a product which can be manufactured by third parties by an individual retailer. Ghouri requires that the third party vendors offer the product directly to the consumer. It does not allow the consumer to purchase the product in response to a search query. Rather, a user of the Ghouri system must wait until she receives an offer for the desired product. Since Walker and Ghouri, individually and in combination, fail to disclose the present invention as amended. Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 103 is improper and should be withdrawn.

Further, the present invention does not require the user to input any sensitive personal information to win the item sought. The systems of Ghouri and Walker require the end user to enter information related to the user's name, address, and credit card information, which can be tracked by marketing agencies and the like to determine a user's buying tastes, etc. As a result, the user frequently receives unwanted promotional materials based on the inputted information. In contrast, the present invention does not require the user to input any sensitive personal information. A user of the present invention merely enters a contest with a predetermined winning percentage. Consequently, the user of the present information does not receive unwanted promotional materials and the like.

Thus, the present invention for the first time discloses a novel search engine with an option to win the item sought. This represents a vast improvement over the prior art. Further,

the cited references neither teach nor suggest the novel and non-obvious features of this invention.

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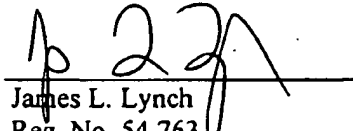
20

### CONCLUSION

Applicants submit that the specification, drawings, and all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. The claims have been amended merely to clarify the novel features of the current  
5 invention and are in no way related to patentability. Early and favorable action is accordingly solicited.

Respectfully submitted,

Date: 2-27-06

  
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## EXHIBIT 4



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839
26158	7590	06/27/2005	EXAMINER	
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC			LASTRA, DANIEL	
P.O. BOX 7037			ART UNIT	
ATLANTA, GA 30357-0037			PAPER NUMBER	

3622

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/759,103	<b>Applicant(s)</b> CLARK ET AL	
	<b>Examiner</b> DANIEL LASTRA	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 March 2005.  
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-30 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

*ML*

**DETAILED ACTION**

1. Claims 1-30 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

***Response to Amendment***

2. In response to Non Final Rejection filed 12/30/2004, the Applicant filed an Amendment on 03/30/2005, which amended claims 1, 9, 10, 14, 15, 19, 21, 22, 26, 29 and 30. Applicant's amendment overcame the Section 112 rejection.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7-10, 12-15, 17-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 2003/0054888) in view of Ghouri (US 2002/0082978).

As per claims 10 and 20-22, Walker teaches:

A method of providing a user with a game of chance, the method comprising:

receiving electronic signals representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals representing at a least one product, a price of the product (see Walker paragraph 39). Walker does not expressly teach and a third-party dealer of the product. However, Ghouri teaches a system that searches for dealers of

products selected by users (see paragraphs 22 and 23). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products, which users would like to play games to win said selected products. This feature would show to users the best dealers or manufacturers' offers of products selected by users.

*automatically* transmitting electronic signals representing at least a first option *for the user* to play a game to win the product without *the user* first making any payment (see Walker paragraph 130), *or requesting the first option* and a second option to purchase the product (see Walker paragraphs 34; 149);

if the user *chooses* to play the game:

electronically calculating a probability of winning the product *by the user*; electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 144); and

in response to a winning pseudo-random outcome, purchasing the product for the user (see Walker paragraph 145);

and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product (see Walker paragraph 34,149-151);

As per claim 1, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals representing search parameters descriptive of a product or service (see Walker paragraph 39);

transmitting electronic signals representing dealers in the product or service and associated prices (see Walker figure 6). Walker does not expressly teach dealers. However, Ghouri teaches a system that searches for dealers of products selected by users (see paragraphs 22 and 23). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products, which users would like to play games to win said selected products. This feature would show to users the best dealers or manufacturers' offers of products selected by users.

*automatically* providing the user an option to play a game to win a selected product or service without the user first making any payment (see paragraph 130) or *requesting the option* (see paragraph 34; 149);

electronically calculating a probability of winning the selected product or service by the user (see paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see paragraph 145); and

in response to a winning pseudo-random outcome, purchasing the selected product or service for the user (see paragraph 145).

As per claim 15, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals representing search parameters descriptive of a product (see Walker paragraph 39);

transmitting electronic signals representing a plurality of different dealers and associated prices charged by each of said different dealers for products identified in response to said at least one search parameter (see Walker figure 6). Walker does not expressly teach dealers. However, Ghouri teaches a system that searches for dealers of products selected by users (see paragraphs 22 and 23). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products, which users would like to play games to win said selected products. This feature would show to users the best dealers or manufacturers' offers of products selected by users.

*automatically* providing the user an option to play a game to win a selected product or service without the user first making any payment (see Walker paragraph 130) *or requesting the option* (see Walker paragraph 34; 149);

electronically calculating a probability of winning the selected product or service by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing said selected one product from a corresponding dealer for the user (see paragraph 145).

As per claims 7, 12 and 17, Walker teaches:

The method of claim 10, comprising calculating a probability of winning based on at least a current budget (see Walker paragraph 144).

As per claims 8, 13 and 18, Walker teaches:

The method of claim 10, comprising calculating a probability  $P$  of winning based on a total number of game players (see Walker paragraph 110).

As per claim 23, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win (see Walker paragraphs 129-131).

As per claim 25, the same rejection applied to claims 7-8 is applied to claim 25.

As per claims 2, 24 and 27, Walker teaches:

The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system (see Walker paragraphs 26 and 89).



As per claims 9, 14 and 19, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

Walker does not expressly teach Pa is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see paragraph 143).

Pt is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

Pm is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

Pu is probability factor that varies with the user's behavior *during a user session* (see Walker paragraph 88); and

N is a number of current users (see Walker paragraph 110).

Claims 3-5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker, et al (U.S. 2003/0054888) in view of Ghouri (US 2002/0082978) and further in view Yoseloff (U.S. 6,331,143).

As per claims 3 and 29, Walker teaches:

The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see column 8, lines 35-50; column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker teaches:

The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a

system (see column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker teaches:

The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. However, Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to the provider of the products (see paragraph 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would

give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

Claims 6, 11, 16, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri (US 2002/0082978) and further in view of Angles et al (U.S. 5,933,811).

As per claims 6, 11, 16, 26, 28 Walker teaches:

The method of claim 10, but fails to teach comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party, such as a game provider, provides compensation. However, Angles teaches a system where users are compensated for viewing sponsors' advertisements (see column 16, lines 38-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsors' advertisements independently of the purchase of the advertised product or service, as taught by Angles and these compensations would allow users to play games to win the sponsors' advertise products, as taught by Walker. Compensating users for viewing advertisements would be a good business decision as this would increase the probability that users would view the sponsors' advertisements and would play to win the advertise products, therefore increasing customer traffic and customer loyalty.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri (US 2002/0082978) and further in view of Angles et al (U.S. 5,933,811) and Yoseloff (US 6,331,143).

As per claim 30, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 29 but fails to teach wherein the user can *increase the probability of winning* the product or service by participating in an online survey for an advertising sponsor. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that sponsors would compensate users for viewing the sponsors' advertisements or for participating in the sponsors' online surveys. Sponsors would compensate users by allowing the users to play games to win the sponsors' products.

#### ***Response to Arguments***

4. Applicant's arguments filed 03/30/2005 have been fully considered but they are not persuasive. The Applicant argues that Walker does not teach that a user is automatically provided with an option to play a game to win a selected product or service without requesting the option. The Examiner answers that Applicant's figure 4 teaches that a user has to click the hyperlink "win it" to play to win a product, so said user needs to make an request to play said game. Walker provisional (60/204,673) page 2, summary teaches "that the customer may be able to select one or more products (e.g., selecting on a web page, using a kiosk, scanning a barcode) that he wants to win and may try to win the product(s) through various games including slot

machine, video poker, roulette, etc... A benefit of embodiments of the present invention is that the excitement of gambling may be added to shopping, allowing the customer to win any item of the customer's choice. Adding the excitement to shopping may be able to increase sales for a particular retailer". Therefore, Walker teaches that a user makes a request to win products and therefore, teaches the Applicant's claimed invention.

The Applicant argues that Walker does not teach automatically transmitting electronic signals representing at least a first option for the user to play a game to win a product without the user first making any payment. The Examiner answers that Walker teaches in paragraph 130 "An alternate from of entry may also comprise signing one's name, providing a fingerprint, or simply asking to play the game for free. Therefore, Walker teaches at least a first option for the user to play a game to win a product without the user first making any payment.

The Applicant argues that Walker does not teach the option of purchasing of a product as an option to playing a game to win the prize. The Examiner answers that Walker teaches in paragraph 34 that "retail stores also include Websites in which descriptions and visual representations of products for sale may be viewed by customers and through which the customers may purchase one or more products for sale". Therefore, Walker gives customers the option of being directed to a merchant's website and purchase merchant's products, without the need to play a game to win said product.

The Applicant argues that Walker does not teach "probability factor that varies with the user's behavior occurring during a user session because Walker teaches that a

customer rating is associated with customer's purchasing history. The Examiner answers that Walker teaches that a customer may pay a fee in order to be associated with a particular rating (see paragraph 88). Therefore, if during a user session a customer pay a bigger fee, said customer based upon said behavior would receive a higher rating and a higher probability of receiving a winning outcome.

The Applicant argues that Walker does not teach the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system. The Examiner answers that Walker teaches in paragraph 89 that a probability may be determine based on a customer history or receiving winning outcomes stored in the customer database. Therefore, Walker teaches that the probability increase with the value derived from the user's interaction with the system.

#### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 571-272-6724. The Right fax number of the Examiner is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*DL*  
Daniel Lastra  
May 30, 2005

*Yehdega Retta*  
RETTA YEHDEGA  
PRIMARY EXAMINER



## EXHIBIT 5

WOMBLE  
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& RICE  
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	Number of Pages (Including Cover) 08	(404)888-7349
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**MESSAGE:**

In re application of: Clark, et al.  
Serial No. 09/759,103  
Filing Date: January 12, 2001  
For: Search Engine Providing an Option to Win the Item Sought

Attached for filing are the following documents.

1. Notice of Appeal
2. Pre-Appeal Brief Request for Review
3. Pre-Appeal Brief

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) P166 1010.1	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 (37 CFR 1.8(a)) on <u>September 26, 2005</u> Signature <u>[Signature]</u> Typed or printed name <u>Diana Ogles</u>		Application Number <b>09/759,103</b>	Filed <b>January 12, 2001</b>
		First Named Inventor <b>Clark</b>	
		Art Unit <b>3622</b>	Examiner <b>Daniel Lastra</b>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/78) <input checked="" type="checkbox"/> attorney or agent of record. <b>32,497</b> Registration number <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34		<u>[Signature]</u> Signature <b>John J. Timar</b> Typed or printed name <b>(404) 888-7412</b> Telephone number <b>September 26, 2005</b> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 132 and 37 CFR 1.11, 1.14 and 41.5. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: ) Examiner: Daniel Lastra  
Clark, et al ) Group Art Unit: 3622  
Serial No: 09/759,103 ) Confirmation No.: 1839  
Filed: January 12, 2001 ) Attorney Docket No.: P166 1010.1  
For: Search Engine Providing an Option to Win the Item Sought

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Final Office Action mailed June 27, 2005, for the above-identified patent application, Applicants submit the following arguments in conjunction with this Pre-Appeal Request for Review.

The Examiner's rejection of claims 1, 2, 7-10, 12-15, 17-25 and 27 under 35 U.S.C. 103(a) as unpatentable over *Walker, et al.* (U.S. 2003/0054888) in view of *Ghouri, et al.* (2002/0082978) is in error.

The Examiner's ability to use either the *Walker, et al.* or the *Ghouri, et al.* published applications is predicated on the fact that both claim priority to provisional patent applications that were filed before Applicant's patent application was filed on January 12, 2001. In order to use either of these references as prior art based on earlier filed provisional applications, the provisional applications themselves must teach that which the Examiner relies upon for showing aspects of the Applicants' claimed invention in the published applications of *Walker, et al.* and *Ghouri, et al.* It is an error for the Examiner to rely on teachings of the published applications that were not also in the provisional applications from which the published applications claim priority.

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Regarding claim 10, the Examiner stated at page 3 of the office action mailed June 27, 2005 that *Walker* teaches "automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment (citing *Walker*, paragraph 130) or requesting the first option and a second option to purchase the product" (citing *Walker*, paragraphs 34, 149). Applicants' arguments are found in the amendment response filed March 30, 2005 at pages 15-16. Specifically, Applicants argue that the statement in *Walker, et al.* provisional patent application 60/204,763, that the customer may be able to play for free for a limited number of plays (alternate method and use 13 on page 6 of 8) does not constitute a teaching of this particular claim step.

This isolated statement does not constitute a teaching or suggestion of an automatically transmitted option to play a game to win a product without making any payment or first requesting the option. Figs. 6, 7 and 9 in the *Walker* provisional application each show the step of receiving payment or a wager before executing the game. Fig. 8 does not explicitly show a step of payment, but the text describing the point-of-sale (POS) view depicted in this figure states at item 3 on page 8 of 8 that "If the product has been won, provide for no additional payment, otherwise credit towards payment at least some portion of the amount previously spent by the customer when trying to win the product."

Furthermore, the Examiner cannot rely on the teachings of paragraph 130 of the *Walker, et al.* published application which describes alternate forms of entry into a game since there are no counterpart teachings in the *Walker* provisional application. However, even if these teachings could be applied, the alternate forms of entry into a game to play for a product that are described in paragraph 130 are not a teaching or suggestion of automatically transmitting electronic signals representing an option to play to win a product without first requesting an option to play. Therefore, it was an error to use the teachings of this paragraph in the rejection of claim 10.

Applicants' arguments concerning the teachings of paragraph 149 are found on page 16 of Applicants' March 30, 2005 amendment response. As noted therein, *Walker* teaches that the customer pays for the product before playing a game to win the same product. In the related flowchart of Fig. 10, there is no depiction of directing a customer to a web site to buy a product. As shown in Fig. 10, the customer pays for the product, then requests to play the game to win the

product. However, even the step of requesting to play the game is not depicted in the flow charts or specification of the provisional application. Therefore, it was an error to use the teachings of this paragraph in the rejection of claim 10.

Further regarding claim 10, the Examiner stated at page 3 of the Office Action mailed June 27, 2005, that *Walker* teaches "if user chooses to purchase a product instead of playing the game: directing the user to a website which sells the product," citing *Walker* paragraphs 34, 149 - 151. Applicant's arguments are found in the Amendment response filed March 30, 2005, at pages 16 - 17. As noted therein, paragraphs 149 - 151 and Fig. 10 of *Walker, et al.* describe a process in which a customer selects a product, payment is received for the product, and the customer requests to play a game for the product.

In paragraph 150, *Walker, et al.* teaches that selection of the product is received by a POS terminal in response to a bar code scanner scanning a bar code corresponding to the product. Paragraph 151 teaches that payment for the product is received using a payment identifier associated with the customer identifier received by the customer input/output device or through manual input by the customer using the customer input/output device. As shown in Fig. 10 of *Walker, et al.*, after a customer selects and pays for the product, he then requests to play a game to either win the product or have a portion of the fee for playing the game credited to the customer. There is no teaching in *Walker, et al.* of directing the user to a website that sells a product if a user chooses to purchase a product instead of playing the game when presented with the alternative options. In Applicants' invention, the user has the selectable options to win the product or to buy the product. If the user decides to buy the product, a hyperlink takes the user to the product provider's website in order to purchase the product.

With further regard to the teachings of paragraphs 149 - 151 of *Walker, et al.*, the closest corresponding teachings are found in the provisional application in Figs. 8 - 9, the corresponding description of Fig. 9 on page 7 of 8 of the provisional application, and the description of the POS view on page 8 of 8 of the provisional application. Note that the description of Fig. 9 is "a flow chart of the exemplary method performed by the control program in an embodiment where the customer purchases the item the customer wishes to win before trying to win the item." There is no teaching in the *Walker, et al.* provisional application of the customer actually requesting an

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option to play the game. Therefore, it was an error to use the teachings of these paragraphs in the rejection of claim 10.

Claims 1, 15, 21 and 22 each include the limitation of automatically providing the user with an option to play the game to win a selected product or service without the user first making any payment or requesting the option. The Examiner used the same basis for rejecting these claims as he did for claim 10. As argued above, it was an error for the Examiner to apply the teachings of the *Walker, et al.* published patent application for teachings that were not found in the provisional patent application. Therefore, the rejections of claims 1, 10, 15, 21 and 22 are each based on teachings in the *Walker, et al.* published application that are not found in the provisional patent application.

Further regarding claim 1, the Examiner stated at page 4 of the Office Action mailed June 27, 2005, that *Ghouri, et al.* teaches "transmitting electronic signals representing dealers in the product or service and associated prices. The Examiner stated that *Ghouri, et al.* teaches a system that searches for dealers of products selected by users, citing paragraphs 22 and 23. Applicants' arguments concerning *Ghouri, et al.* are found at page 18 of the Amendment response filed March 30, 2005. Although Applicants' arguments were made with respect to the Examiner's rejection of claim 20, they are also applicable to claims 1, 15 and 21. *Ghouri, et al.* teaches an interactive system which provides customers with comprehensive information about a plurality of products and any associated customizable features, further providing a forum for conducting a reverse auction where sellers of products, exactly or closely matching those sought by the customer, bid for that customer's business (paragraph 22). *Ghouri, et al.* further teaches an interactive system and method for customizing an automobile through an interactive, online automobile configuration program, which may be electronically integrated and configured with dealers' inventory, and subsequently soliciting bids for the customer's automobile from a plurality of automobile dealerships over a distributed computing network (paragraph 23). As stated in paragraph 66, requests for new bids are transmitted, preferably with electronic mail, to notify the system support group and the participating dealers. Dealers can access the system of *Ghouri, et al.* and submit a bid that the customer can consider. The customer must select a bid before receiving dealer contact information (paragraph 74). Fig. 20 illustrates a sample bid results page;

Fig. 21 illustrates a bid comparison page; Fig. 22 illustrates the bid acceptance page. Only after accepting a bid does the customer obtain any dealer information. This does not represent a teaching of transmitting electronic signals representing dealers in the product or service and associated prices as claimed in claim 1. Therefore, it was an error to apply the teachings of *Ghourl, et al.* directed to a reverse auction for a customizable product in rejecting claim 1. Claims 15 and 21 both include the limitation of transmitting electronic signals representing a plurality of dealers and associated prices charged by each of the dealers. Therefore, for the same reasons as for claim 1, it was an error for the Examiner to apply the teachings of *Ghourl, et al.* in the rejection of claims 15 and 21. The Examiner has also failed to provide copies of the twelve web pages and thirty-five page technical description that are part of the *Ghourl, et al.* provisional application. Thus Applicants are unable to ascertain which teachings of the *Ghourl, et al.* published application can be applied as prior art.

In view of the above, it is submitted that the Examiner's rejection of independent claims 1, 10, 15, 21 and 22 was in error because it was based on the *Walker, et al.* published patent application filed after the present application, and relying on teachings not found in the corresponding provisional patent application and consequently not applicable as prior art. Furthermore, it was an error to apply the teachings of *Ghourl, et al.* in the rejection of Claim 1, 15 and 21, since *Ghourl, et al.* does not teach transmitting electronic signals representing dealers in the product or service and associated prices.

Respectfully submitted,



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Registration No. 32,497  
Attorney for Applicants

9/26/05  
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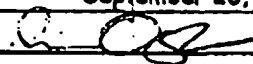
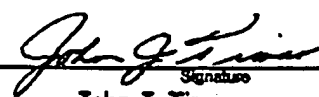


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<b>NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES</b>		Document Number (Optional) <b>P166 1010.1</b>	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" (37 CFR 1.8(a)) <b>September 26, 2005</b> on _____ Signature  Typed or printed name <b>Diana Ogles</b>		In re Application of <b>Clark, et al.</b> Application Number <b>09/759,103</b> Filed <b>01/12/2001</b> For Search Engine Providing an Option to Win the Item Sought Art Unit <b>3622</b> Examiner <b>Daniel Lastra</b>	
Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.			
The fee for this Notice of Appeal is (37 CFR 41.20(b)(1))		<b>\$ 500.00</b>	
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:		<b>\$ 250.00</b>	
<input type="checkbox"/> A check in the amount of the fee is enclosed.			
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.			
<input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.			
<input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. <b>09-0528</b> . I have enclosed a duplicate copy of this sheet.			
<input type="checkbox"/> A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.			
<b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b>			
I am the		 Signature <b>John J. Timar</b> Typed or printed name	
<input type="checkbox"/> applicant/inventor.		<b>(404) 888-7412</b> Telephone number	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)		<b>September 26, 2005</b> Date	
<input checked="" type="checkbox"/> attorney or agent of record. <b>32,497</b> Registration number			
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34.			
<b>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</b>			
<input checked="" type="checkbox"/> Total of <b>1</b> forms are submitted.			

This collection of information is required by 37 CFR 41.21. The information is required to obtain or retain a benefit by the public which is to be (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form should suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## EXHIBIT 6




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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839
26158	7590	12/13/2005		
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC P.O. BOX 7037 ATLANTA, GA 30357-0037				
			EXAMINER LASTRA, DANIEL	
			ART UNIT 3622	PAPER NUMBER

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Application Number</b> 	<b>Application/Control No.</b> 09/759,103 Eric W. Stamber	<b>Applicant(s)/Patent under Reexamination</b> CLARK ET AL. Art Unit 3622
<b>Document Code - AP.PRE.DEC</b>		

## Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 9/26/05.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-30.

Claim(s) withdrawn from consideration: \_\_\_\_\_

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Eric W. Stamber *ES*

(2) Daniel Lastra *DL*

(3) James Myhre *JM*

(4) \_\_\_\_\_

# EXHIBIT 6

MAY 08 2008

PTO/SB/30 (01-08)

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# Request for Continued Examination (RCE) Transmittal

Address to:  
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Alexandria, VA 22313-1450

Application Number	09/758,103
Filing Date	January 12, 2001
First Named Inventor	Scott Clark
Art Unit	3622
Examiner Name	Daniel Lastra
Attorney Docket Number	632-001

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application. Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

- a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
- i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_
- ii. ☐ Other \_\_\_\_\_
- b. ☒ Enclosed
- i. ☒ Amendment/Reply
- ii. ☐ Affidavit(s)/ Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☒ Other Transmittal, Fee Transmittal, Fax Cover

## 2. Miscellaneous

- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. ☐ Other \_\_\_\_\_

## 3. Fees

- The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.  
The Director is hereby authorized to charge the following fees, any underpayment of fees, or credit any overpayments, to Deposit Account No. 23-0420. I have enclosed a duplicate copy of this sheet.
- a. ☒ RCE fee required under 37 CFR 1.17(e)
- ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)
- iii. ☐ Other \_\_\_\_\_
- b. ☐ Check in the amount of \$ \_\_\_\_\_ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

05/09/2008 PCHOMP 00000047 230420

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED	
Signature	Date
Name (Print/Type) <u>Joe H. Shallenburger</u>	Registration No. <u>37,937</u>

## CERTIFICATE OF MAILING OR TRANSMISSION

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Signature	Date
Name (Print/Type) <u>Melissa Hunter</u>	Date <u>5/8/08</u>

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE **PATENT**

In re Application of: Clark, *et al.*

Serial No.: 09/759,103

Group Art Unit: 3622

Filed: January 12, 2001

Examiner: Daniel Lastra

For: SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM  
SOUGHT Atty. Docket No.: 632-001

Honorable Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**AMENDMENT AND REQUEST FOR CONTINUED EXAMINATION**

SIR:

In response to the Final Office Action dated May 21, 2007 in the above mentioned case,  
Applicants respectfully request reconsideration in view of the following amendments and  
remarks:

Amendments to the Claims begin on Page 2 of this paper.

Remarks begin on Page 18 of this paper.

### Amendments to the Claims

This listing of claims shall replace all prior versions and listings of claims in the application:

1. (Currently Amended) A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing search

parameters descriptive of a product;

retrieving at least one product information from at least one database storing

independent third-party retail vendor product information;

transmitting electronic signals to the user system representing the retrieved

product information and associated prices;

automatically providing the user with an option to play a game to win a selected

product from said product information without the user first

making any payment or requesting the option;

electronically calculating a dynamic probability of ~~winning~~ winning the selected

product by the user based on one or more factors selected from a group

consisting of: the cost of the selected product in relation to the total cost of

all products available, a current prize budget, a ratio of the current prize

budget to a total amount of funds received and the user's behavior during a

user session;

electronically generating a ~~pseudo-random outcome~~ a trial outcome of an event

trial, the probability of the event trial generating a winning trial outcome

corresponding to the calculated probability of winning;



generating an outcome indicator independent of, and differently distributed from,  
the trial outcome;

displaying the outcome indicator to the user; and

in response to a winning ~~pseudo-random trial~~ outcome, purchasing the selected  
product for the user from the independent third-party retail vendor at no  
cost to the user.

2. (Previously Presented) The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system.
3. (Currently Amended) The method of claim 1, wherein the ~~pseudo-random outcome is indicated by displaying a display~~ comprises a user-chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number.
4. (Previously Presented) The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number.
5. (Previously Presented) The method of claim 3, wherein the probability of winning is

different than one divided by ten raised to the power of the number of digits in the comparison number.

6. (Currently Amended) The method of claim 1, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation to the provider of the game of chance.
7. (Previously Presented) The method of claim 1, comprising calculating a probability of winning based on at least a current budget.
8. (Previously Presented) The method of claim 1, comprising calculating a probability P of winning based on a total number of game players.
9. (Previously Presented) The method of claim 1, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;

and

N is a number of current users.

10. (Currently Amended) A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

retrieving at least one product information from at least one database storing independent third-party retail vendor product information;

transmitting electronic signals to the user system representing at a least one product, a price of the product and ~~[[a]]~~ the independent third-party retail vendor of the product;

automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment or requesting the first option, and a second option to purchase the product;

if the user chooses to play the game:

electronically calculating a dynamic probability of winning the product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

electronically generating a ~~pseudo-random outcome~~ a trial outcome, the  
probability of the trial outcome generating a winning trial outcome  
corresponding to the calculated probability of winning;  
generating an outcome indicator independent of, and differently  
distributed from, the trial outcome;  
displaying the outcome indicator to the user; and  
in response to a winning ~~pseudo-random trial~~ trial outcome, purchasing the product for  
the user from the independent third-party retail vendor at no cost to the  
user; and  
if the user chooses to purchase the product instead of playing the game:  
directing the user to a web site which sells the product.

11. (Currently Amended) The method of claim 10, comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party provides compensation to the provider of the game of chance.
12. (Canceled).
13. (Previously Presented) The method of claim 10, comprising calculating a probability P of winning based on a total number of game players.

14. (Previously Presented) The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;  
and

$N$  is a number of current users.

15. (Currently Amended) A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

retrieving at least one product information from at least one database storing independent third-party retail vendor product information;

transmitting electronic signals to the user system representing a plurality of different independent third-party retail vendors and associated prices charged by each of said different independent third-party retail vendors for products identified in response to said at least one search parameter;

automatically transmitting electronic signals to the user system representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and if the user chooses to play the game: electronically calculating a dynamic probability of winning said selected one product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session; electronically generating a ~~pseudo-random outcome~~ a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning; generating an outcome indicator independent of, and differently distributed from, the trial outcome; displaying the outcome indicator to the user; and in response to a winning ~~pseudo-random trial~~ trial outcome, purchasing said selected one product from a corresponding independent third-party retail vendor for the user at no cost to the user.

16. (Currently Amended) The method of claim 15, comprising providing the user with an opportunity to increase the chances of winning by performing a task for which a third party provides compensation to the provider of the game of chance.

17. (Canceled).

18. (Previously Presented) The method of claim 15, comprising calculating a probability P of winning based on a total number of game players.

19. (Previously Presented) The method of claim 15, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m}{N} + P_u$$

where:

$P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available;

$P_t$  is a probability factor that varies with a current prize budget;

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received;

$P_u$  is probability factor that varies with the user's behavior during a user session;

and

$N$  is a number of current users.

20. (Previously Presented) The method of claim 15, wherein the electronic signals representing the associated prices charged by each of said different dealers, represent the prices charged on said each of said different dealers' own web sites.

21. (Currently Amended) A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product;

searching for products matching said at least one search parameter;

transmitting electronic signals to the user system representing a plurality of independent third-party retail vendors and associated prices charged by each of said independent third-party retail vendors for products identified in response to said at least one search parameter, each of the products identified being offered for sale on a corresponding web site of each independent third-party retail vendor;

automatically transmitting electronic signals to the user representing an option to play a game to win a selected one of said products without the user first making any payment or requesting the option; and

if the user chooses to play the game:

electronically calculating a dynamic probability of winning said selected one product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

electronically generating a ~~pseudo-random outcome~~ having a probability trial



outcome, the probability of the trial outcome generating a winning trial  
outcome corresponding to the calculated probability of winning;  
generating an outcome indicator independent of, and differently distributed from,  
the trial outcome;  
displaying the outcome indicator to the user; and  
in response to a winning ~~pseudo-random trial~~ trial outcome, purchasing said selected  
one product from a corresponding independent third-party retail vendor  
for the user at no cost to the user.

22. (Currently Amended) A method for providing a user an opportunity to win a product or service by playing a game of chance without buying the product or service and without paying a fee to play, comprising the steps of:
- enabling the user to submit a search query associated with a type of product or service;
  - conducting a search in a database for ~~[[a]]~~ an independent third-party retail vendor product or service that satisfies the search query;
  - automatically presenting a result of the search to the user, including at least one product or service offered for sale by ~~said~~ the independent third-party retail vendor retrieved from the database, along with an option to play the game;
  - enabling the user to select the product or service that he wants to win;
  - dynamically determining the user's chance of winning the selected product or

service based on one or more factors selected from a group consisting of:  
the cost of the selected product in relation to the total cost of all products  
available, a current prize budget, a ratio of the current prize budget to a  
total amount of funds received and the user's behavior during a user  
session;

generating an a trial outcome for each play of the game ~~that~~ wherein the  
probability of the trial outcome generating a winning trial outcome  
corresponds to the user's chance of winning;

generating an outcome indicator independent of, and differently distributed from,  
the trial outcome; and

displaying the outcome indicator of the game to the user

23. (Currently Amended) The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user, and at no cost to the user, if the outcome for the play of the game is a win.
24. (Previously Presented) The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of enabling the user to increase the chance of winning the selected product or service through repeated plays of the game.
25. (Previously Presented) The method for providing a user an opportunity to win a product

or service of claim 22 wherein the step of determining the user's chance of winning the selected product or service is a function of at least one of a cost of the product or service, a number of other users playing to win the product or service concurrently, a current prize budget and an amount of funds received from an advertising sponsor.

26. (Previously Presented) The method for providing a user an opportunity to win a product or service of claim 25 wherein the advertising sponsor provides funds for the purchase of the selected product or service to a game provider as a payment for a display of an advertisement to the user during each play of the game.
27. (Previously Presented) The method for providing a user an opportunity to win a product or service of claim 25 wherein the step of determining the user's chance of winning the selected product or service is a function of the user's behavior during repeated plays of the game.
28. (Currently Amended) The method for providing a user an opportunity to win a product or service of claim 26 wherein the user's repeated plays of the game generates revenue from the advertising sponsor ~~for~~ paid to a game provider which increases the user's chance of winning the selected product or service.
29. (Previously Presented) The method for providing a user an opportunity to win a product or service of claim 22 wherein the game of chance comprises displaying a number selected by the user along with the number generated to represent the outcome for each

play of the game.

30. (Previously Presented) The method for providing a user an opportunity to win a product or service of claim 29 wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor.
31. (Currently Amended) The method of Claim 1, further comprising collecting a database of independent third party retail vendor product information prior to receiving the search parameters from the user.
32. (Currently Amended) The method of Claim 1 whereby transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the independent third party retail vendor and a link to initiate playing to win the same product.
33. (Currently Amended) A method for increasing user traffic to a search engine website, comprising:  
receiving a search query from a user system interacting with a search webpage of the website, the search query defining a desired product for the user; and  
transmitting a results webpage to the user system, the results page including at least one link for redirection to an independent third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to

~~said~~ the independent third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product at no cost to the user, the link corresponding to the independent third party website redirection link.

34. (Currently Amended) The method of claim 33, wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the independent third party vendor corresponding to the independent third party website redirection link.

35. (Currently Amended) A method for increasing user traffic to a search website, comprising:  
providing a search webpage containing a search interface for a user to submit a search query for a product;  
receiving a search query from a user employing said search webpage;  
searching independent third party websites by reference to said query;  
retrieving product information and corresponding price from said the independent third party websites for at least one products satisfying said query;  
providing a game of chance in response to a user selection of the link to win the product;  
and purchasing the product from the independent third party for the user response to a favorable outcome in said game;

transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the independent third party website, and a link to win the product;

providing a game of chance in response to a user selection of the link to win the product,

wherein the probability of winning the product by the user is dynamically calculated based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;

generating an outcome indicator independent of, and differently distributed from, the probability of winning;

displaying the outcome indicator to the user; and

purchasing the product from the independent third party for the user in response to a favorable outcome in said game and providing said product to the user at no cost to the user.

36. (Currently Amended) A product search website executing on a server storing a plurality of web pages, the website comprising:
- a search page for a user submitting a query to the server for at least one product;
  - a results webpage transmitted to the user, the results page including links to an independent third party website and a link to a play webpage of the website;
  - a play webpage providing a game of chance for winning the product corresponding to a selected play link from the results webpage, wherein the probability of winning

the product by the user is dynamically calculated based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session; and

a product win webpage to displaying an outcome indicator indicating indicate a favorable outcome in said game of chance for said product, the outcome indicator independent of, and differently distributed from, the probability of winning.

### Remarks

Applicant submits this Amendment and Response in response to the May 21, 2007 Office Action and following an in-person and a telephone interview with Examiner Lastra and Supervisory Examiner Myhre. An Appeal Brief was filed on March 4, 2008 and a Request for Continued Examination is being filed concurrently with this response.

Applicants have amended claims 1, 3, 10-11, 15-16, 21-23, 28 and 31-36. Claims 12 and 17 have been cancelled without prejudice. Claims 1-11, 13-16 and 18-36 are currently pending. No new matter has been added. Applicants believe that the foregoing comments overcome the rejections set forth in the May 21, 2007 Office Action.

Applicants wish to thank Examiner Lastra and Supervisory Examiner Myhre for the courtesy extended in granting and conducting an in-person and telephonic interview with their representatives. The above listed claim amendments reflect the comments and input received from Examiner Lastra and Supervisory Examiner Myhre during the interviews.

#### **I. THE EXAMINER'S REJECTIONS**

The Examiner rejected Claims 1, 2, 7-10, 12-15, 17-25, 27 and 31-36 under 35 U.S.C. § 103(a) as being unpatentable over Walker *et al.*, U.S. Patent Application Pub. No. 2003/0054888 (hereinafter "Walker") in view of Roll *et al.*, U.S. Patent Application Pub. No. 2002/0016779 (hereinafter "Roll"). The Examiner argued that "it would have been obvious at to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system.

Claims 3-5 and 29 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Roll, in further view of United States Patent No. 6,331,143.



to Yoseloff, *et al.*, (hereinafter referred to as "Yoseloff"). The Examiner stated that "Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number..."

The Examiner rejected claims 6, 11, 16, 26 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Roll, in further view of United States Patent No. 5,933,811, to Angles, *et al.*, (hereinafter referred to as "Angles"). The Examiner stated that "Angles teaches a system where users are compensated for viewing sponsors' advertisements. See, Office Action dated May 18, 2006, page 13, third paragraph. The Examiner argued that "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsor's advertisements independently of the purchase of the advertised product or service as taught by Angles"

Claim 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker, in view of Roll, Angles and Yoseloff. The Examiner recognized that Walker "fails to teach wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor." See, Office Action dated May 18, 2006, page 14, third paragraph. The Examiner stated that it would have been obvious "to know that sponsors would compensate users for viewing the sponsors' advertisements or for participating in the sponsors' online surveys."

## **II. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN**

In light of the current amendments, the Applicant respectfully requests reconsideration of the Examiner's rejections, and withdrawal of the same.

Referring initially to Claim 1, recited are, *inter alia*, elements of:

- electronically calculating a dynamic probability of winning the selected product by the user based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session;
- electronically generating a trial outcome of an event trial, the probability of the event trial generating a winning trial outcome corresponding to the calculated probability of winning;
- generating an outcome indicator independent of, and differently distributed from, the trial outcome;
- displaying the outcome indicator to the user; and
- in response to a winning trial outcome, purchasing the selected product for the user from the independent third-party retail vendor at no cost to the user.

The Applicants respectfully assert that none of the cited prior art references, taken singly, or in any combination, teach, suggest, or obviate, a search engine providing an option to win the item sought where the system calculates a "dynamic probability" of winning "based on one or more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the user's behavior during a user session. Furthermore, none of the cited references teach suggest, or render obvious the Claim 1 element of generating a trial outcome and "an outcome indicator independent of, and differently distributed from, the trial outcome" before displaying the outcome indicator to the user. Finally, none of the prior art references teach that, after a user wins the product they were searching for, the system providing the product "at no cost to the user."

Therefore, for at least the reasons stated above, Claim 1 is patentable over all of the cited prior art references. Independent Claims 10, 15, 21, 22, 33 and 35-36 include limitations analogous to at least one of the elements cited above for Claim 1. The Applicants, therefore, reiterate their arguments for Claim 1, and assert that Claims 10, 15, 21, 22, 33 and 35-36 are patentable over the prior art for at least the same reasons as Claim 1. Claims 2-9, 11, 13-14, 16 18-20, 22, 24-32 and 34 all depend from one of the independent claims, discussed above. By virtue of their dependencies, Claims 2-9, 11, 13-14, 16 18-20, 22, 24-32 and 34 include all of the limitations as the claims from which they depend, and are, therefore, patentable for at least the same reasons. Therefore, all claims are therefore in condition for allowance. Thus, the Examiner is respectfully requested to withdraw the rejections to the claims.

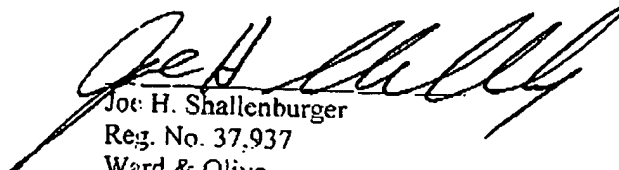
#### CONCLUSION

Applicants submit that the specification, drawings, and all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. The claims have been amended merely to clarify the novel features of the current invention and are in no way related to patentability. The Applicants respectfully request the Examiner's reconsideration and withdrawal of the various rejections stated in the May 21, 2007 Office Action. Early and favorable action is accordingly solicited.

Should any changes to the claims and/or specification be deemed necessary to place the application in condition for allowance, the Examiner is respectfully requested to contact the undersigned to discuss the same. This Amendment and RCE is believed to be timely filed. If a petition for extension of time and/or any other fees are required, the Patent and Trademark office is specifically authorized to charge such fee to Deposit Account No. 23-0420 in the name of Ward & Olivo.

Respectfully submitted,

Date: 5/8/08

  
Joe H. Shallenburger  
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# EXHIBIT 7



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839

26158	7590	06/27/2005
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EXAMINER
LAstra, DANIEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/759,103

Applicant(s)

CLARK ET AL

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 March 2005.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-30 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

***Response to Amendment***

2. In response to Non Final Rejection filed 12/30/2004, the Applicant filed an Amendment on 03/30/2005, which amended claims 1, 9, 10, 14, 15, 19, 21, 22, 26, 29 and 30. Applicant's amendment overcame the Section 112 rejection.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7-10, 12-15, 17-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 2003/0054888) in view of Ghouri (US 2002/0082978).

As per claims 10 and 20-22, Walker teaches:

A method of providing a user with a game of chance, the method comprising:  
receiving electronic signals representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals representing at a least one product, a price of the product (see Walker paragraph 39). Walker does not expressly teach and a third-party dealer of the product. However, Ghouri teaches a system that searches for dealers of



products selected by users (see paragraphs 22 and 23). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products, which users would like to play games to win said selected products. This feature would show to users the best dealers or manufacturers' offers of products selected by users.

*automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment (see Walker paragraph 130), or requesting the first option and a second option to purchase the product (see Walker paragraphs 34; 149);*

*if the user chooses to play the game:*

*electronically calculating a probability of winning the product by the user; electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 144); and*

*in response to a winning pseudo-random outcome, purchasing the product for the user (see Walker paragraph 145);*

*and*

*if the user chooses to purchase the product instead of playing the game:*

*directing the user to a web site which sells the product (see Walker paragraph 34,149-151);*

*As per claim 1, Walker teaches:*

Art Unit: 3622

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals representing search parameters descriptive of a product or service (see Walker paragraph 39);

transmitting electronic signals representing dealers in the product or service and associated prices (see Walker figure 6). Walker does not expressly teach dealers. However, Ghouri teaches a system that searches for dealers of products selected by users (see paragraphs 22 and 23). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products, which users would like to play games to win said selected products. This feature would show to users the best dealers or manufacturers' offers of products selected by users.

*automatically* providing the user an option to play a game to win a selected product or service without the user first making any payment (see paragraph 130) or *requesting the option* (see paragraph 34; 149);

electronically calculating a probability of winning the selected product or service by the user (see paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see paragraph 145); and

in response to a winning pseudo-random outcome, purchasing the selected product or service for the user (see paragraph 145).

As per claim 15, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals representing search parameters descriptive of a product (see Walker paragraph 39);

transmitting electronic signals representing a plurality of different dealers and associated prices charged by each of said different dealers for products identified in response to said at least one search parameter (see Walker figure 6). Walker does not expressly teach dealers. However, Ghouri teaches a system that searches for dealers of products selected by users (see paragraphs 22 and 23). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products, which users would like to play games to win said selected products. This feature would show to users the best dealers or manufacturers' offers of products selected by users.

*automatically* providing the user an option to play a game to win a selected product or service without the user first making any payment (see Walker paragraph 130) *or requesting the option* (see Walker paragraph 34; 149);

electronically calculating a probability of winning the selected product or service by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing said selected one product from a corresponding dealer for the user (see paragraph 145).

As per claims 7, 12 and 17, Walker teaches:

The method of claim 10, comprising calculating a probability of winning based on at least a current budget (see Walker paragraph 144).

As per claims 8, 13 and 18, Walker teaches:

The method of claim 10, comprising calculating a probability  $P$  of winning based on a total number of game players (see Walker paragraph 110).

As per claim 23, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user if the outcome for the play of the game is a win (see Walker paragraphs 129-131).

As per claim 25, the same rejection applied to claims 7-8 is applied to claim 25.

As per claims 2, 24 and 27, Walker teaches:

The method of claim 1, wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system (see Walker paragraphs 26 and 89).

As per claims 9, 14 and 19, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

Walker does not expressly teach  $P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see paragraph 143).

$P_t$  is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

$P_m$  is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

$P_u$  is probability factor that varies with the user's behavior *during a user session* (see Walker paragraph 88); and

$N$  is a number of current users (see Walker paragraph 110).

Claims 3-5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri (US 2002/0082978) and further in view Yoseloff (U.S. 6,331,143).

As per claims 3 and 29, Walker teaches:

The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see column 8, lines 35-50; column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker teaches:

The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a

system (see column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker teaches:

The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. However, Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to the provider of the products (see paragraph 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would

give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

Claims 6, 11, 16, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri (US 2002/0082978) and further in view of Angles et al (U.S. 5,933,811).

As per claims 6, 11, 16, 26, 28 Walker teaches:

The method of claim 10, but fails to teach comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party, such as a game provider, provides compensation. However, Angles teaches a system where users are compensated for viewing sponsors' advertisements (see column 16, lines 38-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the Walker system would be compensated for the viewing of selected sponsors' advertisements independently of the purchase of the advertised product or service, as taught by Angles and these compensations would allow users to play games to win the sponsors' advertise products, as taught by Walker. Compensating users for viewing advertisements would be a good business decision as this would increase the probability that users would view the sponsors' advertisements and would play to win the advertise products, therefore increasing customer traffic and customer loyalty.



Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri (US 2002/0082978) and further in view of Angles et al (U.S. 5,933,811) and Yoseloff (US 6,331,143).

As per claim 30, Walker teaches:

The method for providing a user an opportunity to win a product or service of claim 29 but fails to teach wherein the user can *increase the probability of winning* the product or service by participating in an online survey for an advertising sponsor. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that sponsors would compensate users for viewing the sponsors' advertisements or for participating in the sponsors' online surveys. Sponsors would compensate users by allowing the users to play games to win the sponsors' products.

#### ***Response to Arguments***

4. Applicant's arguments filed 03/30/2005 have been fully considered but they are not persuasive. The Applicant argues that Walker does not teach that a user is automatically provided with an option to play a game to win a selected product or service without requesting the option. The Examiner answers that Applicant's figure 4 teaches that a user has to click the hyperlink "win it" to play to win a product, so said user needs to make an request to play said game. Walker provisional (60/204,673) page 2, summary teaches "that the customer may be able to select one or more products (e.g., selecting on a web page, using a kiosk, scanning a barcode) that he wants to win and may try to win the product(s) through various games including slot

Art Unit: 3622

machine, video poker, roulette, etc...A benefit of embodiments of the present invention is that the excitement of gambling may be added to shopping, allowing the customer to win any item of the customer's choice. Adding the excitement to shopping may be able to increase sales for a particular retailer". Therefore, Walker teaches that a user makes a request to win products and therefore, teaches the Applicant's claimed invention.

The Applicant argues that Walker does not teach automatically transmitting electronic signals representing at least a first option for the user to play a game to win a product without the user first making any payment. The Examiner answers that Walker teaches in paragraph 130 "An alternate from of entry may also comprise signing one's name, providing a fingerprint, or simply asking to play the game for free. Therefore, Walker teaches at least a first option for the user to play a game to win a product without the user first making any payment.

The Applicant argues that Walker does not teach the option of purchasing of a product as an option to playing a game to win the prize. The Examiner answers that Walker teaches in paragraph 34 that "retail stores also include Websites in which descriptions and visual representations of products for sale may be viewed by customers and through which the customers may purchase one or more products for sale". Therefore, Walker gives customers the option of being directed to a merchant's website and purchase merchant's products, without the need to play a game to win said product.

The Applicant argues that Walker does not teach "probability factor that varies with the user's behavior occurring during a user session because Walker teaches that a

Art Unit: 3622

customer rating is associated with customer's purchasing history. The Examiner answers that Walker teaches that a customer may pay a fee in order to be associated with a particular rating (see paragraph 88). Therefore, if during a user session a customer pay a bigger fee, said customer based upon said behavior would receive a higher rating and a higher probability of receiving a winning outcome.

The Applicant argues that Walker does not teach the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system. The Examiner answers that Walker teaches in paragraph 89 that a probability may be determine based on a customer history or receiving winning outcomes stored in the customer database. Therefore, Walker teaches that the probability increase with the value derived from the user's interaction with the system.

### ***Conclusion***


5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

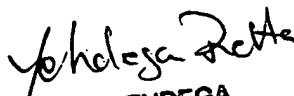
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 571-272-6724. The Right fax number of the Examiner is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel Lastra  
May 30, 2005

  
RETTA YEHDEGA  
PRIMARY EXAMINER

# EXHIBIT 8

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) P166 1010.1	
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		First Named Inventor <u>Clark</u>	
		Art Unit <u>3622</u>	Examiner <u>Daniel Lastra</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<u>[Signature]</u> Signature <u>John J. Timar</u> Typed or printed name <u>(404) 888-7412</u> Telephone number <u>September 26, 2005</u> Date	
<input type="checkbox"/> applicant/inventor.			
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/88)			
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>32,497</u>			
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the burden of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: ) Examiner: Daniel Lastra  
Clark, et al. ) Group Art Unit: 3622  
Serial No: 09/759,103 ) Confirmation No.: 1839  
Filed: January 12, 2001 ) Attorney Docket No.: P166 1010.1  
For: Search Engine Providing an Option to Win the Item Sought

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Final Office Action mailed June 27, 2005, for the above-identified patent application, Applicants submit the following arguments in conjunction with this Pre-Appeal Request for Review.

The Examiner's rejection of claims 1, 2, 7-10, 12-15, 17-25 and 27 under 35 U.S.C. 103(a) as unpatentable over *Walker, et al.* (U.S. 2003/0054888) in view of *Ghouri, et al.* (2002/0082978) is in error.

The Examiner's ability to use either the *Walker, et al.* or the *Ghouri, et al.* published applications is predicated on the fact that both claim priority to provisional patent applications that were filed before Applicant's patent application was filed on January 12, 2001. In order to use either of these references as prior art based on earlier filed provisional applications, the provisional applications themselves must teach that which the Examiner relies upon for showing aspects of the Applicants' claimed invention in the published applications of *Walker, et al.* and *Ghouri, et al.* It is an error for the Examiner to rely on teachings of the published applications that were not also in the provisional applications from which the published applications claim priority.

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Regarding claim 10, the Examiner stated at page 3 of the office action mailed June 27, 2005 that *Walker* teaches "automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment (citing *Walker*, paragraph 130) or requesting the first option and a second option to purchase the product" (citing *Walker*, paragraphs 34, 149). Applicants' arguments are found in the amendment response filed March 30, 2005 at pages 15-16. Specifically, Applicants argue that the statement in *Walker, et al.* provisional patent application 60/204,763, that the customer may be able to play for free for a limited number of plays (alternate method and use 13 on page 6 of 8) does not constitute a teaching of this particular claim step.

This isolated statement does not constitute a teaching or suggestion of an automatically transmitted option to play a game to win a product without making any payment or first requesting the option. Figs. 6, 7 and 9 in the *Walker* provisional application each show the step of receiving payment or a wager before executing the game. Fig. 8 does not explicitly show a step of payment, but the text describing the point-of-sale (POS) view depicted in this figure states at item 3 on page 8 of 8 that "If the product has been won, provide for no additional payment, otherwise credit towards payment at least some portion of the amount previously spent by the customer when trying to win the product."

Furthermore, the Examiner cannot rely on the teachings of paragraph 130 of the *Walker, et al.* published application which describes alternate forms of entry into a game since there are no counterpart teachings in the *Walker* provisional application. However, even if these teachings could be applied, the alternate forms of entry into a game to play for a product that are described in paragraph 130 are not a teaching or suggestion of automatically transmitting electronic signals representing an option to play to win a product without first requesting an option to play. Therefore, it was an error to use the teachings of this paragraph in the rejection of claim 10.

Applicants' arguments concerning the teachings of paragraph 149 are found on page 16 of Applicants' March 30, 2005 amendment response. As noted therein, *Walker* teaches that the customer pays for the product before playing a game to win the same product. In the related flowchart of Fig. 10, there is no depiction of directing a customer to a web site to buy a product. As shown in Fig. 10, the customer pays for the product, then requests to play the game to win the



product. However, even the step of requesting to play the game is not depicted in the flow charts or specification of the provisional application. Therefore, it was an error to use the teachings of this paragraph in the rejection of claim 10.

Further regarding claim 10, the Examiner stated at page 3 of the Office Action mailed June 27, 2005, that *Walker* teaches "if user chooses to purchase a product instead of playing the game: directing the user to a website which sells the product," citing *Walker* paragraphs 34, 149 – 151. Applicant's arguments are found in the Amendment response filed March 30, 2005, at pages 16 – 17. As noted therein, paragraphs 149 – 151 and Fig. 10 of *Walker, et al.* describe a process in which a customer selects a product, payment is received for the product, and the customer requests to play a game for the product.

In paragraph 150, *Walker, et al.* teaches that selection of the product is received by a POS terminal in response to a bar code scanner scanning a bar code corresponding to the product. Paragraph 151 teaches that payment for the product is received using a payment identifier associated with the customer identifier received by the customer input/output device or through manual input by the customer using the customer input/output device. As shown in Fig. 10 of *Walker, et al.*, after a customer selects and pays for the product, he then requests to play a game to either win the product or have a portion of the fee for playing the game credited to the customer. There is no teaching in *Walker, et al.* of directing the user to a website that sells a product if a user chooses to purchase a product instead of playing the game when presented with the alternative options. In Applicants' invention, the user has the selectable options to win the product or to buy the product. If the user decides to buy the product, a hyperlink takes the user to the product provider's website in order to purchase the product.

With further regard to the teachings of paragraphs 149 – 151 of *Walker, et al.*, the closest corresponding teachings are found in the provisional application in Figs. 8 – 9, the corresponding description of Fig. 9 on page 7 of 8 of the provisional application, and the description of the POS view on page 8 of 8 of the provisional application. Note that the description of Fig. 9 is "a flow chart of the exemplary method performed by the control program in an embodiment where the customer purchases the item the customer wishes to win before trying to win the item." There is no teaching in the *Walker, et al.* provisional application of the customer actually requesting an

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option to play the game. Therefore, it was an error to use the teachings of these paragraphs in the rejection of claim 10.

Claims 1, 15, 21 and 22 each include the limitation of automatically providing the user with an option to play the game to win a selected product or service without the user first making any payment or requesting the option. The Examiner used the same basis for rejecting these claims as he did for claim 10. As argued above, it was an error for the Examiner to apply the teachings of the *Walker, et al.* published patent application for teachings that were not found in the provisional patent application. Therefore, the rejections of claims 1, 10, 15, 21 and 22 are each based on teachings in the *Walker, et al.* published application that are not found in the provisional patent application.

Further regarding claim 1, the Examiner stated at page 4 of the Office Action mailed June 27, 2005, that *Ghourl, et al.* teaches "transmitting electronic signals representing dealers in the product or service and associated prices. The Examiner stated that *Ghourl, et al.* teaches a system that searches for dealers of products selected by users, citing paragraphs 22 and 23. Applicants' arguments concerning *Ghourl, et al.* are found at page 18 of the Amendment response filed March 30, 2005. Although Applicants' arguments were made with respect to the Examiner's rejection of claim 20, they are also applicable to claims 1, 15 and 21. *Ghourl, et al.* teaches an interactive system which provides customers with comprehensive information about a plurality of products and any associated customizable features, further providing a forum for conducting a reverse auction where sellers of products, exactly or closely matching those sought by the customer, bid for that customer's business (paragraph 22). *Ghourl, et al.* further teaches an interactive system and method for customizing an automobile through an interactive, online automobile configuration program, which may be electronically integrated and configured with dealers' inventory, and subsequently soliciting bids for the customer's automobile from a plurality of automobile dealerships over a distributed computing network (paragraph 23). As stated in paragraph 66, requests for new bids are transmitted, preferably with electronic mail, to notify the system support group and the participating dealers. Dealers can access the system of *Ghourl, et al.* and submit a bid that the customer can consider. The customer must select a bid before receiving dealer contact information (paragraph 74). Fig. 20 illustrates a sample bid results page;

Fig. 21 illustrates a bid comparison page; Fig. 22 illustrates the bid acceptance page. Only after accepting a bid does the customer obtain any dealer information. This does not represent a teaching of transmitting electronic signals representing dealers in the product or service and associated prices as claimed in claim 1. Therefore, it was an error to apply the teachings of *Ghourl, et al.* directed to a reverse auction for a customizable product in rejecting claim 1. Claims 15 and 21 both include the limitation of transmitting electronic signals representing a plurality of dealers and associated prices charged by each of the dealers. Therefore, for the same reasons as for claim 1, it was an error for the Examiner to apply the teachings of *Ghourl, et al.* in the rejection of claims 15 and 21. The Examiner has also failed to provide copies of the twelve web pages and thirty-five page technical description that are part of the *Ghourl, et al.* provisional application. Thus Applicants are unable to ascertain which teachings of the *Ghourl, et al.* published application can be applied as prior art.

In view of the above, it is submitted that the Examiner's rejection of independent claims 1, 10, 15, 21 and 22 was in error because it was based on the *Walker, et al.* published patent application filed after the present application, and relying on teachings not found in the corresponding provisional patent application and consequently not applicable as prior art. Furthermore, it was an error to apply the teachings of *Ghourl, et al.* in the rejection of Claim 1, 15 and 21, since *Ghourl, et al.* does not teach transmitting electronic signals representing dealers in the product or service and associated prices.

9/26/05  
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Respectfully submitted,



John J. Timlar  
Registration No. 32,497  
Attorney for Applicants

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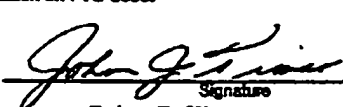
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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] <b>September 26, 2005</b> on _____ Signature  Typed or printed name <b>Diana Ogles</b>		In re Application of <b>Clark, et al.</b> Application Number <b>09/759,103</b> Filed <b>01/12/2001</b> For Search Engine Providing an Option to Win the Item Sought Art Unit <b>3622</b> Examiner <b>Daniel Lastra</b>	
Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.			
The fee for this Notice of Appeal is [37 CFR 41.20(b)(1)]		<b>\$500.00</b>	
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<input type="checkbox"/> applicant/inventor.		<b>John J. Timar</b> Typed or printed name	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/86)			
<input checked="" type="checkbox"/> attorney or agent of record. <b>32,497</b> Registration number		<b>(404) 888-7412</b> Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34.		<b>September 26, 2005</b> Date	
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<input checked="" type="checkbox"/> Total of <b>1</b> forms are submitted.			

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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MESSAGE:

In re application of: Clark, et al.  
Serial No. 09/759,103  
Filing Date: January 12, 2001  
For: Search Engine Providing an Option to Win the Item Sought

Attached for filing are the following documents.

1. Notice of Appeal
2. Pre-Appeal Brief Request for Review
3. Pre-Appeal Brief

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# EXHIBIT 9



# UNITED STATES PATENT AND TRADEMARK OFFICE


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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,103	01/12/2001	Scott Clark	10567-003	1839
26158	7590	12/13/2005	EXAMINER	
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC			LASTRA, DANIEL	
P.O. BOX 7037			ART UNIT	
ATLANTA, GA 30357-0037			PAPER NUMBER	

3622

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Application Number</b> 	<b>Application/Control No.</b> 09/759,103 Eric W. Stamber	<b>Applicant(s)/Patent under Reexamination</b> CLARK ET AL. Art Unit 3622	
<b>Document Code - AP.PRE.DEC</b>			

## Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 9/26/05.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-30.

Claim(s) withdrawn from consideration: \_\_\_\_\_

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Eric W. Stamber *ES*

(3) James Myhre *JM*

(2) Daniel Lastra *DL*

(4) \_\_\_\_\_